

No. 16154 ✓

United States
Court of Appeals

for the Ninth Circuit

THE COLEMAN COMPANY, INC., a Corpora-
tion, Appellant,

vs.

THE SIEGLER CORPORATION, a Corporation,
Appellee.

Transcript of Record

In Two Volumes

VOLUME I.

(Pages 1 to 312, inclusive)

Appeal from the United States District Court for the
Southern District of California,
Central Division

FILED

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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur.]

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*Page numbers appearing at bottom of page of Original Transcript of Proceedings.

In the United States District Court, Southern
District of California, Central Division

No. 213-57 BH

THE SIEGLER CORPORATION, a Corporation,
Plaintiff,

vs.

THE COLEMAN COMPANY, a Corporation,
Defendant.

COMPLAINT FOR DECLARATORY
JUDGMENT

Comes now the Plaintiff and for cause of action
against the Defendant, alleges as follows:

1. The Plaintiff, The Siegler Corporation, is a corporation organized and existing under the laws of the State of Delaware and has a regular and established place of business at 875 S. Arroyo Parkway, City of Pasadena, County of Los Angeles and State of California.

2. The Defendant, The Coleman Company, is a corporation organized and existing under the laws of the State of Kansas and has a regular and established place of business at 6480 Flotilla Street, City of Los Angeles, County of Los Angeles and State of California.

3. The Plaintiff's cause of action against the Defendant arises under the patent laws of the United States. This court has jurisdiction of the

subject matter of Plaintiff's cause of [2] action under the provisions of 28 U.S.C. sec. 1338 relating to patent causes and the provisions of 28 U.S.C. sec. 2201 relating to declaratory judgments.

4. On or about December 31, 1956, the Defendant, by a letter addressed to the Holly Manufacturing Company, Inc., 875 S. Arroyo Parkway, Pasadena, California, gave notice to Holly Manufacturing Company of alleged infringement of United States Patent No. 2,767,702 entitled "Wall Heater and Economizer Structure" issued on October 23, 1956, to The Coleman Company. At all times since on or about November 29, 1955, Holly Manufacturing Company has been and now is a division of the Plaintiff and is known as "Holly Manufacturing Company, a Division of The Siegler Corporation."

5. The Defendant's charge of infringement of said patent by the Plaintiff relates to wall heaters being manufactured and sold by the Plaintiff in the County of Los Angeles, State of California.

6. The Plaintiff does not infringe said Patent No. 2,767,702, and so advised the Defendant by a letter dated February 6, 1957.

7. The Plaintiff is informed and believes and therefore alleges that said patent and each claim thereof is invalid for the following reasons:

(a) Harry Giwosky, named in said patent as the inventor, was not the first inventor of the purported invention or inventions described or claimed in said patent;

(b) The purported invention or inventions described or claimed in said patent are not patentable in view of the state of the art at the time said purported invention or inventions were made;

(c) More than one year prior to the date on which the application for said patent was filed the purported [3] invention or inventions described or claimed in said patent were in public use and on sale in the United States;

(d) More than one year prior to the date on which the application for said patent was filed the purported invention or inventions described or claimed in said patent were described in printed publications in the United States or a foreign country.

8. The Plaintiff is informed and believes and therefore alleges that claim 2 of said patent is invalid and void for the following reasons:

(a) The changes and amendments in the claims and specification of the application for said patent during the prosecution of said application in the Patent Office broadened the application to embrace a purported invention not described in the original application as filed;

(b) The subject matter of said claim is not embraced in the statement of invention or claims of the original application and no supplemental oath was filed to cover the subject matter of such claim.

9. By reason of the foregoing allegations an actual controversy now exists between the parties to

this action so that Plaintiff needs a declaration of its rights by this court.

Wherefore, Plaintiff prays:

(1) For a judgment declaring that United States Patent No. 2,767,702 is invalid;

(2) For a judgment declaring that said patent is not infringed by Plaintiff;

(3) That a preliminary and final injunction be issued by this court enjoining Defendant from asserting that said patent or any claim thereof has been or is now being infringed by Plaintiff; [4]

(4) That Plaintiff be awarded its costs and attorneys' fees in this suit.

CHRISTIE, PARKER &
HALE,

/s/ By JAMES B. CHRISTIE,

/s/ By RICHARD B. HOEGH. [5]

[Endorsed]: Filed February 8, 1957.

[Title of District Court and Cause.]

ANSWER AND COUNTERCLAIM

Defendant, The Coleman Company, Inc., answering the complaint herein, states as follows:

1. Admits the allegations of paragraph 1 of the complaint.

2. Admits the allegations of paragraph 2 of the complaint.

3. Admits the allegations of paragraph 3 of the complaint.

4. Admits the allegations of paragraph 4 of the complaint.

5. Admits the allegations of paragraph 5 of the complaint.

6. Admits that it received a letter from plaintiff dated February 6, 1957, denying infringement, but denies the remainder of the allegations of paragraph 6 of the complaint.

7. Denies the allegations of paragraph 7 of the complaint.

8. Denies the allegations of paragraph 8 of the complaint.

9. Admits the allegations of paragraph 9 of the complaint. [22]

Counterclaim

Further answering, and by way of counterclaim against plaintiff, defendant avers:

10. This is a suit for infringement of United States Letters Patent No. 2,767,702 for a Wall Heater and Economizer Structure, and this Honorable Court has jurisdiction because this is an action arising under the patent laws of the United States.

11. Defendant, The Coleman Company, Inc., is a corporation organized and existing under the laws of the State of Kansas, and plaintiff is a corporation organized and existing under the laws of the

State of Delaware and has a regular and established place of business at 875 S. Arroyo Parkway, City of Pasadena, County of Los Angeles, and State of California.

12. On October 23, 1956, said United States Letters Patent No. 2,767,702 were duly and legally issued to the defendant, The Coleman Company, Inc., for an invention entitled "Wall Heater and Economizer Structure", and defendant is the sole owner and holder of said Letters Patent.

13. Since the issuance of said Letters Patent on October 23, 1956, plaintiff has infringed said Letters Patent by making, selling, and using the structure covered by said patent, and will continue to infringe said patent unless enjoined by this Honorable Court.

14. Defendant has notified plaintiff in writing of said Letters Patent.

15. On or about December 31, 1956, the defendant notified plaintiff of said alleged infringement of said United States Letters Patent No. 2,767,702, issued on October 23, 1956, but in spite of such notice, plaintiff continues, and threatens to continue, such infringement. Plaintiff is deriving profits from said infringing acts and defendant has been damaged.

Wherefore, defendant prays: [23]

1.) For a judgment holding said Letters Patent No. 2,767,702 valid.

2.) For a judgment holding said Letters Patent No. 2,767,702 infringed by plaintiff.

3.) That an injunction be issued restraining plaintiff, its directors, officers, employees, and others acting by or under plaintiff's direction or authority, from making, selling, using or otherwise infringing said Letters Patent No. 2,767,702.

4.) That plaintiff be required to account for and pay to the defendant all damages suffered by defendant as a result of plaintiff's said infringement.

5.) That defendant be awarded its costs and such other and further relief as may be deemed proper in the circumstances.

PARKER, STANSBURY, REESE &
McGEE, DAWSON, TILTON,
FALLON & LUNGMUS,

/s/ By RAYMOND G. STANBURY,
Attorneys for Defendant. [24]

Affidavit of Service by Mail Attached. [25]

[Endorsed]: Filed May 6, 1957.

[Title of District Court and Cause.]

ANSWER TO DEFENDANT'S
COUNTERCLAIM

The plaintiff, The Siegler Corporation, answers the defendant's counterclaim as follows:

1. Admits that by its counterclaim the defendant has alleged infringement of United States Letters Patent No. 2,767,702 and that this court has jurisdiction of the subject matter of the counterclaim. Plaintiff denies that it has infringed or is infringing the patent in the suit.

2. Admits the allegations of paragraph 11 of the counterclaim.

3. Admits that on October 23, 1956 United States Letters Patent No. 2,767,702 was issued to the defendant and that the defendant is the sole owner and holder of said Letters Patent. Except as expressly admitted, plaintiff denies the allegations of paragraph 12 of the counterclaim. [26]

4. Denies the allegations of paragraph 13 of the counterclaim.

5. Admits the allegations of paragraph 14 of the counterclaim.

6. Admits that on or about December 31, 1956 the defendant notified the plaintiff of alleged infringement of United States Letters Patent 2,767,702 issued on October 23, 1956. Except as expressly admitted, plaintiff denies each and every allegation of paragraph 15 of the counterclaim.

For a First Affirmative Defense to the counterclaim, plaintiff alleges as follows:

7. Plaintiff hereby incorporates by reference each and every allegation of paragraph 7 of the plaintiff's complaint for declaratory judgment in the above entitled action.

For a Second Affirmative Defense against the counterclaim the plaintiff alleges as follows:

8. Plaintiff hereby incorporates by reference each and every allegation of paragraph 8 of the plaintiff's complaint for declaratory judgment in the above entitled action.

Wherefore the plaintiff prays that the defendant take nothing by its counterclaim and that the plaintiff be awarded its costs and attorney's fees.

CHRISTIE, PARKER & HALE,
/s/ By RICHARD B. HOEGH,
Attorneys for Plaintiff. [27]

[Endorsed]: Filed May 29, 1957.

[Title of District Court and Cause.]

INTERROGATORIES TO DEFENDANT

Plaintiff requests that the defendant, The Coleman Company, Inc., by an officer thereof competent to testify on its behalf, answer under oath, in accordance with Rule 33 of the Federal Rules of Civil Procedure, the following interrogatories: [39]

* * * * *

[Note: Interrogatories are the same as set out in Answers of Defendant at pages 13-26.]

Dated: November 27, 1957.

CHRISTIE, PARKER & HALE,
JAMES B. CHRISTIE,
C. RUSSELL HALE,
RICHARD B. HOEGH,
ASHLEY STEWART ORR,

/s/ By RICHARD B. HOEGH,
Attorneys for Plaintiff. [47]

Affidavit of Serve by Mail Attached. [48]

[Endorsed]: Filed November 29, 1957.

[Title of District Court and Cause.]

DEFENDANT'S ANSWERS TO PLAINTIFF'S INTERROGATORIES

Defendant, The Coleman Company, Inc., by Alwin B. Newton, its Vice President in Charge of Design and Research, answers the interrogatories served on it by the plaintiff and dated November 27, 1957 as follows:

It is understood that plaintiff manufactured a "first series" of wall heaters from approximately 1950 to 1954 which included models 25NS, 25ND, 35NS, 35ND, 50ND and 57ND; that defendant manufactured a "second series" of wall heaters from sometime in 1954 to about January, 1957 which included models 250S, 250D, 350S, 350D, 500D, and 570D; and that plaintiff manufactured a "third

series'' of wall heaters from about January, 1957 to the present which include models 25S, 25D, 35S, 35D, 50D, and 55D. For purpose of conciseness the term "first series", "second series", and "third series", as thus understood and defined, will be used in the following answers.

Interrogatories Nos. 1 to 6

1. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly Wall heaters designated as Model 25 NS.

2. State which claim or claims, if any, the defendant contends to be infringed by plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 25 ND.

3. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 35 NS.

4. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 35 ND.

5. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company,

in manufacturing and selling Holly wall heaters designated as Model 50 ND.

6. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 57 ND.

Answers to Interrogatories Nos. 1 to 6

Defendant in answering the above interrogatories collectively, does not contend that any claim of the patent in suit is infringed by any model of the "first series", being those designated in the above interrogatories.

Interrogatories Nos. 7 to 12

7. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 250 S.

8. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 250 D.

9. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 350 S.

10. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 350 D.

11. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 500 D.

12. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 570 D.

Answers to Interrogatories Nos. 7 to 12

Defendant in answering the above interrogatories collectively, on the basis of present information and belief, contends that Claim 2 of the patent in suit is infringed by each and all models of the "second series", being those designated in interrogatories 7 to 12.

Interrogatories Nos. 13 to 18

13. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 25 D.

14. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff

or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 25 S.

15. State which claim or claims, if any, the defendant claims to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 35 D.

16. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 35 C.

17. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 50 D.

18. State which claim or claims, if any, the defendant contends to be infringed by the plaintiff or its predecessor, Holly Manufacturing Company, in manufacturing and selling Holly wall heaters designated as Model 55 D.

Answers to Interrogatories Nos. 13 to 18

Defendant in answering the above interrogatories collectively, contends on the basis of information and belief that Claim 2 of the patent in suit is infringed by each and all models of the "third series", being those designated in interrogatories 13 to 18.

Interrogatories Nos. 19 to 23

19. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a wall heater having a lower casing provided with an inlet port and spaced therefrom an outlet port, as claimed in claim 1 of the patent in suit.

20. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a lower casing being adapted to be positioned at least partially within a room wall at the bottom portion thereof, as claimed in claim 1 of the patent in suit.

21. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a lower casing having means forming a combustion chamber mounted therein whereby air flowing thereinto through said inlet port is heated as it rises toward said inlet port, as claimed in claim 1 of the patent in suit.

22. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a barrier plate forming a closure wall across said casing near the top thereof, as claimed in claim 1 of the patent in suit.

23. State which model or models, if any, of Holly

wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a flue communicating at its lower end with said combustion chamber and adapted to extend upwardly above said barrier plate and between the space panels of a room wall, as claimed in claim 1 of the patent in suit.

Answers to Interrogatories 19 to 23

Defendant in answering the above interrogatories collectively on the basis of its information and belief states that each and all of the models of the first, second and third series include the specified elements, being those designated in all of the foregoing interrogatories.

Interrogatory No. 24

24. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a lower casing including an inlet casing portion above said barrier plate and having an inclined top wall forming a hood extending outwardly from a panel of said wall and being provided with an inlet opening there-through, as claimed in claim 1 of the patent in suit.

Answer to Interrogatory No. 24

Defendant in answering the above interrogatory on the basis of information and belief states that none of the models of the first, second, or third series include the specified element.

Interrogatory No. 25

25. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a flue casing about said flue above said barrier plate and being spaced from said flue to define a flow passage thereabout, as claimed in claim 1 of the patent in suit.

Answer to Interrogatory No. 25

Defendant in answering the above interrogatory on the basis of information and belief states that all of the models of the first, second and third series include the specified element.

Interrogatory No. 26

26. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a flue casing having an inlet opening above and adjacent said barrier plate whereby air flowing into the flue casing sweeps that plate in heat exchange relation therewith, as claimed in claim 1 of the patent in suit.

Answer to Interrogatory No. 26

Defendant in answering Interrogatory No. 26 on the basis of information and belief states that each of the models of the second and third series include the specified element but that none of the models of the first series include it.

Interrogatory No. 27

27. State which model or models, if any, of Holly

wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a flue casing having an enlarged opening spaced above said inlet opening but adapted to be below the ceiling level of a room space, as claimed in claim 1 of the patent in suit.

Answer to Interrogatory 27

Defendant in answering the above interrogatory on the basis of information and belief states that all of the models of the first, second and third series included the specified element.

Interrogatory No. 28

28. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a closure plate within said flue casing dividing the same into flow-separated passage sections, as claimed in claim 1 of the patent in suit.

Answer to Interrogatory 28

Defendant in answering the above interrogatory on the basis of information and belief states that none of the models of the first, second or third series included the specified element.

Interrogatory No. 29

29. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company,

the defendant contends include a closure plate horizontally dividing said enlarged opening to form an outlet opening below the closure plate and an additional inlet opening above the closure plate, whereby within a room space, one increment of air flows into said heater casing through the inlet port thereof and after being heated, flows outwardly through the outlet port thereof, a second increment of air flows through said hood inlet opening, upwardly through said flue casing in heat exchange relation with said flue and outwardly through said flue casing outlet opening, a third increment of air flows inwardly into said flue casing through said additional inlet opening and upwardly in heat exchange relation with said flue, as claimed in claim 1 of the patent in suit.

Answer to Interrogatory No. 29

Defendant in answering the above interrogatory on the basis of information and belief states that none of the models of the first, second or third series include the specified element.

Interrogatories Nos. 30 to 36

30. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a vertically-extending lower heater casing for housing a combustion chamber, as claimed in claim 2 of the patent in suit.

31. State which model or models, if any, of Holly

wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include an economizer casing extending above said lower heating casing, as claimed in claim 2 of the patent in suit.

32. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a barrier plate extending across said lower heater casing beneath said economizer casing and near the top of said lower heater casing, as claimed in claim 2 of the patent in suit.

33. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a flue extending through said barrier plate from within said lower heater casing and through said economizer casing and in spaced relation to the side walls thereof, as claimed in claim 2 of the patent in suit.

34. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include the upper portion of the front of said lower heater casing providing a heated air outlet adjacent the under side of said barrier plate, as claimed in claim 2 of the patent in suit.

35. State which model or models, if any, of Holly

wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include the front portion of said lower heater casing projecting outwardly further than the front portion of said economizer casing, as claimed in claim 2 of the patent in suit.

36. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a projecting portion including the forward portion of said barrier plate and providing a casing hood portion extending above and over said barrier plate forward portion, as claimed in claim 2 of the patent in suit.

Answers to Interrogatories 30 to 36

Defendant in answering the above interrogatories collectively, on the basis of information and belief states that each of the models of the first, second and third series include the specified elements.

Interrogatory No. 37

37. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include a casing hood portion being spaced from said barrier plate forward portion to provide a passage for the flow of air over the upper surface of said barrier plate forward portion, as claimed in claim 2 of the patent in suit.

Answer to Interrogatory 37

Defendant in answering the above interrogatory

on the basis of information and belief states that each model of the second and third series included the specified element but that said element was not included in any model of the first series.

Interrogatories Nos. 38 and 39

38. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include an economizer casing having an air inlet near the bottom of the front thereof and an air outlet above said inlet but adapted to be below the ceiling level of a room space, as claimed in claim 2 of the patent in suit.

39. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company, the defendant contends include an economizer air inlet being positioned inwardly of said barrier plate forward portion and adjacent the upper surface of said barrier plate, as claimed in claim 2 of the patent in suit.

Answers to Interrogatories 38 and 39

Defendant in answering the above interrogatories collectively, on the basis of information and belief state that each model of the first, second and third series included the specified elements.

Interrogatory 40

40. State which model or models, if any, of Holly wall heaters manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company,

the defendant contends include a casing hood portion providing a room air inlet opening, said room air inlet means adapted to communicate on one side with the room atmosphere and on the other with said air passage over the upper surface of the forward portion of said barrier plate and said room air inlet means being constructed and arranged to cause room air to pass over the said upper surface of the said barrier plate forward portion in heat exchange relation therewith, as claimed in claim 2 of the patent in suit.

Answer to Interrogatory No. 40

Defendant in answering the above interrogatory on the basis of information and belief states that each model of the second and third series included the specified element but that said element was not included in any model of the first series.

Interrogatories Nos. 41 to 45

41. State whether or not any wall heaters manufactured or sold by the defendant have been marked with the legend "Patent No. 2,767,702," or "patent No. 2,767,702," or a similar legend which includes the patent number of the patent in suit.

42. State which models, if any, of wall heaters manufactured or sold by the defendant have been marked with the number of the patent in suit.

43. State the date on which patent marking pertaining to Patent No. 2,767,702 was first placed on any wall heaters manufactured or sold by the defendant on or after October 23, 1956.

44. State all types of marking, pursuant to 35 U.S.C., Section 287, which has been placed upon any wall heaters manufactured or sold by the defendant.

45. Where, on any wall heaters manufactured or sold by the defendant, is any marking of the patent in suit placed.

Answers to Interrogatories 41 to 45

Defendant in answering the above interrogatories collectively admits that its gas wall heaters which were being manufactured and sold at the time of issuance of the patent in suit and which wall heaters have subsequently been discontinued were not marked with any notice by patent number or otherwise with respect to the patent in suit.

ALWIN B. NEWTON,
Vice President, Design & Research, The Coleman
Company, Inc.

State of Kansas

County of Sedgwick—ss.

Alwin B. Newton, being duly sworn, deposes and says that he resides at 3511 Elmwood Drive, Wichita 17, Kansas; that he is the Vice President in charge of Design and Research of The Coleman Company, Inc., defendant herein; and that he has read the foregoing answers to interrogatories and knows the contents thereof and that the same are true of his own knowledge, except as to matters

therein stated to be on information and belief, and as to those matters he believes them to be true.

/s/ ALWIN B. NEWTON.

Subscribed and sworn to before me this 3rd day of February, 1958.

[Seal] /s/ LILLIAN A. DICKENS,

Notary Public in and for said County and State.

My Commission Expires June 29, 1959.

Affidavit of Service by Mail Attached. [14]

[Endorsed]: Filed February 11, 1958.

[Title of District Court and Cause.]

PLAINTIFF'S REQUESTS FOR ADMISSIONS

The plaintiff requests that the defendant, The Coleman Company Inc., pursuant to the provisions of Rule 36 of the Federal Rules of Civil Procedure, admit or deny the following facts: [49]

* * * * *

[Note: Facts to be admitted are set out in the Defendant's Reply at pages 29-30.]

Dated this 27th day of November, 1957.

/s/ RICHARD B. HOEGH.

Affidavit of Service by Mail Attached. [51]

[Endorsed]: Filed November 29, 1957.

[Title of District Court and Cause.]

NOTICE PURSUANT TO 35 U.S.C. SEC. 282

You and Each of You Will Please Take Notice that as presently advised, plaintiff will rely upon the following prior art as showing anticipation of the patent in suit:

United States Letters Patent No. 268,860, issued to Browell on December 12, 1882, and will present the testimony of the following named person as the prior inventor, or as having prior knowledge of, or as having previously used the purported invention of the patent in suit: John H. Hollingsworth, 1976 North Roosevelt Avenue, Altadena, California. [55]

This notice is given pursuant to 35 U.S.C. Sec. 282.

Dated January 14, 1958.

CHRISTIE, PARKER & HALE,
/s/ By RICHARD B. HOEGH. [56]

Affidavit of Service by Mail Attached. [57]

[Endorsed]: Filed January 15, 1958.

[Title of District Court and Cause.]

DEFENDANT'S REPLY TO PLAINTIFF'S
REQUEST FOR ADMISSIONS UNDER
RULE 36

State of Kansas

County of Sedgwick—ss.

Alwin B. Newton, being duly sworn on oath and in response to Plaintiff's Request for Admissions Under Rule 36, responds to the six paragraphs of Plaintiff's Request as follows:

1. That claim 1 of the patent in suit does not cover wall heater models 25NS, 25ND, 35NS, 35ND, 50ND or 57ND manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

Answer: Admitted.

2. That claim 1 of the patent in suit does not cover wall heater models 250S, 250D, 350S, 350D, 500D, 570D manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

Answer: Admitted. [65]

3. That claim 1 of the patent in suit does not cover wall heater models 25S, 25D, 35S, 35D, 50D, 55D manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

Answer: Admitted.

4. That claim 2 of the patent in suit does not cover wall heater models 25NS, 25ND, 35NS, 35ND,

50ND or 57ND manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

Answer: Defendant is not in a position to formally admit or deny this request at the present time since it has had no opportunity to examine all of the heater models specified in plaintiff's request No. 4. On the basis of information and belief, however, it is probably true that Claim 2 of the patent in suit does not cover wall heater models 25NS, 25ND, 35NS, 35ND, 50ND and 57ND manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

5. That claim 2 of the patent in suit does not cover wall heater models 250S, 250D, 350S, 350D, 500D, 570D manufactured and sold by the plaintiff or its predecessor Holly Manufacturing Company.

Answer: Defendant is not in a position to formally admit or deny plaintiff's request No. 5 since it has not had an opportunity to examine all of the models specified therein. On the basis of information and belief, however, it is probable that Claim 2 of the patent in suit does cover and is infringed by wall heater models 250S, 250D, 350S, 350D, 500D and 570D manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

6. That claim 2 of the patent in suit does not cover wall heater models 25S, 25D, 35S, 35D, 50D, 55D manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

Answer: Defendant is unable to formally admit or deny [66] plaintiff's request No. 6 since it has not had an opportunity to examine all of the models specified therein. On the basis of information and belief, however, it is probably true that Claim 2 in the patent in suit does cover and is infringed by wall heater models 25S, 25D, 35S, 35D, 50D and 55D manufactured and sold by the plaintiff or its predecessor, Holly Manufacturing Company.

/s/ ALWIN B. NEWTON,
Vice President, Design and Research, The Coleman
Company, Inc.

Subscribed and sworn to before me, a notary public, this 3rd day of February, 1958.

[Seal] /s/ LILLIAN A. DICKENS,
Notary Public.

My Commission Expires June 29, 1959. [67]

Affidavit of Service by Mail Attached. [68]

[Endorsed]: Filed February 11, 1958.

[Title of District Court and Cause.]

INTERROGATORIES TO PLAINTIFF

Defendant requests that the plaintiff, The Siegler Corporation, by an officer thereof competent to testify on its behalf, answer under oath, in accordance with Rule 33 of the Federal Rules of Civil Procedure, the following interrogatories: [69]

* * * * *

[Note: Interrogatories are the same as set out in Answers of Plaintiff at pages 32-34.]

Dated: February 20, 1958.

PARKER, STANSBURY, REESE &
McGEE, DAWSON, TILTON,
FALLON & LUNGMUS,

/s/ By RAYMOND G. STANSBURY,
Attorneys for Defendant. [70]

Affidavit of Service by Mail Attached. [71]

[Endorsed]: Filed February 21, 1958.

[Title of District Court and Cause.]

PLAINTIFF'S ANSWERS TO DEFENDANT'S INTERROGATORIES

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, plaintiff answers defendant's interrogatories as follows:

1. "With respect to plaintiff's 'first series' of wall heaters, including models 25NS, 25ND, 35NS, 35ND, 50ND and 57ND, can the model 35NS be taken as representative or typical of the operation of all of the models of said first series with respect to the issues in this suit? If not, state which model or models may so be taken as typical or representative."

Plaintiff's model 35NS cannot be taken as representative or typical of the operation of all the models of plaintiff's first series with respect to the is-

sues of this suit. No model [72] of plaintiff's first series may be taken as typical or representative.

2. "With respect to plaintiff's 'second series' of wall heaters, including models 250S, 250D, 350S, 350D, 500D, and 570D, can model 350S be taken as representative or typical of the operation of all of the models of said second series with respect to the issues in this suit? If not, state which model or models may be so taken as typical or representative."

Plaintiff's model 350S cannot be taken as representative or typical of the operation of all the models of plaintiff's second series with respect to the issues of this suit. No model of plaintiff's second series may be taken as typical or representative.

3. "With respect to plaintiff's 'third series' of wall heaters, including models 25S, 25D, 35S, 35D, 50D and 55D, can model 35S be taken as representative or typical of the operation of all of the models of said third series with respect to the issues in this suit? If not, state which model or models may be so taken as typical or representative."

Plaintiff's model 35S cannot be taken as representative or typical of the operation of all the models of plaintiff's third series with respect to the issues of this suit. No model of plaintiff's third series may be so taken as typical or representative.

4. "With further reference to plaintiff's 'third series' of wall heaters, is there any difference in

the operation of model 25S from model 35S with respect to the issues in this suit?"

The difference in input between the model 25S and the model 35S of plaintiff's third series of wall heaters causes [73] differences in the volume of air flow through the heaters and in the amount of heat which is transmitted from the heater to the air flowing through the heater. Plaintiff does not consider that either the 25S or the 35S can possibly be considered to infringe the defendant's patent and for that reason states that there is no difference in operation between the two models with respect to the issues of this law suit. However, to the extent that the issues of this law suit may be resolved upon a matter of degree of heat transfer or air flow, there is a difference in the operation between the two models.

Dated this 7th day of March, 1958.

CHRISTIE, PARKER & HALE,

/s/ By RICHARD B. HOEGH.

State of California

County of Los Angeles—ss.

Paul H. Hammond, being duly sworn, deposes and says that he is the Assistant Secretary of The Siegler Corporation; and that he has read the foregoing answers to interrogatories and knows the contents thereof and that the same are true of his own knowledge, except as to matters therein stated to be on information and belief, and as to those matters he believes them to be true.

/s/ PAUL H. HAMMOND.

Subscribed and sworn to before me this 7th day of March, 1958.

[Seal] /s/ BERNICE GOGO,
Notary Public in and for the County of Los Angeles, State of California. My Commission Expires May 8, 1960. [74]

Affidavit of Service by Mail Attached. [75]

[Endorsed]: Filed March 10, 1958.

[Title of District Court and Cause.]

PRETRIAL STATEMENT

The parties hereto, for the purpose of simplifying the issues, agree as follows:

1. That the defendant is the owner of United States Letters Patent No. 2,767,702. (This is referred to as the Giwosky Patent and covers a type of wall heater.)

2. That on or about December 31, 1956 the defendant, by a letter addressed to Holly Manufacturing Company, Inc., gave notice to said addressee of alleged infringement of the aforesaid patent. It is admitted that said notice was effective as to plaintiff.

3. That ever since November 29, 1955, Holly Manufacturing Company, Inc. has been, and now is, a division of plaintiff company, and is known as "Holly Manufacturing Company, a division of The Siegler Corporation." [76]

4. On February 8, 1957 plaintiff filed this action for declaratory relief, alleging non-infringement and invalidity.

5. On May 6, 1957 defendant filed its answer and counterclaim. By said counterclaim defendant seeks an adjudication of validity and infringement, an injunction and an accounting of damages.

6. Plaintiff manufactured and sold its "first series" of wall heaters from approximately 1950 to 1954 which included models 25NS, 25ND, 35NS, 35ND, 45ND and 55ND; its "second series" of wall heaters from some time in 1954 to about January, 1957 which included models 250S, 250D, 350S, 350D, 500D, and 570D; and its "third" or "current" series of wall heaters from about January, 1957 which includes models 25S, 25D, 35S, 35D, 50D, and 55D. In all the foregoing model designations the first two numerals indicate the rated capacity in thousands of B.T.U.'s and the last letter indicates whether the model is a single or double wall type (e.g. 25NS is a 25,000 B.T.U. single wall model, 350D is a 35,000 B.T.U. double wall model, etc.).

7. The Giwosky patent in suit contains two claims. Claim 1 is not in issue under the pleadings of either party. The contentions of the parties with respect to the issues herein relate to Claim 2 of said patent.

Statement of Contentions

Plaintiff's Contentions

1. The plaintiff contends that the aforesaid letters patent are invalid for the following reasons:

(a) Harry Giwosky, named in said patent as the inventor, was not the first inventor of the purported invention or inventions described or claimed in said patent; [77]

(b) The purported invention or inventions described or claimed in said patent are not patentable in view of the state of the art at the time said purported invention or inventions were made;

(c) More than one year prior to the date on which the application for said patent was filed the purported invention or inventions described or claimed in said patent were in public use and on sale in the United States;

(d) More than one year prior to the date on which the application for said patent was filed the purported invention or inventions described or claimed in said patent were described in printed publications in the United States or a foreign country;

(e) The changes and amendments in the claims and specification of the application for said patent during the prosecution of said application in the Patent Office broadened the application to embrace a purported invention not described in the original application as filed;

(f) The subject matter of said claim is not embraced in the statement of invention or claims of the original application and no supplemental oath was filed to cover the subject matter of such claim.

2. Plaintiff, with respect to the claim of invalid-

ity of the patent, will further rely on United States Patent No. 268,860, issued to Browell, December 12, 1882; United States Patent No. 2,602,441, issued to Holly Manufacturing Company July 8, 1952; the file history of the Giwosky Patent No. 2,677,702; and testimony of John H. Hollingsworth, Altadena, California. [78]

3. Plaintiff alleges that the Giwosky Patent is not infringed by any of its wall heaters.

Defendant's Contentions

1. Defendant contends that the manufacture and/or sale of plaintiff's "second series" of wall heaters and plaintiff's "current" or "third" series of wall heaters (as to each and all models of both of said series) infringe the Giwosky patent. It is not contended that plaintiff's "first series" of wall heaters would have infringed the Giwosky patent even if heaters of said "first series" were manufactured and/or sold after the issuance of said Giwosky patent.

2. Defendant contends that the Giwosky patent is good and valid in law, and that defendant's counterclaim for infringement against plaintiff cannot be defeated for any of the alleged reasons specified herein under "Plaintiff's Contentions".

3. With respect to plaintiff's "first series" of wall heaters, defendant contends that none of the heaters of this series which were manufactured and/or sold prior to October 1, 1953 (the filing date of the Giwosky patent application) were an-

ticipatory of the novel construction and arrangement of the combination wall heater and economizer covered by the patent in suit, said "first series" according to defendant's contention being constructed entirely according to plaintiff's Hollingsworth et al. Patent No. 2,602,441 without incorporating the distinctive features of defendant's Giwosky patent No. 2,767,702.

Signed at Los Angeles, California, this 25th day of March, 1958.

CHRISTIE, PARKER & HALE,

/s/ By RICHARD B. HOEGH.

PARKER, STANBURY, REESE &
McGEE,

/s/ By RAYMOND G. STANBURY. [79]

[Endorsed]: Filed March 28, 1958.

[Title of District Court and Cause.]

AFFIDAVITS, PRIOR ART PATENTS IN
SUPPORT OF PLAINTIFF'S MOTION
FOR SUMMARY JUDGMENT

AFFIDAVIT OF HARRY L. GIWOSKY

Harry L. Giwosky, being duly sworn, deposes and states as follows:

1) I am the Harry L. Giwosky who filed application Serial No. 383,472 on October 1, 1953, for improvements in wall heaters and upon which United States Patent No. 2,767,702 was granted October 23, 1956.

2) At and prior to the time that I designed the wall heater and economizer structure that is shown and described in said application I was employed by The Coleman Company at Wichita, Kansas. I left the employ of The Coleman Company in April 1954, and since that time I have been employed by David White Instrument Company in Milwaukee, Wisconsin. I am now Vice President of Manufacturing for the David White Instrument Company.

3) The Coleman Company made a practice of obtaining [81] all the heaters sold by its competitors. Prior to the time that I designed the wall heater and economizer structure that is shown and described in said patent application, I had examined and was familiar with the wall heaters equipped with secondary heat exchangers made and sold by the Holly Manufacturing Company of Pasadena, California.

4) The wall heater and economizer structure shown and described in said patent application has a third stage of heat exchange. Referring to the drawings in the patent application the third stage of heat exchange occurs between flue gases traveling upward in the flue 17 and room air drawn into the casing 22 (which surrounds the flue below the ceiling of the room) through the opening 27. This room air, after passing upwardly through the casing 22, is discharged upwardly into the annulus between the pipes 29 and 30 and thence into the attic or outside the house.

5) Prior to the time that I filed said application I had built and tested a wall heater and economizer structure similar in all respects to that shown and described in said application, except that it lacked the third stage of heat exchange referred to above and had found that such a wall heater was unsatisfactory because of overheating in the upper part of the economizer. This wall heater and economizer structure had only two stages of heat exchange. It was submitted to the American Gas Association for test and failed to pass.

6) My said application, as originally filed, was directed to a wall heater and economizer structure with three stages of heat exchange, one in the primary wall heater proper near the floor of the room and two along the flue above said wall heater. This is shown by the statement in the application as originally filed (page 2, lines 11-15) that [82]

“* * * A still further object is to provide a structure in which a plurality of cooling streams are employed in connection with the flue, the streams being introduced at the points where greatest danger of overheating is present.”

and by the statement (page 5, lines 13-26) that

“In the foregoing structure it will be observed that in addition to the air heated by the primary wall heater, there are introduced into the wall interior or into the casing 22 therein, at least two increments of cooling air. The first increment, which is entirely separate from the air being heated by the wall heater, is that increment introduced

through the openings 20 and 21, and it will be observed that this cool air is impinged upon the closure plate 18 immediately above the wall heater casing. The second point at which a dangerously high temperature might be reached is the closure 26 at the upper end of the economizer, and at this point the second increment of cool air passing inwardly through opening 27 is impinged."

7. The first point at which a dangerously high temperature might be reached in the economizer shown and described in my application is where the wall panel 12 comes in contact with the flange near the bottom of the economizer casing 22. I have marked this point "A" on the attached copy of United States Patent No. 2,767,702. The wall panel 12 may be made of combustible material and may catch fire if it is heated too highly. The closure plate 18, on the contrary, is not in contact with combustible material and represents no fire hazard even if it is highly heated. Consequently, there is no need to construct or arrange the room air inlets 20, 21, which are located above this barrier plate to cause room air admitted through these inlet means to pass over any portion of this barrier plate in [83] heat exchange relation therewith. Whether or not this room air is in heat exchange relationship with the barrier plate is of no consequence, and I have never regarded that such heat exchange relation is a part of the invention for which I filed said application.

8) As originally filed, my said application con-

tained six claims, all of which were limited to wall heater structures with three stages of heat exchange, the second and third being along the flue above the wall heater. None of these claims required that room air be brought into heat exchange relationship with the barrier plate that separates the first and second stages of heat exchange.

9) I was not informed as to any amendments made in the specification and claims of my application during its prosecution in the United States Patent Office, nor did I ever receive a request to make any oath that the subject matter of any of said amendments was part of my invention and was invented before I filed my original application. I have never made any such oath.

10) I have read United States Patent No. 2,767,702 granted October 23, 1956, and am familiar with it. I have observed that claim 1 of said patent requires the three stages of heat exchange, including the third stage without which I had found that the wall heater and economizer structure shown and described in said patent were unsatisfactory and would not meet AGA requirements. However, claim 2 of said patent makes no reference to the third stage, which prior to the time my patent application was filed, I had found to be essential to the proper operation of the device to which the patent is directed and which was required by the claims as originally filed.

11) Both claims 1 and 2 of United States Patent No. 2,767,702 require that room air introduced

into the second stage of heat exchange be brought into heat exchange relationship with the [84] barrier plate at the bottom of the economizer. As I have already stated, this heat exchange relationship is of no consequence. I never considered that the bringing about of such relationship was a part of the invention to which my application was directed and never intended to claim it as a part thereof.

12) I, Harry L. Giwosky, the affiant herein, am competent to testify to the matters herein stated.

/s/ HARRY L. GIWOSKY.

State of Wisconsin

County of Milwaukee—ss.

Subscribed and sworn to before me this 20th day of November, 1957.

[Seal] /s/ G. R. FLYNN,

Notary Public. 3-12-1961. [85]

[H. L. Giwosky Patent No. 2,767,702 dated October 23, 1956 is set out in the Book of Exhibits at page 314.]

AFFIDAVIT OF PAUL H. HAMMOND

State of California

County of Los Angeles—ss.

I, Paul H. Hammond, being duly sworn, state as follows: I am an Assistant Secretary of The Siegler Corporation and all books, records and accounts kept by The Siegler Corporation at its place of

business at 875 South Arroyo Parkway, Pasadena, California, are under my direct supervision and control. On or about November 29, 1955, The Siegler Corporation acquired all the assets of Holly Manufacturing Company, located at 875 South Arroyo Parkway, Pasadena, California. Prior to November 29, 1955, I was a Vice President of Holly Manufacturing Company. The records of Holly Manufacturing Company show that Holly's "second series" of wall heaters went into production in February, 1954, and the first sales of wall heaters in the "second series" were sales of Model 350S in April, 1954. Holly's so-called "second series" of wall heaters were sold continuously thereafter throughout the United States during the remainder of the year 1954, and the years 1955 and 1956.

/s/ PAUL H. HAMMOND.

Subscribed and sworn to before me this 28th day of March, 1958.

[Seal] /s/ LENORE TAFOYA,
Notary Public in and for said County and State.

My Commission Expires May 13, 1960. [89]

[J. H. Hollingsworth et al. Patent No. 2,602,-
441 dated July 8, 1952 and J. Browell Patent
No. 268,860 dated Dec. 12, 1882 is set out in the
Book of Exhibits at pages 317-325.]

[Endorsed]: Filed March 31, 1958.

[Title of District Court and Cause.]

NOTICE OF PLAINTIFF'S MOTION
FOR SUMMARY JUDGMENT

To: The Defendant Above-Named and to Parker, Stanbury, Reese and McGee, and Raymond G. Stanbury, Esq., its attorneys:

You and Each of You Will Please Take Notice That on Monday, April 7, 1958, at 9:30 a.m., in the courtroom of Judge William C. Mathes, Federal Building, Los Angeles, California, the plaintiff will move and now moves for a summary judgment declaring claim 2 of United States Letters Patent No. 2,767,702 invalid for the following reasons:

1. That the named inventor was not the inventor nor the first inventor of the device claimed in claim 2;
2. That the device claimed in claim 2 is anticipated by the prior art;
3. That claim 2 covers new matter not claimed in the application as originally filed; and
4. That no supplemental oath by the named inventor [165] or any other person was filed as required.

This motion will be based upon the records on file in the above designated action, the attached affidavit of Harry L. Giwosky, together with a copy of Patent No. 2,767,702, the affidavit of Paul H. Hammond, Patent No. 2,602,441 issued to Hollings-

worth, et al., Patent No. 268,860 issued to Browell, certified copy of the file wrapper of Patent No. 2,767,702, and Memorandum of Points and Authorities served and filed in support of this motion, including the admissions of the defendant set forth therein.

Dated: This 28th day of March, 1958.

CHRISTIE, PARKER & HALE,
JAMES B. CHRISTIE,
C. RUSSELL HALE,
RICHARD B. HOEGH,
ASHLEY STEWART ORR,

/s/ By RICHARD B. HOEGH,
Attorneys for Plaintiff. [166]

Affidavit of Service by Mail Attached. [167]

[Endorsed]: Filed March 31, 1958.

[Title of District Court and Cause.]

MEMORANDUM IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

Harry L. Giwosky, named as the inventor in the patent in suit, No. 2,767,702, has stated under oath that he did not invent the subject matter of claim 2 of the patent, the only claim that Coleman alleges that Siegler infringes. Siegler, therefore, moves for a summary judgment of invalidity of claim 2, on the grounds that the named inventor was not the inventor nor the first inventor of the device claimed in claim 2. Further grounds for the

motion for summary judgment are that the device claimed in claim 2 is anticipated by the prior art, that claim 2 covers new matter not claimed in the application as originally filed, and that no supplemental oath by the named inventor was filed as required by law. [168]

I.

Harry Giwosky Did Not Invent the Device
Claimed in Claim 2

The Giwosky patent in claim 2 covers devices which Mr. Giwosky did not design or consider to be part of his invention at the time his application was originally filed. Claim 2 of his patent is, therefore, invalid on the grounds that it introduces new matter and that no supplemental oath was filed. 35 U.S.C. sec. 132 provides, "No amendment shall introduce new matter into the disclosure of the invention." 35 U.S.C. sec. 115 sets forth the requirement that, "The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter or improvement thereof for which he solicits a patent."

Rule 1.67 of the Patent Office Rules of Practice requires a supplemental oath for matter not originally claimed in patent applications, as follows:

"When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention."

The Giwosky patent relates to a wall heater and economizer structure, such as this court has previously considered in the case of *Holly Manufacturing Co. v. The Coleman Co.*, No. 15,886-WM. As shown in red ink on the attached photostatic copy of the drawings of the Giwosky patent, Exhibit A to this memorandum, the Giwosky patent is directed to a structure having three stages of heat exchange. The first stage is a stream of air entering through the port 13 near the floor and discharged through the outlet grille 14 after circulating around the primary heat [169] exchanger of the wall heater. The second stage enters through the intake grille 20 at the top of the wall heater panel and is discharged through the economizer outlet grille 23 after circulating around a portion of the flue inside the economizer box. The third stage enters through the top of the economizer outlet grille at the portion designated 27 and is discharged to the attic or to the atmosphere after circulating around the upper portion of the flue.

The application for the Giwosky patent, both in its specification and its claims, as originally filed on October 1, 1953, was directed exclusively to the structure having the above-described three stages of heat exchange. Thereafter, in April of 1954, Holly Manufacturing Co. began the production and sale of its so-called second series of wall heaters, which are now charged to infringe the Giwosky patent. Holly's third series of wall heaters, which Coleman also contends infringe the Giwosky patent, were introduced in 1957.

In this action Coleman makes no claim that any of the Holly wall heaters infringe claim 1 of the patent as finally issued, since the claim is directed to a device having three stages of heat exchange and, admittedly, none of the Holly devices have a third stage of heat exchange which discharge air into the attic or to the atmosphere. (See defendant's answers to interrogatories and requests for admissions.) The Holly heaters have only two stages of heat exchange, the first being that of the stream of air which circulates around the primary heat exchanger in the lower box, and the second being that which circulates around the secondary heat exchanger or the flue within the secondary box.

After the Holly devices, now charged to infringe, appeared on the market in April, 1954, Coleman, by amendment to the Giwosky application, added claim 2 to the application to cover devices having only two stages of heat exchange. [170]

Throughout the prosecution of the Giwosky application for a patent in the Patent Office, one of the primary references asserted by the Patent Office as a bar to issuing a patent on the application was the patent to Hollingsworth et al., No. 2,602,441, which is owned by Holly and which was before this court in the case of Holly v. Coleman, No. 15,886-WM. In order to obtain a patent over the reference Hollingsworth, Coleman argued strenuously that the patentable distinction between Hollingsworth and Giwosky was the use of room air entering through the inlet grilles 20 of the Giwosky drawings at the top of the panel to sweep over the

barrier plate or top of the lower box 18 in order to maintain the top of the lower box at a relatively low temperature. As stated in the remarks to the amendment dated May 29, 1956, which appears in the attached file history of the Giwosky application:

“Neither the Hollingsworth or Bacon references can be taken as disclosing or suggesting the subject matter covered by claims 13, 19 and 20. The distinctive feature of applicant’s structure is nowhere to be found in these references. In applicant’s structure, the room air entering through inlets 20 or 21 sweeps over the upper surface of barrier plate 18 and over the lower end of the front wall section immediately above the barrier plate. Hollingsworth shows only a dead air space in this area, and the Bacon fireplace heater is obviously quite different.”

Again, in an amendment dated July 11, 1956, Coleman’s counsel argued:

“The Hollingsworth patent, which is the principal reference relied on by the Examiner, merely shows the admittedly old structure of a wall heater and economizer combination. There is a barrier plate near the top of the lower heater casing, and the lower heater casing provides a hood portion which extends above and over the forward portion [171] of the barrier plate. However, the casing hood portion is imperforate, and no provision is made for causing room air to flow over the upper surface of the forward portion of the barrier plate and into the lower portion of the economizer beneath the lower end of the front panel of the room wall.”

The specification and drawings of the Giwosky patent show that the device covered by the patent is a heater having three stages of heat exchange.

In place of the usual introduction to the specification, such as "a preferred form of my invention," the specification reads:

"The invention is shown, in an illustrative embodiment, by the accompanying drawing * * *" (Patent, Col. 1, lines 49, 50.)

The drawing shows a heater employing three stages of heat exchange. It does not show a heater employing two stages of heat exchange or air flow.

Likewise, the specification is directed only to a three-stage heater and it does not disclose or suggest a two-stage heater. For example, the specification points out:

"In the foregoing structure, it will be observed that in addition to the air heated by the primary wall heater, there are introduced into the wall interior or into the casing therein, at least two increments of cooling air." (Patent, Col. 2, lines 63 through 66.) (Emphasis added.)

The application as originally filed was directed solely to a wall heater having three stages of heat exchange. As Mr. Giwosky points out in his affidavit, which is attached hereto:

"My said application, as originally filed, was directed to a wall heater and economizer structure with three stages of heat exchange, one in the primary wall heater proper near the floor of the room and two along the flue above said wall heater."

Mr. Giwosky, prior to the time he developed

the device described and claimed in his original application for a patent, had attempted to design a device like that covered by claim 2 of his patent as finally issued. However, as Mr. Giwosky has pointed out in his affidavit, he was unable to develop such a device to the point where it would pass A.G.A. regulations. In addition, Mr. Giwosky states that the entire basis upon which Coleman obtained a patent—the use of room air to cool the barrier plate—is of no consequence.

By admission of Mr. Giwosky, the application was broadened after it was filed to include a device in claim 2 which he never considered as part of any invention he made. The broadening amendments to the application for the Giwosky patent were made in July, 1956, which was after Mr. Giwosky had left the employ of The Coleman Company, the assignee of the application. The prosecution of the application in the Patent Office was handled by patent counsel for The Coleman Company, who did not consult Mr. Giwosky at all about the prosecution of the application, and particularly did not consult him about the broadening amendment.

The device claimed in claim 2 of the patent as issued is therefore a material departure from the specification as originally filed. Under such circumstances, claim 2 is invalid for lack of a supplemental oath and for the further reason that it includes new matter; 35 U.S.C., Sec. 115.

In the case of *Chicago and Northwestern Railway Co. v. Sayles*, 97 U. S. 554, 563 (1878), the Supreme Court explained the reason for the prohibition

against enlarging claims after the original application has been filed. The Court stated:

“* * * The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the meantime, any more than it does in the case of re-issues of patents [173] previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the meantime, gone into public use.”

“Changes of language, not changing the substantial meaning as it stood before amendment, and even changes of meaning, narrowing the scope of invention described, do not infringe the statute.

“* * * if he only swears to a part, and his attorney puts in the rest, it is exactly like any other yielding to the temptation of improving an affidavit after execution * * *” *Westinghouse v. Metropolitan*, 290 F. 661, 664 (2d Cir. 1923).

“By section 4892 of the Revised Statutes the applicant is required to make oath that he believes himself to be the original inventor of the improvement for which he solicits a patent. Cody made such oath on making his original application, but did not make oath in respect to the matter brought in by the amendment. No doubt, it is competent to amend the specifications while the application is pending, so long as it is done within the scope of

the original application; but it is not competent, under color of this privilege, to introduce new matter." *Michigan Cent. R. Co. v. Consolidated Car-Heating Co.*, (6th Cir. 1895), 67 F. 121, 125.

Obviously, in view of the fact that Mr. Giwosky did not think a device like that claimed in claim 2 of the patent was an operable device, his original application cannot be construed to include such a device as part of his invention.

The material departure in claim 2 from the application as originally filed "required an oath that * * * (Giwosky would have found it impossible) to take, and for want of it the patent is void." *Steward v. American Lava Co.*, 215 U. S. 161, 168 (1909). [174]

II.

Claim 2 Was Added Long After the
Alleged Infringing Devices Appeared
on the Market and Is Therefore Void

Coleman alleges that the second and third series of wall heaters sold by plaintiff infringe claim 2 of the Giwosky patent. The second series was placed on the market in April, 1954, as set forth in the affidavit of Mr. Paul Hammond attached hereto. The third series was placed on the market in 1957. The claim which is claim 2 of the issued patent was first presented to the Patent Office in the amendment which was filed on July 11, 1956, as claim 21, which appears on pages 3 and 4 of the amendment. Thus, the only claim in issue was not presented to the Patent Office until more than two

years after plaintiff started selling the alleged infringing heaters.

The Giwosky patent, as originally filed in October, 1953, contained claims 1-6, all of which clearly required a third stage for circulation. The Holly heaters do not employ such a third stage and so were not covered by these claims.

In the amendment which Coleman filed in October, 1954, the prior claims 1-6 were canceled and new claims 7-11 were presented. Claims 7 and 8 of this amendment required a closure plate 26 positioned in the economizer below the ceiling of the room, as shown on the drawing for the Giwosky patent. The Holly heaters do not employ such a closure plate. (Defendant's answer to Interrogatory 28.) Hence these two claims do not read on the Hollingsworth design. Claims 9-11 of this amendment in the Giwosky application specify three stages of heat exchange and, therefore, do not read on the Hollingsworth, et al. design.

In an amendment dated November 14, 1955, Coleman canceled all of the claims in the application and substituted new claims 12-18. With reference to these new claims Coleman stated on page 12 of the amendment that "The newly added claims carefully define [175] the structural arrangement conceived of by applicant, and in so doing these claims recite a wall heater and economizer assembly wherein three distinct air flow patterns are present." (Emphasis added.)

Thus, in November of 1955, Coleman was urging allowance of claims which were directed only to

wall heaters employing three stages of heat exchange or air flow. Claim 18, which was presented in this amendment became claim 1 of the issued patent, and Coleman admits that claim 1 does not cover the Holly heaters.

In December, 1955, the Patent Office gave a final rejection to the Giwosky patent application, indicating, however, that the subject matter of claims 14 and 18 might be allowable if they were modified to more clearly define the invention. Claim 18 was so modified and it became claim 1 of the patent which is not in issue in this proceeding. Claim 14 was directed to the details of the inlet 20 shown on the Giwosky patent drawings, such as the inclined top wall 19 in which the inlet 20 is located and the vanes in the inlet air to the barrier plate 18. These matters are not in issue in the present proceedings.

On May 29, 1956, Coleman submitted a further amendment in the application, but the Patent Office found that that amendment did not place the application in condition for allowance. Thereafter, Coleman filed a notice of appeal and, on July 11, 1956, submitted an amendment, including claim 21, which became claim 2 of the issued patent.

Thus, the only claim which is in issue in this proceeding was not submitted until more than two years had elapsed since the first sale of plaintiff's wall heaters, which are alleged to infringe, and not until after the application had been given a final rejection and a notice of appeal had been filed. Coleman's prior claims were all of much more lim-

ited scope and clearly did not read on the Holly heaters. [176]

In the case of Webster Electric Company v. Splitdorf Electric Company, 264 U. S. 792, 793, the Supreme Court considered the validity of amended claims which enlarge the scope of claims originally filed after competitive devices had appeared on the market. The Court stated:

“* * * But, this aside, the evidence establishes to our satisfaction that Kane did not originally intend to assert these amended claims, because he considered their subject matter one merely of design, and not of invention; and the inference is fully warranted that the intention to do so was not entertained prior to 1918. During all of this time their subject matter was disclosed and in general use; and Kane and his assignee, so far as claims 7 and 8 are concerned, simply stood by and awaited developments.”

The Court went on to say, on page 794:

“* * * The subject matter of these claims is not of such character that it might not have been readily described in the original application or in one of the subsequent applications,—in 1915, for example,—as it was described in 1918; and the long delay of Kane and his assignee in coming to the point tends strongly to confirm the view that the final determination to do so was an exigent afterthought, rather than a logical development of the original application.”

The United States patent laws require that patents be applied for in the name of the person or

persons who made the invention, 35 U.S.C., Sec. 101. A corporation can acquire title to an invention only through the person or persons who made the invention. In the present case, Coleman acquired title to the application by assignment. Hence, Coleman acquired only the invention which Mr. Giwosky made. Mr. Giwosky has stated under oath that he did not invent the subject matter of claim 2 of the patent. [177] In fact, claim 2 was added by Coleman as "an exigent afterthought" long after the alleged infringing devices appeared on the market. Hence, claim 2 is invalid, and Coleman is not entitled to this claim.

III.

Coleman's Immaterial Variance From the Prior Art Is Not Patentable

Both this Court and the Court of Appeals have considered the inconsequential differences between the Coleman design and the wall heaters described and claimed in the Holly patent, No. 2,602,441, previously before this Court in the case of *Holly v. Coleman*, No. 15,886-WM.

The file wrapper of the Giwosky patent, particularly the amendment dated July 11, 1956, provides Coleman's reasons for its assertion that the Giwosky device is patentable over the patent to Hollingsworth, et al., No. 2,602,441. The purported patentable difference between Hollingsworth and claim 2 of Giwosky is the use of room air to cool the top of the lower box in the second stage of heating in Giwosky—the air that is warmed by cir-

culation through the second box or economizer. Giwosky merely added an air source for the economizer through the inlet grilles at the top of the panel on Coleman's production-model wall heaters which have been held to infringe the Hollingsworth patent. The Court of Appeals found that Coleman copied the Hollingsworth, et al. design with "immaterial variances." 233 F. 2d 71, 84.

Coleman, through its representatives, has admitted that the "immaterial variances" by which the Giwosky device differs from the Hollingsworth device are completely anticipated by the early patent and Browell. Coleman's Mr. Kice testified as follows:

"Now we have only been talking about fireplaces which are commonly thought of as made out of brick or stone. But back in 1882 Mr. Browell—the patent, we don't have the [178] number.

Mr. Lyon: Exhibit I.

The Witness: Exhibit I.—showed a ventilated flue stack, as I have illustrated here in green on the overlay, which was made out of metal; has an inlet opening at the intermediate height above the first box. And the air that is used to ventilate the flue and keep it cool is then discharged into the room and utilized for the sake of economy. That is the first economizer as it is used in the Coleman design." (R. 354-355.)

The design covered by Giwosky's patent differs from Coleman's production model wall heaters, since the production models utilize air from around the lower box and the design in the patent pro-

vides a structure in which air entering the bottom of the economizer "is entirely separate from the air heated by the wall heater." (Patent, Col. 2, lines 67, 68.) Such separation of the primary and secondary stages of heat exchange are shown by Browell. The lack of invention in claim 2 over the references Hollingsworth and Browell was made clear in colloquy between the Court and Mr. Lyon, counsel for Coleman:

"The Court: Upon what basis does the defendant claim an invention was taking in of air in the front?

Mr. Lyon: I do not know, your Honor. We haven't got a patent. Many manufacturers, as your Honor knows, will file an application to protect himself from having somebody filing on the same thing. Now, I don't know what the principle was that they filed on this. We didn't say we had a patent. In fact, I can state to this Court we don't.

The Court: I assume someone made an affidavit with respect to the patent.

Mr. Lyon: That he thought it was an invention at the time he drew it. But I can tell the Court right here and now that the application was rejected on the Browell patent, if you are [179] interested in that." (Transcript, p. 687, Jan. 24, 1955.)

Doubtless, Mr. Lyon must have considered the Browell patent to be most relevant on the issue of whether the Giwosky device represented patentable invention. Otherwise, as one of Coleman's patent counsel, he would have known the basis on which

Giwosky claimed an invention in the patent now before this court and would not have made the statement, “* * * the application was rejected on the Browell patent.”

Despite the importance of Browell attested to by Coleman’s Mr. Kice and Mr. Lyon, the file wrapper of the Giwosky patent shows that Browell was not cited as a reference against the Giwosky application. As this Court observed in a recent similar case:

“One reads the file wrapper and wonders upon what possible ground the letters in suit issued * * * over the prior art cited.” *Delco Chemicals, Inc. v. Cee-Bee Chemical Co.*, 157 F. Supp. 583, 590, (S. C. Cal., 1957).

A multo fortiori then, in view of the uncited prior art which Coleman admits to be an anticipation of its “immaterial variance” from the Hollingsworth patent, no “possible ground” exists for sustaining validity of the patent in suit. Plaintiff submits that the easy combination of the devices disclosed in the Hollingsworth and Browell patents fully anticipates the patent issued to Coleman. [180]

IV.

The Presumption of Validity Does Not Prevent Awarding Summary Judgment Against Coleman

This court has held:

“Since there is no rational basis upon which to rest it, the presumption of validity cannot extend beyond the scope of the administrative record—the

file wrapper of the patent as issued. So the presumption that a patent is valid, as embodying an invention over the prior art, does not subsist as to pertinent prior art not cited or considered by the Patent Office in passing on the application for the patent." *Delco Chemicals, Inc. v. Cee-Bee Chemical Co.*, 157 F. Supp. 583, 587.

Thus the presumption of validity over the references of record is not available as to the Browell patent, which admittedly is most pertinent.

An additional factor further destroys the presumption of validity in the case at bar; namely, misleading the Patent Office.

Mr. Giwosky in his affidavit filed with this memorandum unequivocally states that cooling the barrier plate or top of the lower box is of no significance in the wall heater structure he designed.

As he has pointed out in his affidavit:

"* * * The closure plate (barrier plate) 18 * * * is not in contact with combustible material and represents no fire hazard even if it is highly heated. Consequently, there is no need to construct or arrange the room air inlets 20, 21 which are located above this barrier plate to cause room air admitted through these inlet means to pass over any portion of this barrier plate in heat exchange relation therewith. Whether or not this room air is in heat exchange relationship with the barrier plate is of no consequence, and [181] I have never regarded that such heat exchange relation is a part of the invention for which I filed said application."

Yet in an attempt to distinguish the Giwosky

device over the Hollingsworth et al. patent, and in an endeavor to overcome the Final Rejection by the Patent Office dated December 21, 1955, counsel for Coleman relied upon this very feature as constituting the patentable distinction of the Giwosky device over the Hollingsworth et al. patent.

In an amendment filed July 11, 1956, Coleman represented to the Patent Office:

“The Hollingsworth patent, which is the principal reference relied on by the Examiner, merely shows the admittedly old structure of a wall heater and economizer combination. There is a barrier plate near the top of the lower heater casing, and the lower heater casing provides a hood portion which extends above and over the forward portion of the barrier plate. However, the casing hood portion is imperforate, and no provision is made for causing room air to flow over the upper surface of the forward portion of the barrier plate and into the lower portion of the economizer beneath the lower end of the front panel of the room wall.

“The portion of the room wall front panel immediately above the barrier plate has provided a serious problem of temperature control. Since wall heaters operate on a gravity flow, it is necessary to discharge the air at high temperatures, i.e. 250° to 350° C. This means that air at quite high temperatures heats the under surface of the barrier plate, which also receives heat from the flue that passes therethrough. Excessive heat would be likely

to be transmitted from the upper surface of the barrier plate to the lower end of the front room wall panel with the construction shown in the Hollingsworth patent. Code regulations enforced quite [182] generally throughout the United States specify that the room wall will not be heated at any point more than 90° F. above room temperature. Heating above the code limitation would be quite likely to occur with the Hollingsworth construction, while the problem is overcome with applicant's construction."

Thus, the assignee of Mr. Giwosky's patent application has misled the Patent Office as to the nature of the device designed by Mr. Giwosky. By Mr. Giwosky's own admission the feature which Coleman used to convince the Patent Office that a patent should be issued over the reference Hollingsworth Holly patent was a detail which Mr. Giwosky considered to be of no importance. In Coleman's amendment dated May 29, 1956, Coleman states with reference to the area just above the top of the lower box that Hollingsworth et al "shows only dead air space in this area," and in its amendment dated July 11, 1956, that "heating above the code limitation would be quite likely to occur with the Hollingsworth construction, while the problem is overcome with applicant's (i.e., Giwosky's) construction."

However, the area in question in the Hollingsworth et al device is in direct communication with and forms a part of the air passageway (designated

No. 41 in the Hollingsworth et al patent) around the secondary heat exchanger which, in turn, receives air from the space (designated No. 24 in Figs. 3 and 4 of the Hollingsworth et al patent) about the sides and the back of the lower box or primary heater. Hence, the Hollingsworth et al patent does not show only dead air space in this area as represented by Coleman in its endeavor to find a patentable distinction between the Giwosky design and the Hollingsworth et al design.

Also, the Hollingsworth et al design has been sold commercially since 1950 and approximately 300,000 heaters had been sold by plaintiff prior to the date on which Coleman made these [183] representations to the Patent Office, as shown by the record in *Holly Manufacturing Co. v. The Coleman Company*, No. 15,886-WM. Admittedly, the Hollingsworth et al design meets the A.G.A. requirements concerning room wall temperatures, otherwise the Hollingsworth et al heaters would not have been saleable. Coleman's representation that "Heating above the code limitation would be quite likely to occur with the Hollingsworth construction" is plainly incorrect.

Not long before Coleman represented to the Patent Office that cooling the top of the lower box would be a serious problem in the Hollingsworth et al heater, Coleman's Mr. Kice testified that the Hollingsworth et al heater took room air "up through the columns of the trim * * * into the

space above the lower box * * * into the secondary heat exchanger.” (R. 359.)

Thus, in addition to misleading the Patent Office as to the importance of the certain features of the device claimed in claim 2, Coleman represented that the Hollingsworth et al device had a dead air space above the barrier plate, where as a matter of fact it employs an arrangement which is the equivalent of the basis Coleman urged to obtain a patent over Hollingsworth et al.

In the case of *Floridin v. Attapulugus Clay Co.*, 35 F. Supp. 810, 814 (D. Del. 1940), affirmed 125 F. 2d 669 (3rd Cir. 1942), the court under the same circumstances held:

“It now appears from Fitzsimmons’ test sheets which he did not furnish to the Patent Office and also from his testimony in this case that the tests to which Fitzsimmons refers actually gave results exactly opposite to those stated by him in his affidavit.

* * * * *

“The presumption of validity of the Hartshorne patent is destroyed because the Patent Office was induced to allow the Hartshorne patent over the Ikeda patent by misrepresentations [184] regarding the process disclosed in the Ikeda patent.”

By such misrepresentations made to the Patent Office to obtain a patent, Coleman has destroyed all presumptions of validity of its patent, even as to references of record.

Conclusion

There is no genuine issue as to the following:

(1) Harry L. Giwosky did not invent the subject matter of claim 2.

(2) No supplemental oath was filed as to the subject matter of claim 2.

(3) Claim 2 broadened the scope of the original application to include new matter long after the devices now alleged to infringe claim 2 appeared on the market.

(4) Claim 2 is not patentable over pertinent prior art.

(5) No presumption of validity over the prior art exists as to claim 2.

This course should therefore summarily declare claim 2 invalid.

Dated this 28th day of March, 1958.

Respectfully submitted,

CHRISTIE, PARKER & HALE,
JAMES B. CHRISTIE,
C. RUSSELL HALE,
RICHARD B. HOEGH,
ASHLEY STEWART ORR,

/s/ By C. RUSSELL HALE,

/s/ RICHARD B. HOEGH,

Attorneys for Plaintiff. [185]

[Endorsed]: Filed March 31, 1958.

Oct. 23, 1956

H. L. GIWOSKY

2,767,702

WALL HEATER AND ECONOMIZER STRUCTURE

Filed Oct. 1, 1953

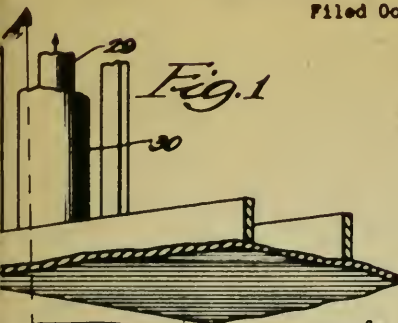
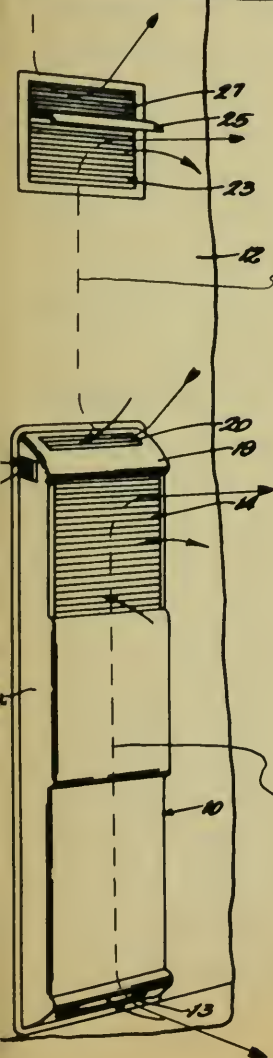


Fig. 1

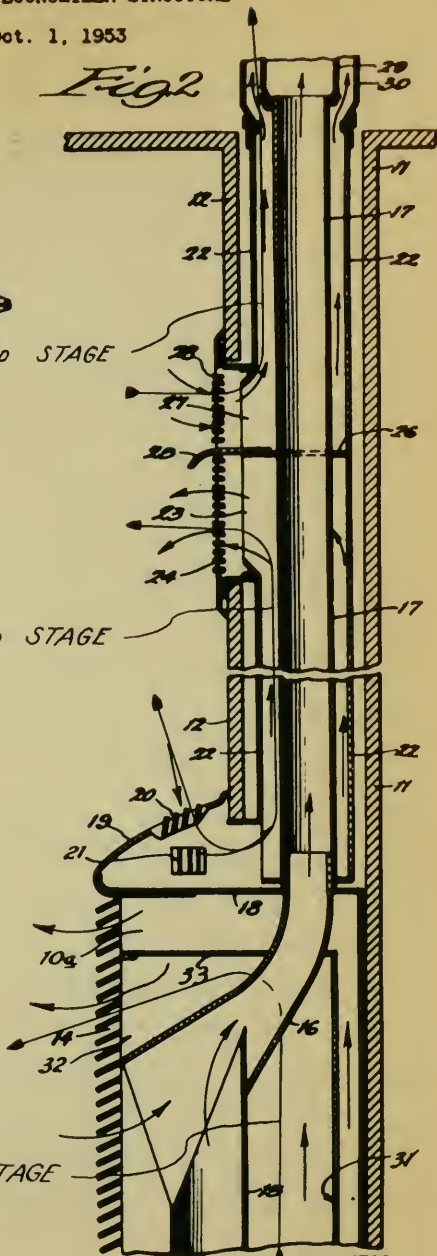


3RD STAGE

2ND STAGE

1ST STAGE

Fig. 2



INVENTOR:

Harry L. Giwosky,

BY

Dawson, Tiltner & Graham,
ATTORNEYS

[Title of District Court and Cause.]

MEMORANDUM IN OPPOSITION TO
MOTION FOR SUMMARY JUDGMENT

Plaintiff's motion for summary judgment is plainly improper on its face. The motion raises a plethora of triable issues which your Honor cannot be expected to decide without hearing all of the relevant evidence. In accordance with the local rule, however, Defendant has filed a full statement of the genuine factual issues raised by Plaintiff's involved assertions, but it is believed that there is no need to go into this matter in detail. As your Honor will immediately recognize, Plaintiff's motion raises complex questions concerning the scope and interpretation of the patent in suit and its relation to the prior art. On such matters the Court should have the benefit of testimony.

Plaintiff's motion purports to be supported by an affidavit of Defendant's former employee and the inventor of the patent in suit, Harry L. Giwosky. This affidavit is misleadingly incomplete and is couched in phraseology giving rise to completely false inferences. Mr. Giwosky has at Defendant's request executed a further affidavit, as submitted herewith, which directly rebuts the dubious assertions made in Plaintiff's Memorandum as allegedly supported by statements [194] in the first Giwosky affidavit.

Plaintiff's Memorandum, for example, opens with the blatant assertion that Harry L. Giwosky "has

stated under oath that he did not invent the subject matter of Claim 2" of his patent. Nothing could be further from the truth. Mr. Giwosky did not make such a statement in the affidavit filed by Plaintiff. The facts are as described in paragraphs 2-4 of Mr. Giwosky's second affidavit which was executed at Defendant's request. As stated in the concluding sentences of this portion of the second Giwosky affidavit:

"My patent 2,767,702 describes this means of cooling the upper end portion of the economizer, as well as the other cooling means at the lower end of the economizer previously described. To the best of my knowledge and belief I am the first and sole inventor of both of these cooling means as applied to economizer-equipped gas wall heaters, and there had been no public use or public disclosure in a printed publication of either of these cooling means more than one year before October 1, 1953, the filing date of my patent 2,767,702."

Plaintiff's Memorandum contains the further extravagant statement (p. 6):

"In addition, Mr. Giwosky states that the entire basis upon which Coleman obtained a patent—the use of room air to cool the barrier plate—is of no consequence."

This is like arguing that the act of turning off a radiator in a room is of "no consequence" since the object to be accomplished is to cool the room and not the radiator per se. Obviously, however,

the cooling of the radiator is the means to the desired end. As explained by Mr. Giwosky in his second affidavit:

“As stated in my patent application as originally filed, this room air ‘impinged upon the closure plate’, and would thereby necessarily be in heat exchange relation with said plate. The ultimate objective was to reduce the heat transferred to the adjacent wall members of the room in which the heater would be installed. In my opinion the room air inlet just described accomplished this objective.” [195]

The affidavit of Alwin B. Newton also submitted by Defendant further elucidates the matter:

“I further agree with Mr. Giwosky’s statement that the object of providing a room air inlet opening immediately above the closure plate was to correct the overheating in that area. There was no need, as indicated by Mr. Giwosky, to cool the closure plate as such. However, I am sure that Mr. Giwosky did not mean to convey any such erroneous idea as that the ‘impingement’ of the room air on the upper surface of the closure plate does not function as a means for reducing the temperatures at the lower end portion of the room wall. (The area identified by the Letter ‘A’). Obviously it does. Whenever a stream of cool air contacts a hot metal plate it is necessarily and inevitably in ‘heat exchange’ relation with the plate. Thus, the circulation of room air over the closure plate as illustrated and described in the Giwosky patent will

lower the temperature of the closure plate, thus in-turn reducing the amount of heat radiated to the surrounding room wall elements.”

Discussion of Motion

Basically, Plaintiff's motion involves two contentions. The first contention is that Claim 2 of the Giwosky patent is directed to a materially different invention from any subject matter that was disclosed in the original specification and/or covered by any of the initial claims. Plaintiff's second contention is the usual one that the Giwosky patent is invalid because of anticipation by an asserted combination of prior art patents. To decide either of these questions on a motion for summary judgment would require the Court to read and interpret the patent in suit, its file wrapper, and the prior art without the benefit of testimony. Such a procedure could be adopted only where: (1) the meaning of the patent specification, claims and prior art are so clear that they do not require elucidation by factual testimony, and (2) where there are no conflicting interpretations of the specification, claims or prior art. *Park-In Theatres v. Perkins* (C.A. 9, 1951), 190 F. 2d 137, 142. Clearly, that is not the present case. [196]

Alward v. Jordan Marsh Co. (D. Mass., 1953), 111 F. Supp. 758, is a case directly in point. In denying a motion for summary judgment on the same issue raised by Plaintiff herein the Court stated (p. 759):

“Defendant contends that the additions admit-

tedly made to Alward's application were substantial and material. Plaintiff argues that they were not. This is a material issue of fact on which the parties are in dispute." (emphasis added.)

The basis on which Siegler is attempting to attack Coleman's patent is in fact peculiarly inappropriate for determination on summary judgment. A patent applicant is given great latitude in amending his specification and claims. *Glade v. Walgreen Co.* (C.A. 7, 1941), 122 F. 2d 306, 311; *Coats Loaders & Stackers, Inc. v. Henderson* (C.A. 6, 1956, 233 F. 2d 915, 924; *Carson v. American Smelting & Refining Co.* (C.A. 9, 1925), 4 F. 2d 463, 470-471.

As held in the *Coats Loaders* case (p. 924):

"What occurred during the prosecution of the Henderson application was what often occurs in the course of extensive prosecution in the Patent Office: the claims of the application were substantially amended in order to clearly delineate the invention in relation to the prior art. The claims to the sub-combination finally allowed were so different from the combination originally advanced that the specification was amended to provide a more direct correspondence between the disclosure and the claims. We do not understand that *Muncie Gear* decision defeats the validity of claims finally issuing after such a Patent Office history, despite an intervening public use, so long as there was in the original application a full disclosure of the invention finally claimed, as we have found that there was here."

It is Coleman's position in the present suit that

Claim 2 of the Giwosky patent not only is adequately supported by the original specification, which is all that the foregoing cases require, but that additionally and even more conclusive is the fact that the invention covered by Claim 2 was at all times part of the subject matter to which claims were directed, both originally and throughout the prosecution of the Giwosky application. Stated otherwise, it is Defendant's position that the alleged departure from the Giwosky application [197] as originally filed, reduces to a mere quibble over terminology.

Plaintiff's contention that the Giwosky patent should be held invalid as anticipated by the Browell patent hardly deserves discussion on a motion for summary judgment. Plaintiff now says that the old Browell patent (No. 268,860 of 1882) in the fireplace art is relevant to the design of recessed gas wall heaters. It was not so very long ago, however, that the Court of Appeals for this Circuit affirmed your Honor's holding to the contrary, and at the urging of Plaintiff's predecessor in business, the Holly Company. *The Coleman Company, Inc. v. Holly Manufacturing Company* (C.A. 9, 1956), 233 F. 2d 71, 77, 83.

The attempted reliance of Plaintiff on its own Hollingsworth patent is likewise misplaced. The Patent Office expressly held that Giwosky had invented patentable improvements in economizer-equipped gas wall heaters over anything taught in the Hollingsworth patent. The fact that the Giwosky heater was held to infringe the Hollings-

worth patent is completely irrelevant to the present controversy. As set out more fully in the affidavit of Mr. Newton, Coleman contends that Holly redesigned its wall heaters after the introduction of the Giwosky heater by Coleman, and that the redesigned Holly heater included one of the improvements invented by Giwosky. Clearly, Holly's ownership of the Hollingsworth patent gave it no right to appropriate a later developed improvement of a competitor.

Respectfully submitted,

PARKER, STANBURY, REESE &
McGEE,

/s/ By RAYMOND G. STANBURY,
Attorneys for Defendant.

Of Counsel:

Timothy L. Tilton, Dawson, Tilton, Fallon &
Lungmus. John F. Eberhardt, Foulston, Sief-
kin, Schoeppel, Bartlett & Powers. [198]

Affidavit of Service by Mail Attached. [199]

[Endorsed]: Filed May 1, 1958.

[Title of District Court and Cause.]

AFFIDAVITS SUBMITTED BY DEFENDANT
IN OPPOSITION TO PLAINTIFF'S MO-
TION FOR SUMMARY JUDGMENT

The attached affidavits of Alwin B. Newton and Harry L. Giwosky are being submitted by Defendant-Counterclaimant in opposition to Plaintiff's

motion for summary judgment pursuant to Federal Rule 56.

The affidavit of Mr. Newton establishes the real and substantial nature of the controversy herein where the basic issue is whether Plaintiff has appropriated the inventive subject matter of Claim 2 of the Giwosky patent. This affidavit also directly controverts Plaintiff's interpretation, or rather misinterpretation, of the Giwosky patent and file wrapper.

The Giwosky affidavit supplements and clarifies his prior affidavit that was executed at Plaintiff's request. When the first and second Giwosky affidavits are read together it is clear that there is no basis for Plaintiff's assertion that Giwosky did not invent the subject matter of Claim 2 of his patent. Mr. Giwosky's second affidavit also establishes that Plaintiff's contention with regard to the phrase "heat exchange relation" is a mere quibble [201] over a minor point of terminology.

Respectfully submitted,

PARKER, STANBURY, REESE &
McGEE,

/s/ By RAYMOND G. STANBURY,
Attorneys for Defendant,

Of Counsel:

Timothy L. Tilton, Dawson, Tilton, Fallon &
Lungmus. John F. Eberhardt, Foulston, Sief-
kin, Schoepfel, Bartlett & Powers. [202]

AFFIDAVIT OF ALWIN B. NEWTON

State of Illinois,
County of Cook—ss.

Alwin B. Newton, being duly sworn, deposes and states as follows:

1. I am Vice President in charge of design and research for The Coleman Company, the defendant and counterclaimant in the above-identified suit. I hold bachelor's and master's degrees in mechanical engineering, respectively from Syracuse University and from Massachusetts Institute of Technology. I have had rather extensive industrial experience with heating, ventilating, and air conditioning equipment. Since I came to The Coleman Company in 1953, I have been directly concerned with the design, operation, and manufacture of gas wall heaters. [203]

2. I am familiar with Giwosky patent 2,767,702 and with the wall heaters which The Coleman Company formerly manufactured in accordance with this patent. Before the inventor of that heater, Mr. Giwosky, left The Coleman Company to accept employment elsewhere, I had the opportunity on a number of occasions of discussing with Mr. Giwosky the design and experimental work which resulted in the wall heater described in his patent 2,767,702. This patent was assigned by Mr. Giwosky to The Coleman Company while he was in its employment, and the inventions described in said patent are the property of The Coleman Company.

3. In 1954 the Holly Manufacturing Company introduced a new line of gas wall heaters, which in my opinion included a feature that to my knowledge had previously been offered commercially only on the line of wall heaters which The Coleman Company began selling late in 1952. Holly had a line of wall heaters on the market during the years 1952 and 1953, but the wall heaters it was selling in those years did not provide a room air inlet on the front of the heater immediately above the closure plate for the lower heater box. The line of heaters which Holly introduced in 1954, however, did provide such an opening.

4. Exhibit A attached hereto is a photograph of the front of a Holly wall heater Model 350S. The heater as shown is complete, including both the lower heater and the economizer, but the louvered grill member has been removed from the top of the outer case. As indicated on Exhibit A there is an opening "O" immediately above the closure plate "P" which is approximately 11½ inches high and 12 inches long. This is the opening previously referred to which was provided on the new line of heaters introduced by Holly in 1954. The model shown in Exhibit A is a 35,000 BTU single outlet unit, which is the capacity and type of heater that was stipulated to be representative [204] in the suit between Holly and Coleman involving Hollingsworth patent 2,602,441.

5. To my knowledge Holly (now a part of The Siegler Corporation) continued to offer for sale the

line of wall heaters represented by the model of Exhibit A until sometime during the early part of 1957. At that time, Holly, or rather The Siegler Corporation introduced a third new line of wall heaters. This third line of wall heaters still had the opening above the closure plate, notwithstanding the fact that Holly was notified in December, 1956 that this opening was claimed by Coleman to infringe the Giwosky patent. Exhibit B attached hereto is a photograph showing the front with the louvered grill removed of the 35,000 BTU single outlet model, (identified as "35S") of this new line. It will be observed that the opening "O" above closure plate "P" still has a width of approximately 12 inches and a height of about $11\frac{1}{4}$ inches.

6. I have studied the operation of the Holly heaters as illustrated by the models of Exhibits A and B. It is my opinion that in the Holly heaters enough room air enters the opening "O" above closure plate "P" to appreciably reduce room wall temperatures in this area, as described in Giwosky patent 2,767,702.

7. The Holly heaters, as represented by Exhibits A and B, do not include the additional cooling means consisting of a third heat exchange stage as also described in the Giwosky patent. This is in itself a clear demonstration that the feature described in the Giwosky patent of circulating room air over the closure plate of the lower heater box is capable of use independent of the third heat exchange stage. As described to me by Mr. Giwosky

on a number of occasions, this particular room air inlet feature was designed to solve the problem of overheating in the room wall areas immediately [205] above the closure plate, and therefore could advantageously be incorporated in any economizer-equipped wall heater where this problem presented itself.

8. During the accounting trial in the suit involving the Hollingsworth patent 2,602,441 (Holly Manufacturing Company v. The Coleman Company, Inc., No. 15,886-WM Civil), I testified about how the infringing Coleman heaters could have been redesigned to completely eliminate the passage of air from the lower wall space over the closure plate and into the economizer inlet. (Accounting Tr. 974-975, 977-983.) I further presented in that proceeding an overlay drawing illustrating one way in which this might have been done. (Accounting Exhibit BB.) Since the conclusion of the accounting trial I have built and tested experimentally a heater operating like that shown in the accounting trial Exhibit BB. My tests again confirmed that the wall temperatures in the area above the closure plate were improved (that is reduced) by the complete exclusion of lower wall space air from the economizer. This finding confirms the utility of the Giwosky direct room air inlet principle whereby the economizer is supplied with room air rather than with lower wall space air. An important aspect of the Giwosky principle from an engineering standpoint is that the cool room air contacts the upper surface of the closure plate thereby reducing

the temperature of this plate which in turn reduces the amount of heat radiated to the adjacent room wall areas.

9. I have read the affidavit of Harry L. Giwosky which has been filed by the Plaintiff Siegler. I am in complete agreement with Mr. Giwosky's statement that one of the principal areas where overheating occurs in gas wall heaters is that marked "A" on the patent drawing attached to Mr. Giwosky's affidavit. I further agree with Mr. Giwosky's statement that the object of providing a room air [206] inlet opening immediately above the closure plate was to correct the overheating in that area. There was no need, as indicated by Mr. Giwosky, to cool the closure plate as such. However, I am sure that Mr. Giwosky did not mean to convey any such erroneous idea as that the "impingement" of the room air on the upper surface of the closure plate does not function as a means for reducing the temperatures at the lower end portion of the room wall. (The area identified by the letter "A"). Obviously it does. Whenever a stream of cool air contacts a hot metal plate it is necessarily and inevitably in "heat exchange" relation with the plate. Thus, the circulation of room air over the closure plate as illustrated and described in the Giwosky patent will lower the temperature of the closure plate, thus in-turn reducing the amount of heat radiated to the surrounding room wall elements.

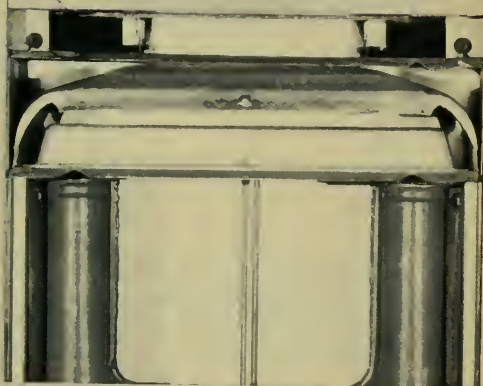
10. I have read Claim 2 of the Giwosky patent

and considered the language of this claim in relation to the operation of the heater described in that patent. It is my opinion that Claim 2 constitutes an accurate and complete description of what occurs when room air is circulated over the closure plate and beneath the lower end portion of the room wall. The "room air inlet means" as recited in Claim 2 refers to the inlets 20, 21 of the patent drawing. This "room air inlet means", as further recited in Claim 2, is "constructed and arranged to cause room air to pass over the upper surface of said barrier plate forward portion (the closure plate 18) in heat exchange relation therewith." Furthermore, Claim 2 is complete even though it does not require the third heat exchange stage. Either of the direct room air cooling means of the Giwosky patent are capable of separate use. A heating engineer reading this patent would recognize, for example, that the feature of having cool room air circulate over the top of the closure plate 18 solved a separate problem than the other cooling feature.

/s/ ALWIN B. NEWTON.

Subscribed and sworn to before me this 15th day of April, 1958.

[Seal] /s/ GENEVIEVE M. PRATT,
Notary Public. [208]



POLYPROPS Product Data

MID-CONTINENT ENGRAVING COMPANY

WICHITA 1 KANSAS

HOLLY
350S

#1555

Exhibit 1

AFFIDAVIT OF HARRY L. GIWOSKY

State of Wisconsin,
County of Milwaukee—ss.

Harry L. Giwosky, being duly sworn, deposes and states as follows:

1. I am the Harry L. Giwosky who previously signed an affidavit at the request of the Siegler Corporation in connection with a lawsuit involving my patent 2,767,702, which I had assigned to the Coleman Company. At the request of the Coleman Company I am now supplementing my prior affidavit.

2. The Holly wall heaters that I had examined prior to October 1, 1953, the date on which I made application for my patent 2,767,702, were equipped with secondary heat exchangers or economizers receiving their air supply from the wall space around the lower heater box, as described in Hollingsworth et al patent 2,602,441, with which I am familiar. There was no opening in the Holly heaters for the direct admission of room air to either the lower portion or the upper portion of the economizers.

3. During the design and experimental work leading to the wall heater described in my patent 2,767,702, I first encountered a problem of overheating in the area immediately above the closure plate of the primary heater box. To overcome this problem I provided an opening in the heater just above this closure plate through which cool room air could circulate. As stated in my patent appli-

cation as originally filed, this room air "impinged upon the closure plate", and would thereby necessarily be in heat exchange relation with said plate. The ultimate objective was to reduce the heat transferred to the adjacent wall members of the room in which [211] the heater would be installed. In my opinion the room air inlet just described accomplished this objective.

4. At a later time, I encounter another problem of overheating. This occurred in the wall area around the upper end portion of the economizer. This difficulty was corrected by providing a third heat exchange stage whereby a separate increment of cool room air was passed around the flue at the upper end of the economizer. My patent 2,767,702 describes this means of cooling the upper end portion of the economizer, as well as the other cooling means at the lower end of the economizer previously described. To the best of my knowledge and belief I am the first and sole inventor of both of these cooling means as applied to economizer-equipped gas wall heaters, and there had been no public use or public disclosure in a printed publication of either of these cooling means more than one year before October 1, 1953, the filing date of my patent 2,767,702.

5. The heater which was approved by AGA and which Coleman manufactured and sold commercially starting in late 1952 had both of the cooling means previously described. This Coleman heater therefore differed in these two important respects

from the Holly heater as sold up to that time. In my opinion, however, the wall temperatures in front of the economizer of the Holly heaters would have been improved by incorporating in the Holly heaters one or both of the cooling means described in my patent 2,767,702. If there was a need for reducing the front wall temperatures in the area immediately above the closure plate of the primary heater, then it would be desirable to provide for the circulation of cool room air beneath the lower end of the room wall and over the upper surface of the closure plate as described in my patent. This could be done independently of the passing of room air around [212] the flue in the upper portion of the economizer, as also described in my patent. I preferred to employ these two cooling means jointly but this does not mean that they were incapable of separate use.

/s/ HARRY L. GIWOSKY.

On this 14th of April, 1958, before me a notary public of the State and in the county aforesaid appeared Harry L. Giwosky, personally known to me, and made the foregoing statement of paragraphs 1 to 5 inclusive upon oath and as his free and voluntary act.

[Seal] /s/ G. R. FLYNN,

Notary Public. 3/12/1961 [213]

Affidavit of Service by Mail Attached. [214]

[Endorsed]: Filed May 1, 1958.

[Title of District Court and Cause.]

STATEMENT OF GENUINE ISSUES

Now comes Defendant-Counterclaimant, The Coleman Company, and states that Plaintiff's motion for summary judgment is not well founded as to any of the four grounds asserted by Plaintiff because genuine, material, and triable issues of fact exist as to each of said grounds, as more particularly specified below.

First Ground

(1) Did Harry L. Giwosky invent the subject matter of Claim 2 of Patent No. 2,767,702?

(2) Was the subject matter of Claim 2 of Patent 2,767,702 described in the specification of the application for said patent as originally filed?

(3) Was Claim 3 of the Giwosky application as originally filed directed to substantially the same invention as Claim 2 of the issued patent? [216]

(4) Was there at all times from the date of original filing to the date of issuance of the Giwosky patent at least one claim before the Patent Office directed to substantially the inventive subject matter of Claim 2 of the issued patent?

(5) Is Claim 1 of the Giwosky patent directed to a different invention from Claim 2 of the same patent?

(6) What bearing, if any, do American Gas Association Regulations have on the question of what

claims may be properly presented in a patent application?

(7) Were any amendments made to the specification and/or claims of the Giwosky patent application which represent "new matter" and thereby constitute a departure from the specification and claims of said application as originally filed?

(8) Does Claim 2 of the Giwosky patent depend on any "new matter" that was introduced into the specification by amendment?

(9) Is the statement in Claim 2 of the Giwosky patent that the room air is in "heat exchange relation" with the barrier plate a mere variation in language from the specification as originally filed, which stated that the cool room air "impinged upon" this barrier plate?

(10) Is it not inherent that whenever cool air is brought in contact with a hot metal plate it is in "heat exchange relation" with the plate?

(11) Can the Giwosky room air cooling means as covered broadly by Claim 2 of Patent 2,767,702 be used independently of a third heat exchange stage?

(12) Does the Giwosky room air cooling means for economizer-equipped wall heaters have utility in 2-stage as well as 3-stage wall heaters?

Second Ground

The foregoing factual issues are all material to the Plaintiff's second ground for summary judgment, and are therefore incorporated hereunder by

reference. The Court's attention is particularly directed to issues 2-4 and 7-9 as previously stated. One particularly important triable issue hereunder may be summarized as follows: [217]

(13) Is Claim 2 of the Giwosky patent directed to inventive subject matter which is supported by the Giwosky application as originally filed?

Third Ground

(14) Is Claim 2 of the Giwosky patent valid over the prior art?

(15) Does the fact that Coleman's commercial wall heaters constructed in accordance with the Giwosky patent were held to infringe Hollingsworth Patent No. 2,602,441 have any bearing on the question of whether the Giwosky patent covers patentable improvements over the Hollingsworth design?

(16) Does Browell Patent No. 268,860 anticipate the invention covered by Claim 2 of the Giwosky patent?

(17) Can the Browell patent be combined with the Hollingsworth patent to invalidate Claim 2 of the Giwosky patent?

Fourth Ground

(18) Did the United States Patent Office overlook the most pertinent prior art in its examination of the Giwosky application?

(19) Is the Browell Patent No. 268,860 merely

cumulative with other patents officially cited against the Giwosky application by the Patent Office?

(20) Was the Patent Office misled by any untrue representations during the prosecution of the Giwosky application?

Respectfully submitted,

PARKER, STANBURY, REESE
& McGEE,

/s/ By RAYMOND G. STANBURY,
Attorneys for Defendant.

Of Counsel: Timothy L. Tilton, Dawson, Tilton,
Fallon & Lungmus. John F. Eberhardt, Foul-
ston, Siefkin, Schoeppel, Bartlett & Powers.

Certification

I, Raymond G. Stanbury, as attorney for Defendant-Counterclaimant in the above-captioned action hereby certify that the foregoing "Statement of Genuine Issues" has been made in good faith and not for purposes of delay, and that in my opinion material disputed and triable issues exist between the parties hereto as to each of the four grounds asserted by Plaintiff in its motion for summary judgment.

/s/ RAYMOND G. STANBURY. [219]

Affidavit of Service by Mail Attached. [220]

[Endorsed]: Filed May 1, 1958.

[Title of District Court and Cause.]

REPLY TO DEFENDANT'S MEMORANDUM
IN OPPOSITION TO PLAINTIFF'S MO-
TION FOR SUMMARY JUDGMENT

Plaintiff has brought the present Motion for Summary Judgment in order to eliminate the time and expense involved in needlessly trying the issue of infringement of Coleman's Giwosky Patent No. 2,767,702, for it is clear from the uncontroverted evidence of record that Claim 2 of this patent is invalid and unenforceable.

Defendant alleges that the present Motion for Summary Judgment is improper because there are triable issues of fact on which this Court should have the benefit of testimony. It is well established that a Motion for Summary Judgment is proper if it merely requires the application of legal standards to facts which are adequately presented to the Court in the form of affidavits, issued patents or documents. *Park-in Theatres, Inc. v. Perkins* (9th Cir., 1951) 190 F. 2d 137; *Delco Chemicals v. Cee-Bee Chemical [221] Co.*, 157 F. Supp. 583 (S.D. Cal., 1957).

The present Motion may be resolved on the basis of the file history of Coleman's Giwosky patent, the two affidavits of Mr. Giwosky, and the patents to Hollingsworth et al. and Browell, all of which are already of record. The matters set forth in these documents are not complex, and any factual matters can be determined merely by inspecting the docu-

ments. The present Motion can be resolved on any one of several grounds without raising any material issues.

Neither Coleman nor Siegler (nor its predecessor, Holly) has manufactured or sold wall heaters in accordance with the structure shown in Coleman's Giwosky patent. It is merely a paper patent which has not served to advance science or industry, and hence it is of little significance.

The Giwosky patent purports to cover wall heaters employing a primary heater located in a lower box and a secondary heat exchanger or economizer disposed about the flue above the lower box, wherein all of the air for the secondary heat exchanger or economizer is admitted from the room through an opening located above the lower box about midway along the heater structure. This Court and the Court of Appeals have found that wall heaters which Coleman manufactured and sold during the years 1952 to 1957 took air for the secondary heat exchanger or economizer from the space about the lower box, and hence infringed the Hollingsworth et al. patent owned by plaintiff. *Holly v. Coleman*, No. 15,886-WM. These wall heaters did not obtain all the air for the secondary heat exchanger or economizer through the opening at the top of the lower box in accordance with the disclosure of Coleman's Giwosky patent. Instead, the wall heaters obtained a substantial portion of this air from the space about the sides and back of the lower box in accordance with the disclosure of plaintiff's Hollingsworth et al. patent. [222]

When Coleman was forced to discontinue the manufacture and sale of the infringing heaters by a final injunction it did not go over to the wall heater design which is shown in its Giwosky patent, but rather it went to a design which does not employ any secondary heat exchanger or economizer.

In an affidavit submitted in support of defendant's opposition to the present Motion, Mr. Newton states that since the conclusion of the accounting trial in the other action he has built and tested experimentally a wall heater following the design of the Giwosky patent in which the air flow about the lower box is completely excluded from the economizer. If the wall heaters which were the subject of Mr. Newton's *ex parte* tests do in fact exclude this air, it is, so far as the evidence in the two lawsuits in question is concerned, the very first wall heater to be constructed in accordance with the design of the Giwosky patent. Any such tests have only philosophical significance in this action and have no legal significance in the earlier Case No. 15,886-WM, since they were not conducted prior to Coleman's infringement.

In an endeavor to raise an issue of fact, Mr. Newton in his affidavit submitted two pictures of wall heaters manufactured by plaintiff showing openings designated "O" which he alleges constitute infringement of Coleman's Giwosky patent. Plaintiff's heaters do have such openings, because it is more economical to construct the wall heaters that way. (See Hollingsworth deposition.) However, there is a marked difference in the function of these openings

in plaintiff's wall heaters and in the wall heaters of the Giwosky patent. Coleman's Giwosky patent requires that air enter this opening to provide the air for the secondary heat exchanger or upper portion of the wall heater. In plaintiff's wall heaters air comes out of this opening rather than going into it. (Hollingsworth deposition.) The air which comes out of this opening in plaintiff's wall heaters is a portion of the air which passes [223] through the space about the sides and back of the lower box. In other words, plaintiff's heater still obtains the air for the secondary heat exchanger from the space about the sides and back of the lower box in accordance with the disclosure in plaintiff's Hollingsworth et al. patent, and plaintiff's heaters do not obtain the air for the secondary heat exchanger through the opening designated "O" in Mr. Newton's photographs.

These matters raised by Mr. Newton's affidavit are directly concerned with the issue of infringement which is a triable issue of fact, and which is not in issue in the present Motion. These matters are discussed briefly here in order to provide proper background for consideration of the issues of law which are directly before this Court on plaintiff's Motion for Summary Judgment.

Defendant alleges that there are numerous triable issues of fact as to each of the grounds asserted in plaintiff's Motion for Summary Judgment. Most of the issues can be resolved merely by reading the documents of record. The remaining alleged issues are not material with respect to the issues raised by

the Motion for Summary Judgment. The alleged issues are discussed below under the respective grounds asserted by plaintiff.

I.

The Named Inventor Was Not the Inventor Nor the First Inventor of the Device Claimed in Claim 2

(1) Did Harry L. Giwosky invent the subject matter of Claim 2 of Patent No. 2,767,702?

This matter may be ascertained by reading the file history of the Giwosky patent and Mr. Giwosky's two affidavits of record

Claim 2 purports to cover a wall heater employing only two stages of heat exchange. The specification and claims of the Giwosky patent application, as originally filed, described and claimed wall heaters employing three stages. The specification or [224] drawings did not disclose or suggest the possibility of using only two stages, and they did not show how the third stage could be omitted. It is well established that the elimination of one element in a combination claim makes the claim for a new and different invention. *Muncie Gear v. Outboard Steel Company*, 315 U.S. 759 (1942); *Milcor Steel Company v. Fuller Company*, 316 U.S. 143 (1942).

Moreover, Mr. Giwosky stated in paragraph 5 of his affidavit which was submitted with plaintiff's motion, that he built and tested a wall heater and economizer structure that lacked the third stage of heat exchange, and found that such a wall heater was unsatisfactory because of overheating in the

upper part of the economizer. Mr. Giwosky went on to point out in paragraph 10 of his affidavit that Claim 2 of the patent makes no reference to the third stage which he had found to be essential to the proper operation of the device to which the patent is directed.

Clearly, any invention which Mr. Giwosky made must include all of the elements which he found to be essential to the proper operation of the device. He found the third stage to be essential, and hence, Claim 2 which omits one essential element is not part of Mr. Giwosky's invention.

In a subsequent affidavit by Mr. Giwosky which is submitted with defendant's Opposition to the present motion, Mr. Giwosky does not contradict his previous statement. His later affidavit merely states in paragraph 5 that he "preferred to employ these two cooling means" for the secondary heat exchanger "jointly" (i.e., three stages of heat exchange including the stage through the primary heater or lower box), but that this does not mean that the two cooling means were "incapable of separate use." In other words, Mr. Giwosky's affidavits state that his invention was a three-stage wall heater and that portions of his wall heater might [225] be capable of use in devices other than the invention covered by his patent.

Possibly the two cooling means are capable of separate use, but the Giwosky patent does not show how they could be used separately, and Mr. Giwosky found both the so-called cooling means or stages of heat transfer in the secondary heat exchanger to be

essential to the proper operation of the wall heater, as set forth in paragraph 10 of his first affidavit. Clearly, any invention which Mr. Giwosky made must include all the stages which he found to be essential to the proper operation of the device. His patent cannot be enlarged by the assignee years later to encompass a different combination which does not include all of the elements which Mr. Giwosky found to be essential to the proper operation of the device.

(2) Was the subject matter of Claim 2 of Patent 2,767,702 described in the specification of the application for said patent as originally filed?

This matter may be ascertained by reading the specification of the application, as originally filed, a certified copy of which was submitted with plaintiff's motion papers.

In the third paragraph of the specification, it is stated, "A still further object is to provide a structure in which a plurality of cooling streams are employed in connection with the flue, the streams being introduced at the points where the greatest danger of overheating was present."

Clearly, this statement requires at least two cooling streams or stages of heat exchange along the flue in addition to the first stage of heat exchange in the primary heater or lower box. Thus the original application was directed to three stages of heat exchange.

In an endeavor to broaden the original application, Coleman amended this statement on July 11, 1956, nearly three years after [226] the application

was filed. The amended statement reads as follows, the underlined portion showing the amendment: "A still further object is to provide a structure in which one or a plurality of cooling streams are employed in connection with the flue, the streams being introduced at the points where the greatest danger of overheating is present."

Even if this change in the wording of the application were proper, it would still fail to enlarge the scope of the application so as to cover a flue employing only one cooling stream because the application does not show how a wall heater could be constructed employing only one cooling stream in connection with the flue.

The description of the operation of the device further emphasizes the fact that the Giwosky patent is directed to a wall heater having three stages of heat exchange. The description states, "In the foregoing structure it will be observed that in addition to the air heated by the primary wall heater, there are introduced into the wall interior or into the casing 22 therein, at least two increments of cooling air." (Patent, Col. 2, lines 63-66.)

Clearly, the specification describes the structure and operation of a device employing two stages of heat exchange in addition to the stage where air is heated by the primary heater. The specification does not describe how such a wall heater could be modified to operate with only one stage of heat interchange in addition to the stage in the primary heater.

(3) Was Claim 3 of the Giwosky application as

originally filed directed to substantially the same invention as Claim 2 of the issued patent?

This matter may be ascertained by reading the two claims.

Claim 3 of the Giwosky application as originally filed reads as follows:

“In a wall heater structure equipped with a flue [227] extending upwardly between the panels of a wall, a casing about said flue, an inlet for said casing near the lower portion of said flue, a barrier extending across said casing at an intermediate point of said flue, an opening below said barrier for discharging heated air, and an opening in said casing above said barrier for admitting cool air about said flue.”

This claim requires an inlet near the lower portion of the flue, which is the inlet which communicates with the inlet 20 of the patent drawings for admitting the second-stage air to the lower portion of the secondary heat exchanger or economizer. The claim also requires a barrier extending across the economizer structure with an opening for discharging heated air. This is the opening 23 which discharges the second stage air. The claim further requires an opening above the barrier for admitting cool air to the flue. This is the opening 27 of the patent drawings which admits air to the third stage of heat interchange.

Thus, Claim 3 of the Giwosky application as originally filed requires the second and third stages of heat interchange along the flue in conjunction with the primary heater or first stage to which the flue is

coupled. Claim 2 of the issued patent requires only the first and second stages of heat interchange.

A claim which is directed primarily to the second and third stages of heat interchange is different from a claim which is directed only to the first and second stages of heat interchange. Coleman's allegation in its statement of genuine issues that this raises a triable issue of fact is obviously a sham.

(4) Was there at all times from the date of original filing to the date of issuance of the Giwosky patent at least one claim before the Patent Office directed to substantially the inventive subject matter of Claim 2 of the issued patent? [228]

This matter may be ascertained by reading the claims which appear in the file history of the Giwosky patent, and may be answered with an unequivocal no! For example, all of the original claims required the third stage of heat exchange which is not required by Claim 2. The portions of these claims which are directed to the third stage are as follows:

Claims 1 and 2—"and means for introducing additional cooling air about the upper portion of the flue"

Claim 3—"and an opening in said casing above said barrier for admitting cool air about said flue,"

Claims 4 and 5—"and an inlet above said barrier to admit cool air into the casing about said flue,"

Claim 6—"said casing being provided with * * * and with an inlet above said barrier."

(5) Is Claim 1 of the Giwosky patent directed to

a different invention from Claim 2 of the same patent?

This matter may be ascertained by reading the two claims in question.

Claim 1 of the Giwosky patent requires three stages of heat exchange and claim 2 of the Giwosky patent requires only the first two stages.

(6) What bearing, if any, do American Gas Association regulations have on the question of what claims may be properly presented in a patent application?

This matter is easy to resolve and it has little or no significance with respect to the issues of the present motion.

The American Gas Association regulations merely establish minimum requirements for appliances, such as wall heaters, so as to protect the ultimate users of the device. Obviously the American Gas Association regulations as such have no bearing on the question of what claims may properly be presented in a patent application. The American Gas Association regulations may be of significance [229] with respect to an inventor's opinion as to what constitutes a device which operates satisfactorily, because a gas appliance must meet the requirements of these regulations before it can be sold on a commercial basis in practically all of the cities and towns of the United States.

(7) Were any amendments made to the specification and/or claims of the Giwosky patent application which represent "new matter" and thereby

constitute a departure from the specification and claims of said application as originally filed?

This matter may be ascertained from an inspection of the file history of the Giwosky patent.

As discussed above, the original application was directed to a wall heater employing three stages. In an amendment filed on July 11, 1956, about three years after the original application was filed, both the specification and one claim were broadened in an endeavor to encompass a wall heater employing two stages of heat exchange as distinguished from a wall heater employing three stages of heat exchange. Clearly, this is a departure from the original specification and claims.

(8) Does Claim 2 of the Giwosky patent depend on any "new matter" that was introduced into the specification by amendment?

This matter may be ascertained from an inspection of the file history of the Giwosky patent.

Claim 2 was first introduced on July 11, 1956, and the specification was amended at that time to state that one or a plurality of cooling streams may be employed in connection with the flue, whereas previously the specification had stated that a plurality of cooling streams are employed.

(9) Is the statement in Claim 2 of the Giwosky patent that the room air is in "heat exchange relation" with the [230] barrier plate a mere variation in language from the specification as originally filed, which stated that the cool room air "impinged upon" this barrier plate?

(10) Is it not inherent that whenever cool air is

brought in contact with a hot metal plate it is in "heat exchange relation" with the plate?

These matters are of little or no importance with respect to grounds I and II of the present motion. They are primarily concerned with whether or not Coleman misrepresented the importance of certain features of the Giwosky patent in order to obtain allowance of Claim 2, as discussed in more detail in ground IV of the present motion.

(11) Can the Giwosky room air cooling means as covered broadly by Claim 2 of Patent 2,767,702 be used independently of a third heat exchange stage?

(12) Does the Giwosky room air cooling means for economizer-equipped wall heaters have utility in 2-stage as well as 3-stage wall heaters?

These matters, apart from what the patent actually teaches, are not material with respect to any of the grounds of invalidity asserted in plaintiff's motion.

The patent does not teach how the first two stages of heat exchange of the Giwosky patent may be employed independently of the third stage. Claim 2 of the patent purportedly covers such a two-stage wall heater, but it is not supported by the patent disclosure and it was not a part of the device to which the original patent application was directed. Hence, it is immaterial whether or not it can be established at this late date that one of the stages of the three-stage heater which is disclosed in the Giwosky patent may be eliminated. [231]

II.

Claim 2 Was Added Long After the Alleged In-

fringing Devices Appeared on the Market and Is Therefore Void.

There is no genuine issue as to the following facts:

1. Claim 2 is the only claim of the Giwosky patent allegedly infringed by the plaintiff.

2. Claim 2 was presented in an amendment broadening the original application nearly three years after the application was originally filed and more than two years after the alleged infringing devices appeared on the market.

On the basis of the foregoing uncontroverted facts summary judgment should be granted because Coleman presented claim 2 of the Giwosky patent to the Patent Office more than two years after plaintiff started selling the alleged infringing heaters. *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U.S. 463 (1924); *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823 (2d Cir. 1928); *Westinghouse Electric and Mfg. Co. v. Jeffrey-De Witt Insulator Co.*, 22 F.2d 277 (2d Cir. 1927); *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159 (1938).

The Supreme Court in *Webster Electric Co. v. Splitdorf Electrical Co.*, *supra*, held that claims expanding the patentee's original claims will be invalidated by a delay of two years in applying for the broadened claims unless the delay is justified where there have been intervening rights for more than two years before the broadened claims were filed.

In *Dwight & Lloyd Sintering Co. v. Greenawalt*, *supra*, the court in applying the *Webster Electric*

case held claims presented by amendment more than two years after the defendant had reduced [232] the alleged infringing device to commercial practice invalid because of laches.

The decision in Webster Electrical Co. v. Splitdorf Electrical Co., *supra*, is clearly applicable to amendments to an original application. Wagenhorst v. Hydraulic Steel Co., 27 F. 2d 27 (2d Cir. 1928).

Thus Coleman's claim 2 of the Giwosky patent is invalid since it was filed more than two years after plaintiff's adverse intervening use of the alleged infringing devices.

Moreover, it is well established that a claim is invalid and unenforceable if the device covered by the claim has been on public use or on sale more than one year prior to the date on which the new claim is submitted in the patent application. Muncie Gear Works, Inc. et al. v. Outboard, Marine and Manufacturing Co. et al., 315 U.S. 759 (1942).

As discussed in detail in plaintiff's prior motion papers, Mr. Giwosky did not submit a supplemental oath to the effect that the changes made by amendment to the application were part of his original invention. Such an oath is essential if the changes represent a departure from the original claims, as in the present case.

Coleman alleges that issues 2-7 and 7-9 set forth above are triable issues of fact concerning this ground which cannot be resolved by summary judgment proceedings. The alleged issues 2-4, 7 and 8 can be resolved merely from an inspection of the file history of the Giwosky patent application.

Alleged issue 9 concerning the difference in language between the term "heat exchange relation" and the statement that air "impinged upon the closure plate" is not relevant with respect to this ground of invalidity. This question is relevant primarily with respect [233] to defendant's misleading the Patent Office as to the importance of features of the claim.

Coleman alleges as a further triable issue of fact

"(13) Is claim 2 of the Giwosky patent directed to inventive subject matter which is supported by the Giwosky application as originally filed?"

This matter may be ascertained from an inspection of the file history of the Giwosky patent application.

As discussed above, with reference to alleged issues 2 and 7, the application for the Giwosky patent as originally filed shows and describes a wall heater structure having three separate stages of heat exchange and it describes a wall heater operation having three stages of heat exchange. This application, as originally filed, is directed to an entire wall heater combination, and it does not disclose or suggest that the wall heater structure might be modified to employ only two stages of heat exchange. On July 11, 1956, the third paragraph of the specification was amended to state that one or a plurality of cooling streams may be employed in connection with the flue, instead of the previous statement that a plurality of cooling streams are employed in connection with the flue. Also, claim 21 which became

claim 2 of the issued patent was introduced for the first time in the amendment of July 11, 1956.

Obviously the three-stage wall heater which had been the subject of Coleman's Giwosky patent application from October 1953 to July 1956 is a different invention from the two-stage wall heater which Coleman endeavored to encompass by broadening the application at that time. This is particularly true in view of the fact that the inventor has stated under oath that he found the third stage to be essential to the proper operation of the wall heater. (Giwosky affidavit submitted with Plaintiff's Motion, Paragraph 10.) [234]

The patent statutes provide that "No amendment shall introduce new matter into the disclosure of the invention." 35 U.S.C. 132. The courts have held that in order to establish that new matter has not been introduced by amendment contrary to the statute, the evidence must show that the feature added by amendment is necessary and inevitably inherent in the invention which is described in the application as originally filed, and inherency may not be established by possibilities or probabilities. *Interchemical Corp. v. Watson*, 145 F.Supp. 179 (D.C. Dist. of Col., 1956); *Hansgirk v. Kemmer*, 102 F.2d 212 (C.C.P.A. 1939); *Forward Process Co. v. Cole*, 116 F.2d 946 (D.C. Cir. 1940).

Obviously, the use of only a single stage of heat exchange along the flue so as to provide a wall heater having only two stages of heat exchange as required by claim 2 of Coleman's Giwosky patent is not necessarily inherent in the invention described

in the application as originally filed. The original application made no mention of such a possibility. Even with the amendment of July 1956, it is not clear how the wall heater structure would function satisfactorily with only two stages of heat exchange.

Since no genuine issue exists as to the facts underlying plaintiff's second ground of its motion for summary judgment, the motion should be granted.

III.

Coleman's Immaterial Variance From the Prior Art Is Not Patentable

IV.

The Presumption of Validity Does Not Pre- vent Awarding Summary Judgment Against Coleman

In the case at bar a summary judgment of invalidity on the grounds of anticipation by the prior art should be granted.

There is no genuine issue as to the following facts:

1. Hollingsworth et al. designed and patented an integrated wall heater and economizer structure long before Giwosky's patent application was filed.

2. Coleman's Kice testified under oath in January 1955 to the fact that the Hollingsworth et al. heater took room air "up through the columns of the trim * * * into the space above the lower box * * * into the secondary heat exchanger." (R. 359.)

3. In July 1956 Coleman represented to the Patent Office that in the Hollingsworth construction

“no provision is made for causing room air to flow over the upper surface of the forward portion of the barrier plate (lower box top) and into the lower portion of the economizer.” (Amendment of July 11, 1956.)

4. In May 1956 Coleman represented to the Patent Office that Hollingsworth et al. “shows only dead air space in this area” above the lower box top. (Amendment of May 29, 1956.)

5. The patent issued to Browell, No. 268,862, was not cited as a reference against the Giwosky application. (File history of the Giwosky patent.) [236]

This Court recently held that a summary judgment of invalidity is proper where pertinent prior art patents were not cited by the Patent Office and the elements of the claimed apparatus “are easily understood from a reading of the claims of the patent in conjunction with the specifications and drawings.” *Delco Chemicals v. Cee-Bee Chemical Co.*, 157 F. Supp. 583, 588 (S.D. Cal. 1957).

Similarly, the Court of Appeals for the Ninth Circuit held in a case relied upon by the defendants, that summary judgment of invalidity over the prior art can be granted. *Park-In Theatres v. Perkins*, 190 F. 2d 137 (9th Cir. 1956).

In the case at bar, as in the case of *Vermont Slate Co. v. Tatko Brothers Co.*, 233 F. 2d 9, 10 (2d Cir. 1956)

“The prior art and the patent claims are, without expert aid, easily understandable * * * Nor did it require expert testimony to make it plain that the

differences between the prior art and the patent claims were obvious to persons having ordinary skill in the trade at the time the alleged invention was made.”

On the uncontroverted facts, summary judgment should be granted.

The purported patentable difference between Hollingsworth 2,602,441 and Claim 2 of Giwosky is the use of room air to cool the top of the lower box in the second stage of heating in the Giwosky patent, i.e., the air that is warmed by circulation through the economizer. As has been pointed out, the Hollingsworth device uses room air which passes through the conduits in the trim into the space above the lower box top and then into the economizer in the Hollingsworth device. This fact was known to Coleman at least as early as January 1955, when it was stated in this Court by Mr. Kice.

In order to obtain a patent over the reference Hollingsworth, Coleman misrepresented to the Patent Office the effect of these conduits for airflow in the Hollingsworth device and unequivocally stated to the Patent Office that only a dead air space existed above the lower box in the Hollingsworth device. Doubtless if the Patent Office had known that this statement by Coleman was incorrect, no patent would have been granted on the Giwosky application. Since The Coleman Company misrepresented to the Patent Office the existence of certain features in the Hollingsworth device in order to obtain the Giwosky patent, the presumption of validity which would normally exist as to references of record has

been destroyed. *Floridan v. Attapulugus Clay Co.*, 35 F. Supp. 810, 814 (D.C. Del. 1940).

After the Patent Office examiner stated in his Office letter dated June 12, 1956, that "No invention is seen in providing a direct room air inlet to the economizer of Hollingsworth to the exclusion of that shown in this reference," Coleman further misled the Patent Office by strenuously arguing the importance of air flow over the lower box top in order to obtain a patent. (Amendment dated July 11, 1956.)

That such air flow is not important in the Giwosky device is made clear by his affidavit dated November 20, 1957. Mr. Giwosky states in paragraph 7:

"The first point at which a dangerously high temperature might be reached in the economizer shown and described in my application is where the wall panel 12 comes in contact with the flange near the bottom of the economizer casing 22 * * * The wall panel 12 may be of combustible material and may catch fire if it is heated too highly. The closure plate 18, on the contrary, is not in contact with combustible material and represents no fire hazard if it is heated too highly." [238]

Mr. Giwosky went on to state that there was no need to bring room air in heat exchange relationship with the plate 18 and that he "never considered such heat exchange relation * * * a part of the invention for which I filed said application."

Thus, Mr. Giwosky has pointed out under oath that the basis on which Coleman obtained issuance

of the patent—the use of room air to cool the barrier plate—is of no consequence in his device. Coleman urges in its Memorandum in Opposition to Plaintiff's Motion that this is like arguing that the act of turning off a radiator in a room is of “no consequence,” since the objective to be accomplished is to cool the room and not the radiator, *per se*. Coleman goes on to argue that the cooling of the radiator is the means to the desired end. This is fallacious reasoning because the radiator in question (i.e., the top of the box in which the primary heater is located) is one that cannot be turned off or cooled appreciably. The entire heat generated by the wall heater is generated within the space immediately below the top of the lower box, and hence, it is inherently maintained at a high temperature whenever the heater is operating.

In such a situation the way to maintain the adjacent wall members of the room at satisfactorily low temperatures is to cause air to pass over the wall members, just as one would cause cool air to pass through a room in order to cool it if there was a radiator in it which could not be turned off or cooled appreciably by the flow of air over it.

There is nothing, therefore, in Mr. Giwosky's later affidavit dated April 14, 1958 which contravenes his earlier statement. Thus his later statement that “The ultimate objective was to reduce the heat transferred to the adjacent wall members of the room in which the heater would be installed” relates only to hot spot “A.” And the happenstance that room air taken into the bottom of economizer “im-

been destroyed. *Floridan v. Attapulugus Clay Co.*, 35 F. Supp. 810, 814 (D.C. Del. 1940).

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That such air flow is not important in the Giwosky device is made clear by his affidavit dated November 20, 1957. Mr. Giwosky states in paragraph 7:

"The first point at which a dangerously high temperature might be reached in the economizer shown and described in my application is where the wall panel 12 comes in contact with the flange near the bottom of the economizer casing 22 * * * The wall panel 12 may be of combustible material and may catch fire if it is heated too highly. The closure plate 18, on the contrary, is not in contact with combustible material and represents no fire hazard if it is heated too highly." [238]

Mr. Giwosky went on to state that there was no need to bring room air in heat exchange relationship with the plate 18 and that he "never considered such heat exchange relation * * * a part of the invention for which I filed said application."

Thus, Mr. Giwosky has pointed out under oath that the basis on which Coleman obtained issuance

of the patent—the use of room air to cool the barrier plate—is of no consequence in his device. Coleman urges in its Memorandum in Opposition to Plaintiff's Motion that this is like arguing that the act of turning off a radiator in a room is of "no consequence," since the objective to be accomplished is to cool the room and not the radiator, *per se*. Coleman goes on to argue that the cooling of the radiator is the means to the desired end. This is fallacious reasoning because the radiator in question (i.e., the top of the box in which the primary heater is located) is one that cannot be turned off or cooled appreciably. The entire heat generated by the wall heater is generated within the space immediately below the top of the lower box, and hence, it is inherently maintained at a high temperature whenever the heater is operating.

In such a situation the way to maintain the adjacent wall members of the room at satisfactorily low temperatures is to cause air to pass over the wall members, just as one would cause cool air to pass through a room in order to cool it if there was a radiator in it which could not be turned off or cooled appreciably by the flow of air over it.

There is nothing, therefore, in Mr. Giwosky's later affidavit dated April 14, 1958 which contravenes his earlier statement. Thus his later statement that "The ultimate objective was to reduce the heat transferred to the adjacent wall members of the room in which the heater would be installed" relates only to hot spot "A." And the happenstance that room air taken into the bottom of economizer "im-

pinged upon the closure plate" is [239] completely consistent with his statement that he never considered heat exchange between such room air and the closure plate 18 "a part of the invention."

This Court has recently held that references as to which no presumption of validity exists may be used to invalidate a patent on a motion for summary judgment. *Delco Chemicals v. Cee-Bee Chemical Co.*, 157 F.Supp 583 (S.D. Cal. 1957). In view of the equivalent means shown by Hollingsworth for cooling the area above the lower box, the element upon which Giwosky placed primary importance in obtaining a patent is anticipated by Hollingsworth and on that reference alone the Giwosky patent is invalid. However, the uncited art as well as the art of record further serves to invalidate the patent in suit.

Admittedly Hollingsworth's invention was much earlier in time than the development work done by Mr. Giwosky and as plaintiffs have pointed out in the case of *Holly v. Coleman* (15,886-WM), the early fireplace art in of itself did not solve the problems of wall heaters. However, after Hollingsworth et al. showed how to use secondary heat exchangers in wall heaters, the fireplace art concerning such secondary heat exchangers became important to the wall heater art. Hence the fireplace art considered along with the invention made by Hollingsworth of an integrated wall heater with a secondary heat exchanger is pertinent to show invalidity of the patent to Mr. Giwosky.

The most pertinent fireplace art is the patent

issued to Browell in 1882. The pertinence of this patent was clearly brought out during the trial of *Holly v. Coleman* (15,886-WM) by the testimony of Mr. Kice and the argument of Mr. Lyon as set forth in pages 11 through 13 of plaintiff's Memorandum in Support of Motion for Summary Judgment. A comparison of the Browell patent with the references other than Hollingsworth cited by the Patent Office in the Giwosky application further demonstrates [240] that the Browell patent is more pertinent than any of the references of record except Hollingsworth. Copies of these references are attached hereto as Exhibits A through D.

The reference Cayot 2,702,539 is a conventional single stage wall heater, which was cited merely to show certain design details of casing construction at the top of the heater. (Office action, May 13, 1955.)

The reference Snyder 2,093,492 shows a fireplace heater which obtains some additional heat by circulating air about a portion of the flue around the fireplace. The inlet for the air circulated about the flue is a conduit extending through the masonry to the outside of the dwelling in which the fireplace is installed.

The reference Derrough 1,608,777 shows a means of circulating air about the flue in a masonry chimney. Each stage of heating air in the chimney embraces a complete floor of a room with the inlet at the floor level and the outlet at the ceiling level.

The reference Bacon 786,713 shows a method of transferring warm air from one floor to the next by

using a duct around the chimney of a fireplace heater. Bacon does not employ any fixed barriers between what might be termed stages of air flow along the chimney.

By contrast the reference Browell shows a metal flue construction in which air is taken into a casing about the flue at a point b directly above the primary heating appliance and discharged at an intermediate point I below a barrier. The secondary heat exchanger of the Giwosky patent is the same thing. Air is taken into the casing about the flue at a point 20 directly above the primary heating appliance and discharged at an intermediate point 23 below a barrier.

Admittedly Hollingsworth et al. were the first to invent an integrated wall heater with a secondary heat exchanger. No [241] inventive genius was necessary to adapt Browell's flue construction to the economizer or secondary heat exchanger once Hollingsworth had shown how to employ an economizer or secondary heat exchanger in a wall heater. Since the Browell patent was not a reference cited by the Patent Office no presumption of validity exists as to the combination of Browell and Hollingsworth so that summary judgment of invalidity may be granted. *Delco Chemicals Inc. v. Cee-Bee Chemical Co.*, 157 F.Supp. 583, 590 (S.D. Cal. 1957).

For convenience, the foregoing discussion has related to the so-called third ground and the so-called fourth ground in support of the plaintiff's motion for summary judgment. Defendant in its Statement of Genuine Issues has posed the following questions

under the third and fourth grounds of plaintiff's motion.

(14) Is claim 2 of the Giwosky patent valid over the prior art?

As heretofore pointed out, no expert testimony is needed to explain the Giwosky patent or the prior art. Summary judgment may, therefore, be granted.

(15) Does the fact that Coleman's commercial wall heaters constructed in accordance with the Giwosky patent were held to infringe Hollingsworth Patent No. 2,602,441 have any bearing on the question of whether the Giwosky patent covers patentable improvements over the Hollingsworth design?

As heretofore pointed out Coleman's commercial wall heaters have never been constructed in accordance with the Giwosky patent. This alleged issue of fact is not material to the grounds for summary judgment presented by plaintiff.

(16) Does Browell Patent No. 268,860 anticipate the invention covered by claim 2 of the Giwosky patent?

(17) Can the Browell patent be combined with the Hollingsworth patent to invalidate claim 2 of the Giwosky patent? [242]

The reference Hollingsworth alone or the combination of the references Browell and Hollingsworth invalidate claim 2 of the Giwosky patent so that a summary judgment of invalidity may be granted.

(18) Did the United States Patent Office overlook the most pertinent prior art in its examination of the Giwosky application?

(19) Is the Browell Patent No. 268,860 merely cumulative with other patents officially cited against the Giwosky application by the Patent Office?

In view of Hollingsworth as heretofore pointed out, the reference Browell is not merely cumulative but is the most pertinent fireplace patent to show lack of invention in the Giwosky patent. The Browell patent shows the same secondary heat exchanger that is disclosed in the Giwosky patent. The other patents cited by the Patent Office do not.

(20) Was the Patent Office misled by any untrue representations during the prosecution of the Giwosky application?

As previously stated, in view of the testimony of Mr. Kice, the affidavits of Mr. Giwosky and the representations made to the Patent Office by Coleman, there is no issue as to the established fact that the Patent Office was misled by untrue representations during the prosecution of the Giwosky application.

No genuine issue of material fact on the issue of anticipation of the patent in suit exists and so summary judgment of invalidity on that ground should be granted.

Conclusion

“Summary judgment represents a most useful legal invention to save time and expense, by the avoidance of a trial, when there exist no material fact-issues. It may well be that, in [243] a patent case, a judge should exercise unusual caution in granting a summary judgment. But there are pat-

ent cases where it would be an absurd waste of time and effort to deny such a judgment. This is such a case." Vermont Structural Slate Company, Inc. v. Tatko Brothers Slate Co., Inc., 233 F.2d, 9, 10 (2d Cir. 1956).

Dated this 7th day of May, 1958.

Respectfully submitted,

CHRISTIE, PARKER & HALE,
JAMES B. CHRISTIE,
C. RUSSELL HALE,
RICHARD B. HOEGH,
ASHLEY STEWART ORR,

/s/ By C. RUSSELL HALE,

/s/ RICHARD B. HOEGH,

Attorneys for Plaintiff. [244]

[Note: Exhibit A—Patent L. B. Cayot No. 2,702,539. Exhibit B—Patent R. W. Snyder No. 2,093,492. Exhibit C—Patent H. Derrough No. 1,608,777. Exhibit D—J. D. Bacon & T. McGarrigal No. 786,713 are set out in the Book of Exhibits 327-347.]

Affidavit of Service by Mail Attached. [262]

[Endorsed]: Filed May 8, 1958.

[Title of District Court and Cause.]

PROPOSED FINDINGS OF FACT AND
CONCLUSIONS OF LAW

Pursuant to Local Rule 3(d)(2), the plaintiff

hereby submits the proposed Findings of Fact and Conclusions of Law. There is no genuine issue as to any of the proposed Findings of Fact:

1. Plaintiff, The Siegler Corporation, is a Delaware corporation and has a place of business at 875 South Arroyo Parkway, Pasadena, California.

2. Defendant, The Coleman Company, Inc., is a Kansas corporation and has a place of business in the County of Los Angeles, State of California.

3. This Court has jurisdiction of the subject matter of the action pursuant to the provisions of 28 U.S.C. Sec. 1338 relating to patent causes and 38 U.S.C. Sec. 2201 relating to declaratory judgments. [269]

4. On or about December 31, 1956, the defendant, by a letter addressed to the Holly Manufacturing Company, Inc., 875 South Arroyo Parkway, Pasadena, California, gave notice to Holly Manufacturing Company of alleged infringement of United States patent No. 2,767,702, which was applied for by Harry L. Giwosky and assigned to The Coleman Company, and which issued on October 23, 1956. At all times since on or about November 29, 1955, Holly Manufacturing Company has been and now is a division of the plaintiff and is known as Holly Manufacturing Company, a Division of The Siegler Corporation.

5. By a letter dated February 6, 1957, the plaintiff advised the defendant that the plaintiff does not infringe said Giwosky patent No. 2,767,702.

6. An actual controversy now exists between the

parties to this action so that the plaintiff is entitled to a declaration of its rights by this Court.

7. The defendant's charge of infringement of said patent by the plaintiff relates to wall heaters being manufactured and sold by the plaintiff in the County of Los Angeles, State of California.

8. The Coleman Company at all times since October 23, 1956, has been and now is the owner of all right, title and interest in and to said Giwosky patent No. 2,767,702.

9. The device described in claim 2 of said patent is anticipated by United States patent No. 268,860, issued to Browell in 1882 and by the combination of the Browell patent and the device disclosed in patent No. 2,602,441, issued to Holly Manufacturing Company on July 8, 1952.

10. The patent to Browell, No. 268,860, was not cited against the application for said Giwosky patent No. 2,767,702 and is more pertinent to show the lack of invention over the prior art of the device claimed in claim 2 of said patent than the patents cited as references by the Patent Office. [270]

11. Claim 1 of said Giwosky patent No. 2,767,702 describes a wall heater having three stages or passageways for conveying increments of air through the wall heater. Claim 2 of said Giwosky patent No. 2,767,702 describes a wall heater having two stages or passageways for conveying increments of air through the wall heater.

12. The two-stage wall heater described in claim 2 of said Giwosky patent No. 2,767,702 was constructed and tested by the inventor prior to filing

the application for the patent, and he found the two-stage wall heater unsatisfactory and discarded it. Thereafter the inventor redesigned the wall heater to employ three stages, and the three-stage wall heater was constructed and successfully tested prior to filing the application for the patent. The statement of invention and all of the claims of the application for the Giwosky patent as originally filed were directed to the three-stage wall heater. None of the original claims were directed to a two-stage wall heater, and the specification as originally filed did not describe a two-stage wall heater.

13. The two-stage wall heater described by claim 2 of the Giwosky patent No. 2,767,702 is not part of the invention for which Harry L. Giwosky applied for a patent.

14. Harry L. Giwosky, the named inventor of the devices covered in said patent No. 2,767,702 is not the inventor of the two-stage wall heater described by claim 2 of said patent.

15. The changes and amendments in the claims and specification of the original application for said Giwosky patent No. 2,767,702 during the prosecution of the application in the Patent Office broadened the application to embrace new matter not described in the application as filed. Prior to the time plaintiff's devices appeared on the market the claims in said application were limited to wall heaters having three stages of heat exchange as opposed to the two stages of heat exchange embodied in the device [271] claimed in claim 2. Said changes and amendments appearing in claim 2 of

said patent were made after the plaintiff's accused devices, which have two stages of heat exchange, appeared on the market.

16. The device claimed in claim 2 of said patent is not embraced in the statement of invention or the claims of the original application and no supplemental oath was filed to cover the subject matter of such claim.

17. Claim 2 of patent No. 2,767,702 is invalid.

18. During the prosecution of said patent The Coleman Company misled the Patent Office as to material matters affecting the patentability of the devices claimed in said patent.

Dated: This 28th day of March, 1958.

CHRISTIE, PARKER & HALE,
JAMES B. CHRISTIE,
C. RUSSELL HALE,
RICHARD B. HOEGH,
ASHLEY STEWART ORR,

/s/ By RICHARD B. HOEGH,
Attorneys for Plaintiff. [272]

[Endorsed]: Lodged March 31, 1958. Filed June 19, 1958.

[Title of District Court and Cause.]

ORDER ON PLAINTIFF'S MOTION
FOR SUMMARY JUDGMENT

This cause having come before the Court for hearing on plaintiff's motion for summary judg-

ment, filed March 31, 1958; and the motion having been argued and submitted for decision; and it appearing to the Court that:

(1) plaintiff brought this action for a declaration of invalidity and non-infringement as to United States Letters Patent No. 2,767,702, issued on October 23, 1956 to H. L. Giwosky, assignor of the defendant, The Coleman Company;

(2) an actual controversy exists between plaintiff and defendant as to whether or not claim 2 of the patent in suit is valid and, if so, whether claim 2 is infringed by plaintiff's wall heater; [273]

(3) among the prior art references cited in the administrative proceedings leading to issuance of the patent in suit is Patent No. 2,602,441, issued July 8, 1952, to Hollingsworth, et al, assignor of the plaintiff, and it has been finally and conclusively adjudicated between the parties that plaintiff's Hollingsworth patent No. 2,602,441 is valid and has been infringed by wall heaters manufactured and sold by defendant [See *The Coleman Company v. Holly Mfg. Co.*, 233 F. 2d 71 (9th Cir.), cert. denied 352 U. S. 952 (1956)]; and moreover the parties have stipulated that the entire record in that case in this Court is here for consideration upon this motion for summary judgment [See "*Holly Manufacturing Company, a corp., Plaintiff v. The Coleman Company, Inc., a corp., Defendant*", No. 15,886-WM—Civil];

(4) there is no issue of fact as to the contents of the patent in suit, or as to the contents of the file-wrapper record of Patent Office proceedings lead-

ing to the issuance of the patent in suit, or as to the contents of the various prior-art patents involved;

(5) United States Patent No. 268,860 issued to Browell in 1882 is admitted by the parties to be pertinent prior art which concededly was not cited and presumably not considered by the Patent Office in passing on the application for the patent in suit;

(6) the presumption that a patent is valid, as embodying an invention over the prior art, does not subsist as to pertinent prior art not cited or [274] considered by the Patent Office in passing on the application for the patent [*Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 191 F. 2d 632, 634 & note 4, 637 (9th Cir. 1951); *Gomez v. Granat Bros.*, 177 F. 2d 266, 268 (9th Cir. 1949), cert. denied 338 U.S. 937 (1950); *Mettler v. Peabody Eng. Corp.*, 77 F. 2d 56, 58 (9th Cir. 1935); and see cases from other circuits collected in *Delco Chemicals v. Cee-Bee Chemical Co.*, 157 F. Supp. 583, 587-588 (S.D.Cal. 1957)];

(7) there being no presumption that claim 2 of the patent in suit describes a heater which is a patentable advance over the prior art as disclosed in the Browell patent No. 268,860, considered in conjunction with plaintiff's cited Hollingsworth Patent No. 2,602,441, it is for the Court, upon this motion for summary judgment to determine from (a) the matters finally adjudicated, as well as those matters as to which there is no issue of fact, appearing in the record in this Court in case No.

15,886-WM Civil, (b) the undisputed contents of the patent in suit, (c) the undisputed contents of the file wrapper of the administrative proceedings in the Patent Office, and from (d) the undisputed contents of the prior-art patents, whether claim 2 of the patent in suit describes an inventive advance over the prior art [United States v. Esnault-Pelterie, 303 U. S. 26, 30 (1938); Park-in Theatres, Inc. v. Perkins, 190 F. 2d 137 (9th Cir. 1951)]; and

(8) the Court concludes, as a matter of law, from undisputed facts disclosed by the letters, the [275] file wrapper of the patent in suit, and the prior-art patents, both cited and non-cited, that claim 2 of the patent in suit is invalid, being anticipated by Patent No. 268,860 to Browell, and Patent No. 2,602,441 to Hollingsworth, et al [35 U.S.C. § 102(b)], and failing in all events to meet the standard of invention, because lacking in patentable novelty [id., § 103; Bergman v. Aluminum Lock Shingle Corp. of America, 251 F. 2d 801, 809-810 (9th Cir. 1958); Stauffer v. Slenderella Systems, 254 F. 2d 127 (9th Cir. 1957); Muench-Kreuzer Candle Co., Inc. v. Wilson, 246 F. 2d 624 (9th Cir.), cert. denied 355 U. S. 882 (1957); Oriental Foods v. Chun King Sales, 244 F. 2d 909 (9th Cir. 1957); Kwikset Locks, Inc. v. Hillgren, 210 F. 2d 483 (9th Cir.), cert. denied 347 U. S. 989 (1954)];

It Is Now Ordered that plaintiff's motion for a summary judgment declaring invalid claim 2 of the patent in suit is hereby granted; and the attorneys

for plaintiff will lodge with the Clerk within ten days findings of fact, conclusions of law and judgment accordingly, to be settled pursuant to Local Rule 7.

It Is Further Ordered that the Clerk this day serve copies of this order by United States mail upon the parties appearing in this cause.

June 19, 1958.

/s/ WM. C. MATHES,

United States District Judge.

[Endorsed]: Filed June 19, 1958.

United States District Court
Southern District of California

Office of the Clerk

Room 231, U. S. Post Office & Court House

Los Angeles 12, California.

Parker, Stanbury, Reese & McGee, Esqs.

315 West 9th Street

Los Angeles, Calif.

Christie, Parker & Hale, Esqs.

595 East Colorado St.

Pasadena 1, Calif.

Re: The Siegler Corp., vs. The Coleman Co.,
No. 213-57-WM.

You are hereby notified that summary judgment

2. Defendant, The Coleman Company, Inc., is a Kansas corporation and has a place of business in the County of Los Angeles, State of California.

3. This Court has jurisdiction of the subject matter of the action pursuant to the provisions of 28 U.S.C. Sec. 1338 relating to patent causes and 38 U.S.C. Sec. 2201 relating to declaratory judgments.

4. On or about December 31, 1956, the defendant, by letter addressed to the Holly Manufacturing Company, Inc., 875 South Arroyo Parkway, Pasadena, California, gave notice to Holly Manufacturing Company of alleged infringement of United States Patent No. 2,767,702, which was applied for by Harry L. Giwosky and assigned to The Coleman Company, and which issued on October 23, 1956. At all times since on or about November 29, 1955, Holly Manufacturing Company has been and now is a division of the plaintiff and is known as Holly Manufacturing Company, a Division of The Siegler Corporation.

5. By letter dated February 6, 1957, the plaintiff advised the defendant that the plaintiff does not infringe said Giwosky patent No. 2,767,702.

6. An actual controversy now exists between the parties to this action so that the plaintiff is entitled to a declaration of its rights by this Court.

7. There is no genuine issue as to any material fact necessary to the consideration and determination of said motion for summary judgment.

8. The defendant's charge of infringement of said patent by the plaintiff relates to wall heaters having two stages or passageways for conveying

increments of air through the wall heaters being manufactured and sold by the plaintiff.

9. Claim 1 of said Giwosky patent No. 2,767,702 describes a wall heater having three stages or passageways for conveying increments of air through the wall heater. Claim 2 of said Giwosky patent No. 2,767,702 describes a wall heater having two stages or passageways for conveying increments of air through the wall heater.

10. Defendant has admitted that claim 1 of said Giwosky Patent No. 2,767,702 does not cover plaintiff's wall heater models 25NS, 25ND, 35NS, 35ND, 50ND, 57ND, 250S, 250D, 350S, 350D, 500D, 570D, 25S, 25D, 35S, 35D, 50D, and 55D, and the parties hereto have agreed that claim 1 of said Giwosky patent No. 2,767,702 is not in issue in this action.

11. It is admitted by the parties hereto that United States Letters Patent No. 268,860 issued to Browell in 1882 is pertinent prior art which concededly was not cited and presumably not considered by the Patent Office in passing on the application for the patent in suit No. 2,767,702 issued to Giwosky, and further, the parties stipulated that the entire record of Holly Manufacturing Company v. The Coleman Company, Civil No. 15,886-WM in this Court, is now before this Court for consideration upon plaintiff's motion for summary judgment.

12. The patent to Browell No. 268,860 discloses that it is old in the art to employ a metal flue construction on a primary heating appliance wherein air is taken into a casing about the flue at a location immediately above the primary heating appli-

ance and discharge below a barrier in the casing at a location near the ceiling of the room in which the heating appliance is located. Claim 2 of the Giwosky patent No. 2,767,702 describes a metal flue construction 17 on a primary heating appliance 10 wherein air is taken into a casing 22 about the flue at a location 20 immediately above the primary heating appliance and discharge below a barrier 26 in the casing at a location near the ceiling of the room in which the heating appliance is located, and hence claim 2 of said Giwosky patent No. 2,767,702 does not differ patentably from the device shown in the Browell patent No. 268,860.

13. The patent to Hollingsworth, et al., No. 2,602,441, discloses that it is old in the art to employ in a wall heater having a primary heating element with a secondary heat exchanger to heat a stream of air in addition to that heated by the primary heating element, and the patent to Browell No. 268,860 discloses that it is old in the art to provide a secondary heat exchanger employing a metal flue construction on a primary heating appliance wherein air [283] is taken into a casing about the flue at a location immediately above the primary heating appliance and discharged below a barrier in the casing at a location near the ceiling of the room in which the heating appliance is located. Claim 2 of the Giwosky patent No. 2,767,702 describes a wall heater employing a primary heating appliance and having a flue construction which serves as a secondary heat exchanger wherein air is taken into a casing about the flue at a loca-

tion immediately above the primary heating appliance and discharged below a barrier in the casing at a location near the ceiling of the room in which the heating appliance is located, and hence claim 2 of said Giwosky patent No. 2,767,702 does not differ patentably from the combination of the devices shown in Hollingsworth patent No. 2,602,441 and Browell patent No. 268,860.

14. The device described in claim 2 of said Giwosky patent No. 2,767,702 is anticipated by United States Patent No. 268,860 issued to Browell in 1882 and it is also anticipated by the device disclosed in Hollingsworth patent No. 2,602,441 issued to Holly Manufacturing Company on July 8, 1952.

15. The device described in claim 2 of said Giwosky patent No. 2,767,702 fails to meet the standard of invention required by the laws of the United States because the invention claimed therein lacks patentable novelty over the prior art patents.

16. The device described in claim 2 of said Giwosky patent No. 2,767,702 fails to meet the standard of invention required by the laws of the United States because the subject matter of said claim 2 would have been obvious at the time the alleged invention was made to a person having ordinary skill in the art.

17. Extrinsic evidence is not needed to explain or evaluate the prior art, cited or uncited, and its applicability to the subject matter of claim 2 of the patent in suit. [284]

18. In claim 2 of the Giwosky patent in suit, the various elements set forth as constituting the

patented device do not produce any result not produced in the prior art, or any unexpected result, and do not produce in aggregation any result greater than the sum of their separate results, or any result different from the result which in aggregation is produced in the prior art.

19. The elements of claim 2 of the Giwosky patent in suit, being an alleged combination invention composed of elements old in the art, do not perform any additional and different function in combination than they perform out of it and, as such, said claim 2 fails to meet the standard of invention required by the laws of the United States.

20. Claim 2 of the Giwosky patent in suit is completely anticipated by the prior art.

21. The device of claim 2 of the Giwosky patent in suit is lacking in invention over the prior art.

22. The device of claim 2 of the Giwosky patent in suit is devoid of patentable novelty.

23. The "Order on Plaintiff's Motion for Summary Judgment", filed June 19, 1958, is by reference made a part hereof.

Conclusions of Law

1. This Court has jurisdiction of this action and of the parties to the action.

2. The Giwosky patent in suit No. 2,767,702 is owned by the defendant, The Coleman Company.

3. Any presumption that claim 2 of the Giwosky patent in suit is valid does not subsist as to the pertinent prior art which was not cited or considered by the Patent Office.

4. Claim 2 of Letters Patent No. 2,767,702 issued to Harry L. Giwosky and assigned to the defendant, The Company [285] Company, is invalid as being anticipated by uncited United States Patent No. 268,860 issued to Browell and by the cited United States Patent No. 2,602,441 issued to Hollingsworth et al.

5. There being no dispute of fact as to the contents of the file wrapper history of the Giwosky patent in suit or the prior art patents, both cited and uncited, and no subsisting presumption of validity as to the pertinent prior art which was not cited by the Patent Office, and extrinsic evidence not being required for the purposes of explanation, the question of anticipation and want of invention, and hence of validity, are questions of law.

6. Claim 2 of the Giwosky patent in suit is invalid and void for want of invention over the prior art.

7. Claim 2 of the Giwosky patent in suit is invalid and void for failure to meet the requisite standard of invention in that it lacks patentable novelty over the prior art.

8. Plaintiff is entitled to judgment declaring claim 2 of United States Letters Patent in suit No. 2,767,702 invalid and void and judgment dismissing the counterclaim of the defendant, and for plaintiff's taxable costs.

Judgment

In accordance with the foregoing Findings of

Fact and Conclusions of Law, it is Ordered, Adjudged and Decreed:

1. The defendant, The Coleman Company, is the owner of United States Patent No. 2,767,702.

2. Claim 2 of United States Patent No. 2,767,702 in suit is invalid and void.

3. The counterclaim of the defendant, The Coleman Company, is hereby dismissed.

4. Plaintiff shall recover its taxable costs herein in the [286] amount of \$132.47, as taxed by the Clerk.

Dated: This 10th day of July, 1958.

/s/ WM. C. MATHES,

United States District Judge.

Presented by:

CHRISTIE, PARKER & HALE,

JAMES B. CHRISTIE,

C. RUSSELL HALE,

RICHARD B. HOEGH,

ASHLEY STEWART ORR,

/s/ By ASHLEY STEWART ORR,

Attorneys for Plaintiff. [287]

Affidavit of Mailing Attached. [288]

[Endorsed]: Lodged June 30, 1958. Filed July 10, 1958.

[Title of District Court and Cause.]

NOTICE OF APPEAL

Notice Is Hereby Given that The Coleman Com-

pany, Inc., defendant above named, hereby appeals to the United States Court of Appeals for the Ninth Circuit from the summary judgment entered in this action on July 11, 1958, and from all prior orders, decisions, rulings, findings and conclusions adverse to this defendant rendered during the trial of this case.

Dated this 23rd day of July, 1958.

PARKER, STANBURY, REESE &
McGEE,

/s/ By RAYMOND G. STANBURY,
Attorneys for Defendant-Appellant, The Coleman
Company, Inc. [289]

Affidavit of Service by Mail Attached. [290]

[Endorsed]: Filed July 23, 1958.

[Title of District Court and Cause.]

CERTIFICATE BY CLERK

I, John A. Childress, Clerk of the above-entitled Court, hereby certify that the items listed below constitute the transcript of record on appeal to the United States Court of Appeals for the Ninth Circuit, in the above-entitled case:

A. The foregoing pages numbered 1 to 292, inclusive, containing the original:

Complaint.

Summons.

Stipulation extending time to plead, filed 3/8/57.

Notice of Motion and Motion for Discovery.

Minute Order 4/1/57 re plaintiff's motion to produce.

Notice of Taking Depositions.

Answer and Counterclaim.

Answer to Defendant's Counterclaim.

Notice of Pre-Trial Conference.

Stipulation and Order continuing pre-trial hearing, filed 8/15/57.

Suggestion as to the applicability of the "Low Number Rule", etc.

Stipulation continuing pre-trial hearing, filed 10/10/57.

Interrogatories to Defendant.

Plaintiff's Requests for Admissions.

Stipulation continuing pre-trial hearing, filed 12/16/57.

Stipulation extending time to answer interrogatories and request for admissions.

Notice as to further extensions or continuances.

Notice pursuant to 35 U.S.C. Sec. 282.

Defendant's reply to Plaintiff's Request for Admissions under Rule 36.

Interrogatories to Plaintiff.

Plaintiff's Answers to Defendant's Interrogatories.

Pretrial Statement.

Affidavits, Prior Art Patents and certified copy of File Wrapper in support of Plaintiff's Motion for Summary Judgment.

Notice of Plaintiff's Motion for Summary Judgment.

Memorandum in support of Motion for Summary Judgment.

Stipulation continuing pre-trial hearing and Motion for Summary Judgment.

Affidavit of Raymond G. Stanbury.

Memorandum in opposition to Motion for Summary Judgment.

Affidavits submitted by Defendant in opposition to Plaintiff's Motion for Summary Judgment.

Statement of Genuine Issues.

Reply to Defendant's Memorandum in opposition to Plaintiff's Motion for Summary Judgment.

Minute Order 4/21/58 re pre-trial hearing.

Minute Order 5/12/58 re hearing Motion for Summary Judgment.

Proposed Findings of Fact and Conclusions of Law.

Order on Plaintiff's Motion for Summary Judgment.

Notice of hearing application to tax costs.

Clerk's notice of entry of Summary Judgment.

(Certified copy) Findings of Fact, Conclusions of Law and Summary Judgment.

Notice of Appeal.

Defendant-Appellant's Designation of Record on Appeal.

B. One volume of Reporter's Transcript of Proceedings had on May 12, 1958.

C. Depositions of Alwin B. Newton, Jonathan Ewert, Charles Gale, Carl L. Burrows, F. Earl Fertig, Jr., Raymond F. Biedenbender. Taken 4/17 and 18, 1957.

I further certify that my fee for preparing the foregoing record, amounting to 2.40, has been paid by appellant.

Dated: August 19, 1958.

[Seal] JOHN A. CHILDRESS,
 Clerk.

/s/ By WM. A. WHITE,
 Deputy Clerk.

[Title of District Court and Cause.]

CERTIFICATE BY CLERK

I, John A. Childress, Clerk of the above-entitled Court, hereby certify that the items listed below constitute the 2nd supplemental transcript of record on appeal to the United States Court of Appeals for the Ninth Circuit, in the above-entitled matter:

A. The foregoing pages numbered 1 to 14, inclusive, containing the original:

Defendant's Answers to Plaintiff's Interrogatories, filed 2/11/58.

I further certify that my fee for preparing the foregoing record, amounting to 80 cents, has been paid by appellee.

Dated: January 5, 1959.

[Seal] JOHN A. CHILDRESS,
Clerk.

/s/ By WM. A. WHITE,
Deputy Clerk.

In the United States District Court, Southern Dis-
trict of California, Central Division

No. 15886-WM

HOLLY MANUFACTURING COMPANY, a cor-
poration of California, Plaintiff,

vs.

THE COLEMAN COMPANY, INC., a corpora-
tion of Kansas, Defendant.

TRANSCRIPT OF PROCEEDINGS

Los Angeles, Calif., Tuesday, Jan. 11, 1955
Honorable William C. Mathes, Judge presiding.

* * * * * [1*]

JACK KICE

called as a witness by and on behalf of the defend-
ant, having been first duly sworn, was examined
and testified as follows:

The Clerk: Will you state your name, please?

The Witness: Jack Kice.

The Clerk: K-i-c-e?

* Page numbers appearing at top of page of original Re-
porter's Transcript of Record.

(Testimony of Jack Kice.)

The Witness: That's right.

Direct Examination

Q. (By Mr. Lyon): Will you state your age and occupation, and by whom you are employed, please?

A. I am 40 years old, I work for the Coleman Company, Inc., Wichita, Kansas. The job probably requires a little explanation, because at the time of the depositions I was working—the job title that I had was assistant to the president, which would appear in the depositions, and since that time we have greatly expanded our application engineering section, and I have taken over the reorganization of that department and the service engineering department. My present job title is manager of the application engineering and service department. In this capacity I have charge of all technical matters for the sales department. That would include training and writing manuals, consultation with the design department, liaison between design and factory and [326] numerous other sections of the business.

I could probably summarize it by saying all technical matters for the sales department come under my general jurisdiction.

* * * * *

The Witness: Now, we have only been talking about fireplaces which are commonly thought of as made out of brick or stone. But [363] back in 1882 Mr. Browell—the patent, we don't have the number.

(Testimony of Jack Kice.)

Mr. Lyon: Exhibit I.

The Witness: Exhibit I. —showed a ventilated flue stack, as I have illustrated here in green on the overlay, which was made out of metal; has an inlet opening at the intermediate height above the first box. And the air that is used to ventilate the flue and keep it cool is then discharged into the room and utilized for the sake of economy. That is the first economizer as it is used in the Coleman design.

Q. (By Mr. Lyon): Mr. Kice, you have depicted substantially the device as described in the Browell patent, Exhibit I, in this overlay to Exhibit AA?

A. That is right. This illustrates very close—I don't believe there are any significant differences between what I have shown here on my overlay and the illustration in the Browell patent. In fact, there is a sketch there that I copied this from; that is, a part of the drawing is what I copied this from.

You will note that air enters the economizer——

Q. Would you mark that with a red pencil, A?

A. I have one—air enters the economizer at points A, in openings directly above the lower box, and would absorb heat from the flue and would exhaust back into the room [364] through an outlet, which I will mark B.

In the Browell patent it shows the optional alternative of going on up into second floor rooms. But

(Testimony of Jack Kice.)

what we have shown here is the practical application of the Browell patent.

Now, if I may refer back to Exhibit AB, the overlay,——

The Court: AB?

The Witness: Yes, sir.

The Court: Your last exhibit you were dealing with was——

Mr. Lyon: AA.

The Court: The Browell patent.

The Witness: The Browell patent.

The Witness: The Browell patent was the overlay on Exhibit AA.

The Court: And it is marked——

Mr. Lyon: The first one was AA that he was just discussing. Now he is discussing AB.

The Court: You mean the drawing which illustrates the Browell patent is made a part of AA?

Mr. Lyon: It was the overlay added to AA, if your Honor please.

Mr. Christie: Your Honor, it looks to me as though it is Mr. Kice's interpretation of the portion of the Browell patent; it isn't the Browell patent.

The Court: Of course, it is his interpretation.

Mr. Lyon: Your Honor, see, this is Exhibit AA originally (indicating). I mean, it was marked with all of this on. [365] Now, when he says that he adds the Browell patent, Exhibit AA, he does it by means of this overlay on top of it.

The Court: Another drawing which is attached

(Testimony of Jack Kice.)

to and is a part of Exhibit AA for identification?

Mr. Lyon: That is right, your Honor. Now, he is doing the same thing on AB, which is the side view of AA.

The Witness: You will recall that AB is a side sectional view of a typical fireplace. And we find in the art that Mr. McLeod has a patent which was allowed in 1919.

The Court: Exhibit——

Mr. Lyon: Is that Exhibit C, Mr. Kice, that you are referring to?

The Witness: That is Exhibit C, which is a metal ventilated flue stack and fireplace enclosure, that is very similar to the Holly design philosophy.

In fact, I see in this every element that is claimed by Holly. Remember that we had the lower box and the upper box, with a first radiator and a second radiator and a draft hood, with what we call a deflector.

Now, the ventilation passages that was the invention of Mr. McLeod provides ventilation from grilles at the floor level that permits a flow of air around the sides and the back of the lower radiator, or lower box, excuse me, and permits it to flow up into the second box and through it, picking up the heat from the flue, keeping it cool thereby, and [366] the heat that it picks up is discharged through a grille near the ceiling into the room.

Q. (By Mr. Lyon): Now, is that around the bottom—in this last device is there a shield between the chamber where the fire is and that——

(Testimony of Jack Kice.)

A. Yes, there is a metal shield right up the—surrounding the entire first radiator.

The Court: Now, does the air from the back of the fireplace there get over to be ejected out the front grille above?

The Witness: The space that I have shown here in blue is actually an annulus surrounding the flue passage which is made out of metal and would join on a flue going on up to exhaust the fumes outside. So it seems to me that in these comparatively early inventions we can see the elementary differences between the Coleman design, which is quite similar to the old Browell patent in 1882, and the Holly unit, which is quite similar to the McLeod patent that dates back to 1919.

* * * * *

The Court: When you use that term “heat exchanger,” are you using a term that is common in the trade? [413]

The Witness: Yes, sir.

The Court: Is it synonymous to radiator?

The Witness: More commonly called a heat exchanger than it is a radiator.

The Court: Is there a difference, or is that just a new term?

The Witness: In the language we have been using here they would be synonymous. Now, I do not believe that the secondary heat exchanger that Holly refers to, however, is synonymous with what we call a ventilated flue stack, inasmuch as they have deliberately designed, in my opinion, sir, the

(Testimony of Jack Kice.)

secondary—the lower radiator or primary exchanger somewhat smaller, and with less heat exchange capacity than we do. Because, they do depend on their secondary heat exchanger for a part of the exchange of heat between the flue gases and the air; a rather considerable part. And we are not dependent on that to operate satisfactorily. We are merely interested in ventilating that flue.

The Court: You both salvage that heat, so to speak?

The Witness: That is right.

The Court: And try to put it out in the room, and it does double duty; one, it is depended upon to heat the room, No. 1; and it tends to cool the area surrounding the lower heater, No. 2.

The Witness: That is right; just as Browell did in 1882. [414]

I would say that that about covers my exhibits.

Oh, I believe I have one more here which was Exhibit AH, already marked. And I would just like to make the comparison perhaps just a little more clearer in the action that takes place between—as comparing Coleman, as I have just done, and all of the paths of air flow that we provide to get three or four stages, depending on how you want to turn the stages; but at least three stages of ventilation cooling.

The Court: This chart is Exhibit——

The Witness: This chart that I am showing you here is AH. Oh, excuse me. The chart that I just

(Testimony of Jack Kice.)

mentioned was chart AG. Yes, sir. It shows the Coleman circulation.

The Court: That's the chart you last testified about, is it, AG?

The Witness: Chart AG was the one I was just discussing before we went over to look at the exhibit——

The Court: The chart you now have before you, AH?

The Witness: That is correct.

The Court: That involves a Holly heater?

The Witness: This shows the Holly heater that they built in and depend on. This shaded portion here would be the lower box. This darker cross hatched section is their flue or, as they would call it, the secondary heat exchanger, surrounded by a ventilation shell or annulus.

Now, they do not provide any built-in passage at all in [415] the lower section but depend on air entering through the lower grille or the—there is actually not a grille there. They just mount the unit up above the floor and the skirt covers an opening in the bottom. The grille in the front, I believe, is merely for burner air. Air comes up through here and would be free to go up through the stud space at the side of the unit in the single wall model. I frankly don't know how they get the air up the unit for the dual wall models; but I will not attempt to explain that. Air can come up through here (indicating). Now——

(Testimony of Jack Kice.)

The Court: "Here" being the annulus between the lower box and the stud, is that right?

The Witness: One of the paths is between the lower box and the stud, and the other path that I have attempted to illustrate is merely in the column area at the side of the shell.

The Court: By that do you mean the area between the radiator and the wall of the shell?

The Witness: I believe I can illustrate on their exhibit better.

This space which would be alongside of the lower box.

The Court: Between the outside of the lower box and the inside of the trim, is that right?

The Witness: That is correct; between the outside of the lower box and the inside of the shell or trim. It provides—— [416]

The Court: Shell or trim being Exhibit——

Mr. Lyon: 20-A, I believe, your Honor.

The Court: 20-A?

Mr. Lyon: What is the tag on there, Mr. Kice?

The Court: Exhibit 20-B, would it not, called "panel"?

The Witness: 20-B is the identification.

The Court: The shell is 20-A. That is the secondary heater.

The Witness: Now, that would be ventilated, just a small area of ventilation permitted at the top of the trim, as I understand their design.

The Court: I said Exhibit 20-A. It is Exhibit

(Testimony of Jack Kice.)

20. The lower box, the radiator, Exhibit 20, Holly.

The Witness: Thank you. Now, the air that I have just been referring to has only one outlet, which is the grille in the economizer. Excuse me. The grille in the secondary heat exchanger, which I will shade up here in blue. The path of flow then has to come around the solid brackets that they provide, and would come out of the grille into the room as I have shown here in the blue lines, and will indicate with arrows at the extremities.

The Court: That is the upper grille?

The Witness: That is the upper grille of the Holly secondary heat exchanger. The flow of air around the flue, which they referred to as the secondary exchanger, would be [417] somewhat as I have shown with the spiral lines, I believe. There is some question in my mind as to what occurs in this more or less stagnant portion above the grille. But I would presume that part of that heat would find its way out of the grille. A part of it would find its way as conduction and convection through the wall. And that single stage is the Holly arrangement and the multiplate stage is the Coleman arrangement.

The Court: Now, with respect to the Holly, where do you say the air comes from that is emitted from the upper grille?

The Witness: The Holly unit depends on its air supply from the opening near the floor; and is dependent on a channel being provided by the car-

(Testimony of Jack Kice.)

penter or the plasterer between the lower portion and the stud space.

The Court: In other words, it is your understanding that all the air which is emitted from the upper grille must come from the space between the studs and the heater, exterior of the heater box?

The Witness: That is my understanding exactly. And it is the way I read their patent.

I don't believe there is anything else. [418]

The Court: None of it can come from the so-called lower box proper, the interior of the lower box?

The Witness: No, your Honor. The air supply for the secondary heat exchanger must come from the space outside the lower box, between it and the stud space.

The Court: By the lower box I mean Exhibit 20, and you so understand it, do you?

The Witness: Does Exhibit 20—that includes this? Yes, sir.

The Court: It does not include the trim?

The Witness: They could get a little air up through the columns of the trim.

The Court: Up into the——

The Witness: Up into the space above the lower box.

The Court: Up into the heat exchanger?

* * * * *

PLAINTIFF'S EXHIBIT No. 11

[Letterhead of Dawson, Tilton & Graham]

HD:m

April 15, 1953

James B Christie, Esq.,
595 East Colorado Street,
Pasadena 1, California

Dear Mr. Christie:

Re: Holly Manufacturing Company

Patent No. 2,602,441—

The Coleman Company, Inc.

I have forwarded your letter of March 3, 1953, to The Coleman Company, Inc., and have received a communication from the company with respect to tests which it has performed.

I am advised that when the unit is properly installed, the air flow from the space about the lower box into the upper box is inconsequential. Of course, to make the structure hermetically sealed would require extremely tight joints, which are difficult to get in a plaster wall. It was felt by the Coleman technical people, however, that the trace of air flowing upwardly was inconsequential.

I have now been advised by Coleman that in view of the comments in your letter, they have decided to make a further change in the structure in which the upper unit is seated within the lower unit so that there is no possibility of any flow of air from the space about the lower unit into the

upper box. I believe that this will satisfy your client and I shall plan to send you a copy of the drawing of the new structure in the very near future.

DAWSON, TILTON & GRAHAM

/s/ By HORACE DAWSON
cc The Coleman Company, Inc.
Wichita 1, Kansas

Attn: Mr. Jess L. Moore, Jr.

PLAINTIFF'S EXHIBIT No. 12

[Letterhead of Dawson, Tilton & Graham]

HD:m

June 4, 1953

James B. Christie, Esq.,
595 East Colorado Street,
Pasadena, California

Dear Mr. Christie:

I am enclosing a sketch of the Coleman wall type burner. The Coleman Company has given me working drawings, but in order to make the matter clear, it seemed to me better that a drawing should be prepared similar to the one shown in the Hollingsworth, et al. patent, and, accordingly, I have had such a drawing made.

In the drawing, you will note that the second or upper box 10 is closed at its bottom and that it is open only at its forward intake end 11. None of the air from about the lower box is thus able to enter the upper box 10. Instead, the air that enters the upper box 10 is room air passing through the entrance 11 and extending upwardly about the pipe 12 and outwardly through the discharge opening 13.

I am enclosing also photostatic copies of an advertisement of the Metalbestos Vent Assembly, which advertisement came out several years prior to the filing of your client's application for patent. The advertisement shows a wall heater, and more particularly a vent structure which is employed with a wall heater. The Metalbestos Wall Heater Vent Assembly is used with the common wall heater in which there is a central radiator, a burner for heating it, a stack, a draft hood provided with a relief opening into the room, and the usual outlet and inlet passages. Over such a wall heater is placed The Metalbestos "Wall Heater Vent Assembly", which has an inner radiator communicating with the stack of the wall heater and about the radiator is a second box having inlet parts for receiving air in the lower part of the chamber. Any air leaking upwardly from about the lower box will pass into the second box of the Metalbestos Wall Heater Vent Assembly. We call this structure to your attention because your client has been concerned with the fact that a trace of air may leak past any

barrier placed in the studding space and find its way into the upper box. A studding space, with the rough plaster therein, is, of course, difficult to seal, and in the prior Metalbestos installations, it is found that a small amount of air passes upwardly around the barrier and into the second box.

Yours very truly,

DAWSON, TILTON & GRAHAM
/s/ By HORACE DAWSON

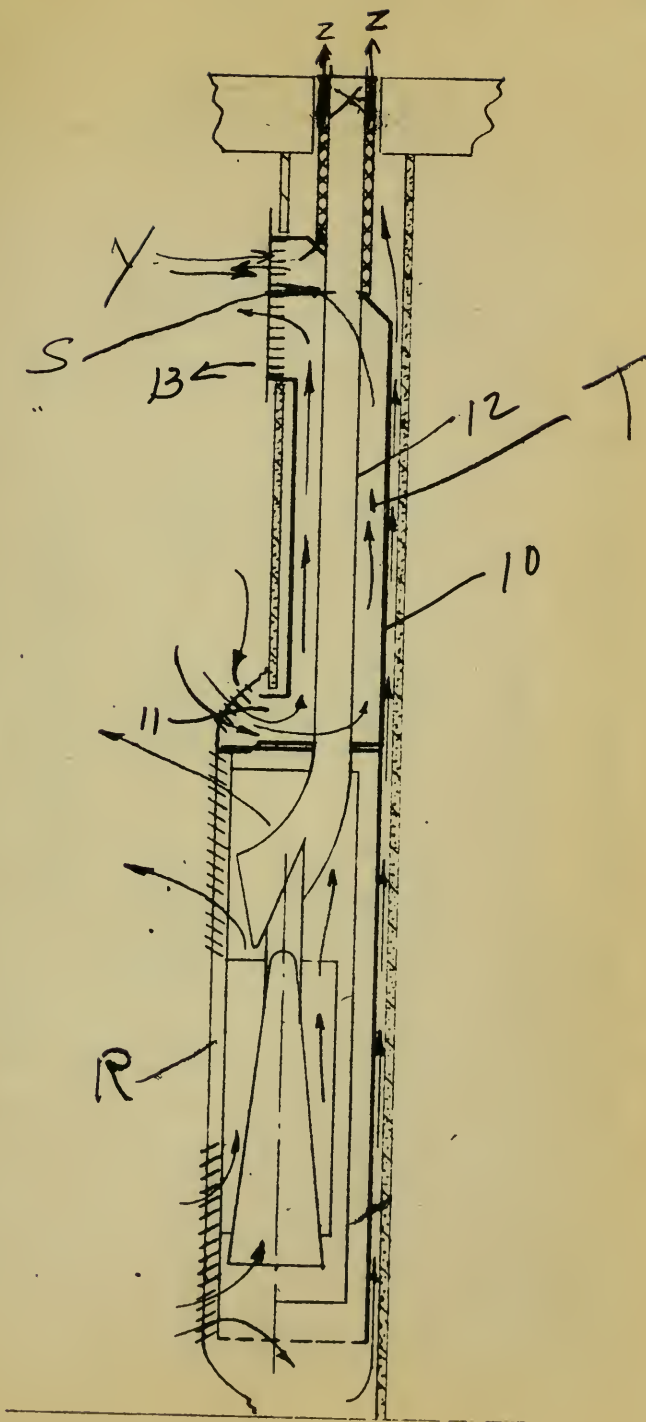
Encs.

cc The Coleman Company, Inc.

Wichita 1, Kansas

Attn: Mr. Jack Kice

854
entire
sheet #1
205



PLAINTIFF'S EXHIBIT No. 43

DATA ILLUSTRATING COMMERCIAL SUCCESS OF NEW
TYPE HOLLY WALL HEATERS

Year	*Total National Wall Heater Shipments Units	Holly Wall Heater Shipments Units	% of National Market	Holly Wall Heater Orders Units	Holly Backlog End of Year Units
1949.....	5,669
1950.....	212,366	**23,935	11.3	26,011	6,551
1951.....	205,486	***39,319	19.1	40,553	7,070
1952.....	260,721	49,046	18.8	60,790	18,469
1953.....	330,272	48,267	14.6	52,691	21,200
1954.....	† 350,000	61,406	17.5	74,335	34,166

* Figures from Bureau of Census, U. S. Dept. of Commerce

** 2,705 new type, balance—old type

*** 37,872 new type, balance—old type

† Based on 10 months reports; last 2 months estimated at average 1954 monthly level

[Title of District Court and Cause.]

TRANSCRIPT OF PROCEEDINGS

Los Angeles, January 24, 1955

* * * * *

The Court: What do you say to Mr. Christie's contention that this correspondence in evidence indicates defendants promised to seal off the lower box, but did not do it?

Mr. Lyon: I think we have. And I think all the way [686] through—I don't think any of these devices have used the principle of this device. It is entirely the principle of that 1882 patent and not the McLeod or the patent in suit. It is that you take the air in here and cool the device (indicating).

The Court: Upon what basis does the defendant claim an invention was taking in of the air in the front?

Mr. Lyon: I do not know, your Honor. We haven't got a patent. Many manufacturers, as your Honor knows, will file an application to protect himself from having somebody filing on the same thing. Now, I don't know what the principle was that they filed on this. We didn't say we had a patent. In fact, I can state to this court we don't.

The Court: I assume someone made an affidavit with respect to the patent.

Mr. Lyon: That he thought it was an invention at the time he drew it. But I can tell the court right here and now that the application was rejected on the Browell patent, if you are interested

in that. I don't think it is germane to this case.

Now, we go to these——

The Court: It wouldn't be decisive, but it might be some indication of the seriousness of the defendant's position on the issue of novelty.

Mr. Lyon: That is right. [687]

* * * * *

[Endorsed]: Filed April 1, 1955.

[Title of District Court and Cause.]

TRANSCRIPT OF PROCEEDINGS

Los Angeles, September 10, 1957

Before Theodore Hocke, Special Master.

* * * * *

HORACE DAWSON

called as a witness on behalf of the defendant, being first sworn, was examined and testified as follows: [11]

* * * * *

Cross Examination

Q. (By Mr. Hoegh): Mr. Dawson, when did you first become aware of the Holly patent?

A. I think it was just shortly after the patent issued.

Q. Did you know at that time that a possible charge of infringement would arise?

A. I think so.

Q. Didn't the Coleman Company know that?

A. I should think so.

Q. That would be the middle of 1952, about?

(Testimony of Horace Dawson.)

A. Well, it was shortly—I think in the record there is a copy of a letter of infringement notice sent.

Q. Yes. Despite your advice to the Coleman Company on these aspects of mode of operation of the Coleman device the [17] District Court laid at rest those questions, did it not?

A. The court decided that there was infringement.

Q. And that was affirmed by the court of appeals? A. That is correct.

Q. And the way in which the court would determine the infringement would be to decide that those, that the Coleman device functioned in the manner taught by the Holly patent, isn't that true?

Mr. Stanbury: Well, I will object to that as calling for the conclusion as to the way the court would decide that.

Mr. Hoegh: I assume Mr. Dawson is here as an expert on what he has given his advice as an expert on what he considered to be a matter for the question of infringement and validity.

Mr. Stanbury: We know the court has declared his advice wrong. That is self-evident.

Perhaps the question conveyed more to my mind than you meant.

Mr. Hoegh: I will withdraw it.

Q. (By Mr. Hoegh): Mr. Dawson, you stated you prepared the patent application on behalf of Mr. Giwosky. A. That is correct.

(Testimony of Horace Dawson.)

Q. What was the primary reference cited by the Patent Office against that application?

A. I don't remember the primary reference, but there are five patents listed here as references, and among them [18] is the Hollingsworth patent, 2,602,441.

Q. Do you recall whether you had particular difficulty in getting around the Hollingsworth patent?

A. I don't recall the difficulty. I know there is difficulty in prosecuting any patent application; that the art is cited and you have to argue for the features which you regard as important novel features. And there the important feature was that instead of bringing the air in from the bottom of the casing around the lower heater that the air was admitted freely through a vent in the very front of the economizer, so that the room air could be utilized in cooling the top of your heater.

Q. Do you recall how many office actions you were faced with in that application?

A. I just don't remember.

The Court: Was that patent passed upon by the District Judge in deciding this case?

Mr. Hoeg: No, it was not. At that time it was merely an application for patent.

Special Master: It had not been issued at the time of the decision?

Mr. Hoegh: That's right.

Q. (By Mr. Hoegh): You have described what you consider to be the differences in the mode of

(Testimony of Horace Dawson.)

operation between that shown in the—or, taught in the Hollingsworth patent and [19] that practiced by the Coleman Company.

Did you ever advise the Coleman Company to completely shutoff the flow of air from around the lower box into the economizer?

A. It seemed to me that the structure shown in the Giwosky patent in effect closed off all the air, because the economizer shown in the patent opposite on the forward side where it vents directly to the room, and I would assume that that cut off the flow of air from the lower part of the casing.

Q. I would like to show you, Mr. Dawson, a letter which is reproduced on page 514 of the record on appeal in this case and ask you if the statements that are set forth in the second paragraph of that letter are similar to what you just described about the Giwosky patent?

A. I think that is correct. Shall I read the paragraph?

Q. Would you, please?

A. "In the drawing, you will note that the second or upper box 10 is closed at its bottom and that it is open only at its forward intake end 11. None of the air from about the lower box is thus able to enter the upper box 10. Instead, the air that enters the upper box 10 is room air passing through the entrance 11 and extending upwardly about the pipe 12 and outwardly through the discharge opening 13." [20]

(Testimony of Horace Dawson.)

Q. On the following page I believe a drawing is reproduced, Mr. Dawson.

A. Yes. On page 516 there is a drawing reproduced, and this seems to be a drawing with the steps shown in the patent.

Q. Could you correlate the numbers, just briefly, as to what you have been talking about?

A. The number 10 is shown in the patent as No. 22, and the entrance 11, I believe, would probably be the part indicated by 20 in the patent.

Special Master: Now, you say that was a letter, Mr. Hoegh?

Mr. Hoegh: Yes, a letter addressed to Mr. Christie dated around April of 1953, I believe. That is correct, is it not?

The Witness: June 4, 1953.

Mr. Hoegh: And the drawing which Mr. Dawson referred to in the record is a drawing which accompanied the letter.

Special Master: In trying to distinguish the two devices?

Mr. Hoegh: That, and pointing out what the Coleman Company was going to do to avoid infringement.

Special Master: To avoid infringement.

Mr. Hoegh: Yes.

Q. (By Mr. Hoegh): Are you familiar with the production models of the Coleman Company in these particular model numbers, [21] Mr. Dawson?

A. I don't believe that I am very familiar with those.

(Testimony of Horace Dawson.)

Q. Did you ever investigate whether or not the statements you have made there were actually true as to the Coleman Company devices?

A. Well, I thought they were true, that this was an accurate statement as to the structure.

Q. Did you observe any tests prior to the time that you made those statements in that letter?

A. I observed some tests that were made prior to taking some depositions in Wichita, and I don't remember what that date was. That probably would be a later date.

Q. Those were the depositions Mr. Christie and I attended?

A. Yes. That would be a later date.

Q. I believe that was in January of 1954.

A. I see.

Q. Would that refresh your recollection on it?

A. Yes. I don't believe that I observed tests prior to writing this, tests made on the structure.

Mr. Hoegh: No further questions. [22]

* * * * *

DEAN OLDS

called as a witness herein by and on behalf of the plaintiff, having been first duly sworn, was examined and testified as follows: [554]

* * * * *

Direct Examination

Q. (By Mr. Hoegh): Mr. Olds, what is your occupation?

A. I am a consulting engineer.

(Testimony of Dean Olds.)

Q. During the period from, say, 1949, through 1952, what was your position?

A. I was in charge of major appliance design of the Coleman Company.

Q. Were you on any of the executive committees of the Coleman Company?

A. I was a member of the board of directors, executive committee, the Long Term Planning Committee, and the New Products Committee.

Q. What is the make-up or who are the members of the New Products Committee?

A. Essentially the major executives of the company, including all the divisions, of course, and other individuals were called in as required.

Q. In the operations of the Coleman Company what are the functions of the New Products Committee?

A. To consider new products, to authorize the design department to proceed with development of those new products, to consider the result of the design department effort, to approve or disapprove. Included in the process, of course, would be a consideration of potential market, cost of tools, [556] capital equipment, et cetera.

Q. When you say the committee included heads of the major departments in the company, would that include the sales department?

A. Yes. At that time Carl Burrows, vice president of sales, often accompanied by Lou Marks, promotional sales manager, and Whelan Richards, who was Mr. Burrows' assistant.

(Testimony of Dean Olds.)

Q. Would someone have been there from the production department?

A. Clarence Coleman, vice president of production, represented production, and brought with him others at times.

Q. Was there an established chairman of the committee?

A. Chairman of the committee normally was Sheldon Coleman, president of the company.

Q. Was Sheldon Coleman a member of the committee?

A. Well, I would say so, yes, sir.

Q. In general, where did ideas for new products come from, Mr. Olds?

A. I would say most frequently from the sales department. Normally, that would not come in the form, perhaps, of a new idea, but rather of a demand and need that they had encountered in the field. I think that would be the normal source of ideas that came to this committee. [557]

Q. Do you recall when the Coleman Company first began to consider a wall heater with a secondary heat exchanger?

A. My recollection is that that would be in the fore part of '51. And by referring to the minutes I find that on Saturday, April 29th, Clarence Coleman, who, as I recall it, had just returned from a trip to the West Coast, discussed the need for a single stud space 35,000 BTU input furnace.

If I may, for just a moment, I would like to call attention to some of the problems that then ex-

(Testimony of Dean Olds.)

isted. We had not been outstandingly successful in competing in this market because we found that the West Coast manufacture was much more flexible than we were. We found ourselves in a similar position as reported by Clarence Coleman at that time. A new unit had come on the market; one of our competitors had produced a single stud space 35,000 BTU unit. The significance of the 35,000 BTU was this: Housing trends had changed again on the Coast. At that particular time a 3-bedroom house seemed to be the most popular thing with the builders, and it happened—or, not happened, but one of the essentials in heating a house of that kind was approximately a 25,000 BTU unit for the bedroom area; a 35,000 for dining room and so forth. So the new house building market at that particular time, he warned us, was going very strongly to this 2-wall unit type of heating requirement; and the 35,000 stud and a half space unit which we then had was not [558] acceptable because of excessive installation costs.

That was the nature of his report at that time.

Q. That was Clarence Coleman's report?

A. Clarence Coleman.

Q. Following a meeting he had out here?

A. He had had a meeting with the West Coast group, yes, sir.

Q. Do you recall that Larry Carney, Jr., was in the sales department here in Los Angeles at that time?

A. I think Larry Carney, Jr. was assistant to

(Testimony of Dean Olds.)

the then branch manager, a chap named Stevens.

Q. Did you at any time receive reports directly from Mr. Carney as to the need for a 35,000 BTU unit? A. Quite frequently, yes, sir.

Q. Referring again to the minutes dated April 29, 1951, Mr. Olds, were any instructions given by the New Products Committee to the Design Department?

A. Yes; which could be summed up in the statement that we must have something that would be strictly competitive with the Holly unit, which would consist—if I may enumerate some of those points—of a single stud space 35,000 BTU unit. We at that time knew of no way of producing such a unit without a heat exchanger, so that, in turn, led to the necessity of some type of heat exchanger.

Q. What happened after the Design Department had been [559] given the go ahead on that?

A. We started work immediately on that development, and in the process conceived the idea that if we placed a register immediately above the wall heater unit itself for the inlet of room air and then exhausted at a point near the ceiling level we would have a better chance, both of cooling the flue and obtaining more circulation.

We produced such a unit, ran preliminary tests on it, enough to satisfy ourselves that it worked satisfactorily, and submitted that back to the New Products Committee.

Q. Do you recall, from reading the minutes, whether that was done at any of these meetings

(Testimony of Dean Olds.)

that are shown there? A. I beg your pardon.

Q. Do you recall, from looking at those minutes, whether that may have been the subject of one of the meetings?

A. I do not find any reference to that particular meeting, no, sir.

Q. Looking to the minutes there for July 12th there, Mr. Olds, could you describe what happened at that particular meeting with respect to the design you had come up with?

A. Well, by this time the proposal which I just mentioned had been made by the Design Department was no longer the subject of consideration.

Q. At some intermediate meeting had this design been discussed in the New Products Committee? [560]

A. Yes, sir, and was rejected by that group.

Q. Do you recall what member of the Committee was primarily the one who caused that to be rejected?

A. No. I think it was Committee action.

Q. Was any particular Committee member primarily interested in seeing that that design was not followed? Any representative from the sales department, for example?

A. I was instructed by the chairman not to continue that development. The sales department expressed the opinion that the unit that we proposed would not be competitive to our competition, Holly, at that time. They offered us reasons; the fact that more plastering work would be required;—in other

(Testimony of Dean Olds.)

words, they expressed a strong preference for our competitive unit-type of design.

Q. At the meeting on July 12th, can you gather from the minutes there the importance of this project to the Coleman Company?

A. Very much so. Again, the situation was the question of priority of design effort, particularly, between two products which we felt desirable for this market; the one which we have been discussing, the wall heater with extended heat exchanger; and the other, a shallow low-cost master furnace which had top priority up to this point. It was more or less explained in these notes—it was decided, and particularly Sheldon Coleman, who made a study of the subject, [561] suggested to the Committee that top priority be given to the wall heater line at that time. In other words, this is the point at which we were given not only a go ahead, but quite a push.

Q. Did the New Products Committee know at that time that the Holly Manufacturing Company had applied for a patent on its wall heater?

A. Yes, I believe so. At a previous meeting—that is the meeting which I referred to when the 2-register structure was submitted—the Design Department, after the decision to abandon that structure, which we in the Design Department felt would not infringe a possible Holly patent. Our reasons were that we had made a search of heat exchangers in general. We felt that a heat exchanger of that type was obviously old.

(Testimony of Dean Olds.)

At that meeting I recall making a remark, "Well, what happens if we go ahead on this structure which is so close to Holly and Holly does obtain a patent on that particular structure?"

Q. Was discussion of the group directed to that problem?

A. Very definitely, by my remarks, yes, sir.

Q. What was the decision?

A. The decision was made the same. The chairman of the Committee not only instructed me to go ahead, but when I [62] asked what situation we might be in in the event of an issuance of the patent to Holly, he told me that he would take care of that matter when it came up.

Q. This was Mr. Sheldon Coleman?

A. Sheldon Coleman, chairman of the Committee, yes.

Q. Going on to the minutes again, Mr. Olds, on November 21st, would you state what had happened in the Coleman Company's development program by that time?

A. November 21st?

Q. Yes.

A. By this time the design had been finalized in so far as the Design Department was concerned. We were ready to release from design. The model was submitted to the New Products Committee and, as noted here, was received by them and was approved by them.

Q. What did that device look like? How did it function and what were its parts?

A. To the best of my memory it would be a

(Testimony of Dean Olds.)

device very similar to the drawing shown here.

Q. Like the Holly one? A. Yes.

Q. By "the drawing shown here," you are referring to a chart on the blackboard there, is that correct?

A. Yes. That is a Coleman unit, is it not?

Q. Yes. [563] A. It looks so to me.

Q. Was the Coleman unit submitted to the American Gas Association for approval at that time?

A. Yes, sir. Immediately following that meeting on approval, our normal practice would be to submit to AGA for test and approval. Normally we allowed a 60 to 90-day period before we started tools. My recollection in this case is that we started some tools at about the time of submittal to AGA; our reason again being that we definitely wanted to produce before the heating season of '52. [564]

Q. Can you ascertain from the minutes subsequent to that date whether or not you went into production on any of the components for these heaters?

A. My recollection is—if you will pardon me, I will look at the minutes here a minute—there is mention of the subject.

I might comment that in some of these subsequent meetings between these two periods there are established target dates for production of the various units in this line.

Q. Directing your attention to the meeting——

A. I beg your pardon?

(Testimony of Dean Olds.)

Q. I was going to direct your attention to the meeting of March 1952.

A. March 5, 1952. Now your question, sir?

Q. Whether there was anything in that which would show that you were building up components to go into these wall heaters.

A. Yes, I would say there is. It is more the nature of the wording of this particular report that supports that. Lyn Hibbs, as I recall it, was assistant to Clarence Coleman, in other words, assistant to vice president of production, you will note that he is recommending at this time that schedules be correlated so that the heat exchange, lower heat exchange units of the economizer model be produced jointly with the economizer. In fact, he goes further and recommends [565] that a bank of economizers be built in advance.

Q. Would that have included a bank of combustion chambers as well?

A. That's right. That is the A-19. I beg your pardon. Did I refer to the economizers there?

Q. Yes, you did.

A. It was my intention to say the combustion chamber proper, which was the A-19.

Q. Was there anything in that meeting relating to the economizer itself?

A. Yes, sir. 68 310 economizer, the group was advised that this item was required for Model 67 and 68 gas wall heaters with A-19 ceramic coated combustion chamber, and therefore should be produced at the same time we are producing 67's and

(Testimony of Dean Olds.)

68's. Production date of August 11, 1952, was approved for this item.

At this time of course we are definitely in the tool-up stage, have to be.

Q. During this time the Coleman unit was at the American Gas Association, is that correct, Mr. Olds?

A. Yes, sir, the unit was on test approximately one year at the American Gas Association.

Q. When the Coleman Company did obtain approval of its wall heaters, these models 64, 67, 68 and 69, were those approved as a unit? [566]

A. Yes. I think you refer now to whether or not the heat exchanger was a separate portion of the unit?

Q. Yes.

A. No; they were approved as a combination unit.

Q. By the American Gas Association?

A. That's right. They had to be assembled together at the dwelling. Must be used together.

Q. During any of this time, or shortly after this time when you got approval on your unit, Mr. Olds, did you talk to Mr. Johnson from the Holly Manufacturing Company?

A. Yes, sir, I received a copy of the Holly patent from Mr. Johnson in August of '52. I came to the Coast in the forepart of September to discuss the possibility of obtaining a license from Holly.

Q. And you talked to Mr. Johnson about that specific subject?

(Testimony of Dean Olds.)

A. I talked to Mr. Johnson on that, yes, sir.

Q. What was the purpose of your meetings, specifically?

A. To try to obtain a license.

Q. Were you making inquiry of a license, as to the possibility of a license?

A. Yes, and perhaps stronger; if I could carry through the negotiation, I was authorized to do so.

Q. What was the result of that meeting, Mr. Olds?

A. Indefinite. Mr. Johnson told me that he had not [567] given the matter consideration, full consideration, at that time. He neither rejected the possibility of obtaining a license, nor did he tell me that he thought it would be possible or likely.

Q. Do you recall about when the American Gas Association did approve these four models, Mr. Olds?

A. I again have tried to check notes on that subject. From the records of the American Gas Association I am told that it was prior to September 20, 1952. I gather from the earlier conversation that subject has not been definitely settled.

Q. Mr. Olds, I believe you stated you were on the executive committee of the Coleman Company—

A. That is correct.

Q. —during this period we are discussing?

A. I am sorry?

Q. During the period we are discussing here?

A. That is correct.

Q. 1950, '51 and '52?

A. Yes, sir.

Q. What is the function of that board?

(Testimony of Dean Olds.)

A. To act for the board of directors between meetings of the directors. [568]

* * * * *

Mr. Hoegh: Mr. Johnson, please.

J. STANLEY JOHNSON

called as a witness by the plaintiff, being first duly sworn, was examined and testified as follows:

Special Master: Will you state your name and address, please?

The Witness: J. Stanley Johnson, 2062 Pinecrest Drive, Altadena, California.

Direct Examination

Q. (By Mr. Hoegh): Mr. Johnson, what is your present occupation?

A. My present occupation is a vice president of the Siegler Corporation.

Q. How long have you had that position?

A. I have had that position since Holly was merged into Siegler in November of 1955.

Q. How long had you been associated with Holly Manufacturing Company prior to that time?

A. Well, I founded Holly Manufacturing Company in 1938. [722]

* * * * *

Q. (By Mr. Hoegh): Mr. Johnson, after the patent was issued did you ever discuss with representatives from the Coleman Company whether you would grant them a license under the patent?

A. I did.

(Testimony of J. Stanley Johnson.)

Q. Which representative of the Coleman Company was that? A. Mr. Deans Olds.

Q. And this was a meeting that took place in September of, roughly, 1952? [782]

A. That's correct.

Q. Did you tell Mr. Olds whether or not you would grant a patent, or a license under this patent? A. I told him that we would not. [783]

* * * * *

Redirect Examination * * * * *

Q. (By Mr. Hoegh): Mr. Johnson, did the Holly company ever consider the possibility of cutting off any air flow from the space around the lower box into the economizer or secondary heat exchanger?

A. We considered that and the possible result.

Q. Did you think it was possible to do that?

A. We didn't think we could do it and meet A.G.A. tests? [843]

* * * * *

WALTER M. BERRY

called as a witness by the defendant, being first sworn, was examined and testified as follows:

Special Master: Will you give me your name and address, please?

The Witness: Walter M. Berry, B-e-r-r-y; 2160 Lennington Avenue, West Los Angeles. [859]

Direct Examination

Q. (By Mr. Stanbury): Mr. Berry, what is your occupation, sir?

A. I am a consulting gas engineer.

(Testimony of Walter M. Berry.)

Q. Will you give us an account of your academic and professional background. Just take the time and give us a brief autobiography of those matters, please.

A. I graduated from the University of Oregon, having majored in chemistry and engineering. Immediately after graduation I went with the Portland Gas & Coke Company in Portland, Oregon, as an engineer and chemist. I was with them for eight years.

Following that, I went to the United States Bureau of Standards in Washington, D. C. as a gas engineer. When I left there seven years later I was chief of the section in gas engineering.

I left the Bureau to come to California as executive engineer for an organization called the California Gas Research Council, an organization sponsored by the California State Railroad Commission and supported by all the California gas companies.

After three and a half years with them, I went into consulting work and, with the exception of three years when I was in the procurement section of the Air Force, I have been doing consulting work in almost every branch of the [860] gas business. However, in recent years most of my work has been in the design and testing of gas appliances. And I represent local and out-of-state manufacturers who send their appliances to the American Gas Association laboratory for approval tests.

Q. Have you done any writing on your subject?

A. Yes. I am the principal author of a number

(Testimony of Walter M. Berry.)

of Bureau of Standards publications, and I wrote extensively for gas journals a number of years ago.

Q. And on behalf of the Coleman Company have you made some efficiency tests of a Coleman wall heater Type Model 67? A. I have.

Q. When did you make these tests, sir?

A. The first series of tests was made at a private laboratory on May 1st and 2nd.

Q. This year?

A. This year. The second series was made at the Coleman plant here in this city on September 3rd and 4th. And a later series of tests was made on September 15th and 16th.

Q. All right. Now, what standard did you use to test the efficiency of the heater?

A. We had the appliance set up in a test board exactly the same as the test board used by the American Gas Association laboratory, with the probable exception that we did not have thermocouples in the back of the economizer section. [861]

Q. All right. What standard of efficiency did you apply?

A. We used the method used by the laboratory by adjusting the gas appliance to its normal rating as close as possible, using wet meter for measuring the gas, and otherwise trying to maintain uniform conditions throughout the series of tests. We measured the gas, of course, and determined the heat loss 15 minutes after starting the heater; and we determined the carbon dioxide in the products of combustion taken at a point six inches below the

(Testimony of Walter M. Berry.)

top of a four-inch flue, insulated flue I might say, and measuring the temperature at the same time. From tables supplied by the laboratory, we determined from those two values the percentages of heat loss in the products of combustion and the difference in the amount of heat supplied to the appliance; and the heat loss in the products of combustion is considered the efficiency of the appliance.

Q. In your answer you referred to "the laboratory" twice. What laboratory do you mean?

A. The American Gas Association testing laboratory.

Q. Is this formula as you have described having used here the AGA formula for testing efficiency?

A. It is.

Q. Now, did you make efficiency tests on this heater in its normal operating condition? [862]

A. We did.

Q. For comparative purposes, did you make efficiency tests of this heater with the air in the wall spaces around the lower box sealed off so that none could get into the economizer? A. We did.

Q. Did you make tests of the heater efficiency with and without an appliance called a chute in it?

A. I did.

Q. This makes four tests, four kinds of tests all together, does it not? With and without the chute, back wall air sealed off and not sealed off?

A. That's right.

Q. All right. Now, when you made the first se-

(Testimony of Walter M. Berry.)

ries of tests on May 1st and 2nd of 1957, did you at that time test with the chute?

A. We did not.

Q. Only without the chute?

A. That's right.

Mr. Stanbury: May I use the blackboard here, your Honor.

Special Master: Yes.

Mr. Hoegh: Just a moment. While you are getting into that—I know what is developing here and I think that the plaintiff—well, I know the plaintiff doesn't think this [863] line of inquiry is proper in this proceeding. These are matters which I understand Mr. Berry will testify to relating to the efficiency of these heaters with these various modifications. And during the contempt hearing the finding of the trial court there was that:

“Prior to the addition of the chute the defendant's wall heaters——”

These are the infringing models——

“such wall heaters were constructed so that the so-called economizer was adapted to receive air flowing upward outside the lower box and inside the wall as taught and claimed by the patent in suit. When such wall heaters were installed and placed in operation a substantial quantity of air entered the economizer of such wall heaters from around the back and sides of the lower box. The quantity of air entering the economizer from around the back and sides of the lower box of defendant's wall heaters previously found to in-

(Testimony of Walter M. Berry.)

fringe was of sufficient quantity to affect materially the efficiency and operation of such wall heaters."

I don't think that any information that Mr. Berry might testify to as to what the situation was as to those wall heaters has any place in this proceeding. Those are matters which have been thoroughly gone into by the trial court and [864] resulting in that particular finding.

Mr. Stanbury: Your Honor, the question of the contribution of this infringing air to this heater has never been tried anywhere. If I am wrong in that counsel need only show us some finding. It's never been tried.

The testimony was given here that this heater could not be made to function without the infringing air, and we are undertaking to prove just the opposite. And one of the elements in determining what a reasonable royalty is is certainly the value of the contribution of the infringement to the invention.

So, I submit that the record would have a vacuum in it if we were not allowed to show what effect this had. I repeat, it has never been tried. It's never been material.

We have, furthermore, this extraordinary situation that is a matter of record in this case. The figures originally used—and I indict both sides in saying it, and I hasten to say I have no credit coming to me as change of counsel, as the facts came out, because the error was on the part of the technical advisers and not the lawyers—but the

(Testimony of Walter M. Berry.)

original decision was based upon data which is now known to be sadly erroneous, and, according to undisputed testimony—if there is any contradiction the plaintiff can introduce it, but up to now it hasn't been introduced at all—it was on data that was mistaken because the inside source of non-infringing [865] air was overlooked by both sides, and the formula used by Mr. Landsberg included non-infringing air with the infringing air. And while on the contempt hearing no expressed finding was made on this subject, the judge's comments show that he realized—and one can read the arguments and see—not only was there no evidence to the contrary, but not even any argument made to the contrary. So that we are now concerned, I respectfully submit, with this issue, if no other: Is it true that we needed the infringing air to make this heater function? If we did, it is a very different situation than if—well, it is like, something like water leaking into a boat that you don't want and can't use. And I don't know how your Honor or anybody else can fix a reasonable royalty in this case without knowing that, among other things, whether it's any good to use or not.

Mr. Hoegh: Your Honor, I am sure it is not the function of this proceeding to concern itself with error as it may have been made in the trial of this case by the defendant. The plaintiff submits no such errors were made, because of the manner in which these heaters were constructed, and that the defendant put on the best case possible.

(Testimony of Walter M. Berry.)

And in spite of that the trial court found that with the devices manufactured by the defendant the defendant knew about this patent and it still decided to go ahead and willfully infringe. Matters of efficiency were presented to the trial court to enable it [866] to ascertain the manner in which the wall heaters manufactured by the defendant functioned, and despite that testimony the trial court held that those heaters were adapted to function in the same way as taught by Hollingsworth. So that those matters have been thoroughly gone into in the trial court as to these particular problems. We don't have any question about them now. Those questions are laid at rest.

Mr. Stanbury: Your Honor may be under the impression that the Landsberg testimony, about which Mr. Landsberg honestly retracted, saying if there was this inside passage—and that's an indisputable matter, it has not been disputed, and can't be disputed—his data meant nothing. But your Honor may be under the impression that his test had to do with efficiency. It didn't at all. When Mr. Hoegh says the question of efficiency has been gone into here, it has never been gone into in any way directly or indirectly in the entire proceeding. Mr. Landsberg's testimony was solely concerned with what percentage of infringing air got into that economizer.

And there have been general statements that you have got to have it to have an efficient heater; general statements, such as by Mr. Johnson, that

(Testimony of Walter M. Berry.)

you can't make the heater without this infringing air, or words to that effect. But there has been no trial of that issue.

I will go a step further. Let us assume that Mr. Landsberg's original data was correct—which is an absurd assumption; it is grossly in error, just way off—but let [867-868] us assume that it was correct and that instead of three per cent 20 per cent of air in the economizer was infringing air. Your Honor has nothing in the record to guide him at all to decide whether that contributed to the efficiency or the cooling of the walls of this heater, or how much; and I repeat that if it appeared that whether that is 20 per cent or three per cent, if we can't use the heater without the infringing air, it wouldn't function, that is one thing, and if it makes no difference whether it be 20 or three per cent in the function of the heater, that is another thing. And I certainly don't understand how your Honor is going to decide a reasonable royalty in this case without knowing this. In fact, it's one of the major points, we submit, not only material but one of the major points on that issue.

Mr. Hoegh: Your Honor, this thing of saying there is nothing in the record on that point, I think, goes right in the face of the finding that I just read to the court. The court did consider this very matter of whether or not this particular heater functioned in the way that the patented heater functioned, and it made findings to that effect and made findings that that air affects materially the

(Testimony of Walter M. Berry.)

efficiency and operation of such wall heaters. [869]

Also at page 344 of the record I wasn't referring to Mr. Landsberg's testimony, I was referring to the defendant's testimony, about the efficiency of these heaters with the air space blocked off, and with it open, and all this same sort of thing that is now being proposed. Mr. Kice testified about it, Mr. Petroff testified about it. There are several exhibits in the record which show the basis of these tests, and I think that the matter was thoroughly explored by the trial court, and the trial court despite that voluminous evidence by the defendant decided that that was erroneous.

As Judge Bone pointed out, the matter was the subject of considerable dispute and the trial court did not choose to follow the testimony presented by the defendants.

Special Master: As I understand it, Mr. Stanbury, one of the elements in ascertaining the damages which may be the reasonable royalty, one of the things that has to be considered is the contribution of the infringement to the amount of damages?

Mr. Stanbury: Yes, sir. The extent of use, in other words.

Special Master: Of course, this evidence to which Mr. Hoegh refers was never introduced for that purpose.

Mr. Stanbury: It wasn't even introduced at all. But if it was, that wasn't even material.

(Testimony of Walter M. Berry.)

Special Master: It went to the question of infringement? [870]

Mr. Stanbury: That is correct. Such as there was as to percentages went to the question of infringement and principle of operation. The degree of contribution, the extent of use, has never been material in this case up to the time of now fixing damages.

Special Master: The objection will be overruled. I think it should be in the record, in any event, so let's go ahead and put it in the record, and then you can tie it in in your arguments as to how much weight should be given to that evidence in determining the damages.

Mr. Hoegh: Your Honor, Judge Swain once cautioned me about arguing after he ruled, but I would like your indulgence in just one sentence: "A careful consideration of the entire record"—reading from Judge Bone's opinion—"convinces us that all of the essential parts and elements of appellee's device have been, with immaterial variances, faithfully copied by appellant in constructing its various models here claimed to infringe appellee's patent."

Special Master: I am not questioning that as far as infringement goes. What I am interested in is the defendant's contention that the contribution of the infringement bears on the amount of damages which should be determined.

You may find a case where the infringement is such a small part of the contribution to the damages that a royalty will be very low. You may find a

(Testimony of Walter M. Berry.)

case where the device [871] wouldn't work at all without the infringing portion, so that the damages would necessarily be much larger, particularly if it is based on a reasonable royalty.

Q. (By Mr. Stanbury): On the first test, May 1st, Mr. Berry—"Not Sealed"; that means with the air free to go wherever it will go in the normal operation of the heater, does it not? A. Yes.

Q. And "Sealed" means that the apertures by which the air could get from the wall spaces around the lower box into the economizer have been closed off? A. Yes.

Q. All right. Now, on May 1st what was the efficiency of this heater, not sealed and no chute?

A. 66½ percent.

Q. You didn't take it with the chute?

A. No.

Q. With this air from the back wall spaces sealed off from the economizer, what was the percentage of efficiency? A. 66½ per cent.

Q. You didn't take it there, either, without the chute? A. No.

Q. September 1st and 2nd, or 1st, was it? [872]

A. September 3rd and 4th.

Q. I beg your pardon.

With the heater not sealed and with the chute in place, what was the efficiency?

A. With chute, unsealed, 66 per cent.

Wait a minute now. Did you ask me with chute or without chute?

Q. I said no chute, no seal.

(Testimony of Walter M. Berry.)

A. No chute, no seal, 66 per cent.

Q. That's right.

Sealed and no chute, what was the per cent?

A. 66½ per cent.

Q. Not sealed and with the chute, what was the per cent? A. 66 per cent.

Q. Sealed and with the chute, what was the per cent? A. 66 per cent.

Q. September 15th you took it one day with the chute and another day without the chute, did you not? A. Yes, we did.

Q. How long does it take to run all the tests that you did? About how long? I don't mean to the minute.

A. Well, it took us all day on September 15th, with the time that we got to run the test. Actually the test itself took two hours from the time we lighted the heater until [873] we started our readings. Then we cooled the heater down with a blower for more than a half hour, probably closer to an hour, and started the other test. So there was an interval there. Actual testing time of about six hours.

Q. I was getting at the fact that you have to have it cooled off before you can change the chute situation.

A. Yes. We ran the chute on Monday morning. We ran both of these tests without the chute on Sunday.

Q. September 15th was a Sunday, was it not?

A. Yes.

(Testimony of Walter M. Berry.)

Q. And on that day did you not take it with the chute, but without the chute?

A. Without the chute.

Q. What was the efficiency of the heater without the seal and without the chute on September 15th?

A. $66\frac{1}{2}$ per cent.

Q. And with the seal and without the chute?

A. $66\frac{1}{2}$ per cent.

Special Master: Were all of these tests run on the same heater with putting the chute in and taking the chute off?

The Witness: Yes.

Special Master: You didn't have one heater with the chute and another one without the chute?

The Witness: No. We installed the chute later.

Q. (By Mr. Stanbury): All right. On September 16th you [874] took it with the chute and not without the chute, is that right? A. Yes.

Q. What was the percentage without the seal, with the chute? A. 66.3 per cent.

Q. What was it sealed and with the chute?

A. 66.2 per cent.

Q. Can you determine these percentages with that degree of precision and avoid human error in it, that is, down to one-tenth per cent?

A. No. I don't think that anything closer than a half per cent has any significance for the reason that with an ordinary gas analysis apparatus that we call an Orsat, it is impossible to read closer than one-tenth of 1 per cent, and that represents a half a per cent in efficiency.

(Testimony of Walter M. Berry.)

Q. What was your conclusion after these tests, Mr. Berry, as to whether the efficiency of this heater was affected—withdraw that. I will put it another way. What was your conclusion from these tests as to whether air from the wall spaces around the lower heater getting into the economizer had any effect upon the efficiency of the heater?

A. It made no difference.

Q. Was that true whether you put it in there or kept it out? [875]

A. It made no difference in efficiency.

Q. With or without the chute?

A. The same is true.

Q. How do you account for the fact that this heater performed at an efficiency of 66 or 66 and a fraction per cent, rather than 70 per cent, both with and without the back wall air getting into the economizer?

A. I think this heater represents more nearly a commercial product, which you probably find in actual use. There was no attempt made to get a very fine refinement of adjustments, such as is necessary to pass the efficiency test at the AGA laboratory.

It is like getting a fine tuning on a carburetor to get these fine adjustments, because there are very, very few heaters that more than just barely get by.

Q. You were interested in making a comparative test here, rather than an absolute test, were you not?

A. That is true.

(Testimony of Walter M. Berry.)

Q. Did you consider that the tests which you made were good reliable comparative tests of the efficiency of this heater with and without the air from around, side and back of the lower box and the wall spaces getting into the economizer?

A. I feel very confident that this represents a very [876] accurate determination of the relative performance under the different conditions.

Q. On these occasions did you take wall temperatures of this heater? A. Yes, we did.

Q. You did that by means of thermocouples?

A. We determined the temperatures with an indicating potentiometer.

Q. Where did you have your thermocouples placed?

A. They were placed in exactly the same locations prescribed by the laboratory, and all the way—spaced four inches apart up and down from the floor up to the header plate, and in front from the header plate up to the top of the economizer.

Q. You mean one in every four-inch square?

A. Yes.

Q. And that would be on the back wall and also the side wall and around the heater box?

A. Also two thermocouples on each stud, on each side.

Q. When you take those readings, do you take the room temperature with each reading?

A. No. We observe the room temperatures at the start and at the end of our set of readings.

(Testimony of Walter M. Berry.)

Q. Then you record the temperature at the thermocouple? [877] A. Yes.

Q. Before taking those temperatures, how long had the heater been operating?

A. Two hours.

Q. Did you take these temperatures according to the AGA standards, or some other standard?

A. According to the AGA standards.

Q. That is, you gave it the same test that it would be given in an AGA laboratory?

A. Yes, sir, I would say that they represent the AGA tests.

Q. Did you record the temperatures?

A. We did.

Q. Do you have your data here? A. I do.

Q. For all the days you did it? A. Yes.

Mr. Hale: We would like to have copies of these, Mr. Stanbury, ahead of time, like we did with our exhibits.

Mr. Stanbury: I know. I have done it every time up to this one, and we will have to have copies made for you.

Special Master: Were copies of those other exhibits made over the week-end?

Mr. Hale: Yes, sir, your Honor. Let me get them out while I am thinking of it. [878]

Special Master: Could you go ahead with some other part of the testimony?

Mr. Stanbury: I am almost through with this witness.

(Testimony of Walter M. Berry.)

Special Master: Would you like to take our recess now and you can go over it?

Mr. Hale: Perhaps he can finish with the witness and then we can look at it over the recess.

Q. (By Mr. Stanbury): There are rectangles here that show left, rear, and right. Those are back walls and side walls, are they?

A. Yes, they are.

Q. And the front, that is the front wall, in front of the economizer? A. Yes.

Q. And the figures you have written down, are those actual temperature readings at the points indicated? A. They are.

Q. And the points indicated are four-inch squares over the area shown?

A. Except for the side, on the studs.

Q. On the stud spaces—what is the difference on the stud spaces?

A. I think they are about two inches apart.

Q. Does that data correctly show the temperature reading at the points indicated on the days indicated, and with the [879] condition as to whether sealed or unsealed, chute or no chute, as indicated? A. They do.

Q. And the temperature of the room on each sheet, does that accurately record the temperature of the room? A. It does.

Q. Were the test conditions better on any one day than any other day?

A. The tests on the Sunday and Monday morning on the 15th and 16th were probably run under

(Testimony of Walter M. Berry.)

better conditions in that the heater was not subjected to outside influences such as drafts and movement of air. [880]

Q. Well, take the May tests. Under what conditions were the May tests taken?

A. That test was not conducted under most favorable conditions, in that due to the height of the heater and the stack on it the heater was actually part of the way out of the building; within an inclosure formed by the partly opened door, and we didn't consider that that condition was entirely favorable.

Q. And on September 3rd and 4th what were the conditions?

A. Those were conducted under somewhat better conditions; however, there was considerable traffic in the neighborhood of the heater. The outside doors of the factory building, the warehouse building, were open most of the time, and there was considerable draft movement of air in the vicinity here.

Q. What kind of doors are you talking about?

A. Big factory doors used for loading and unloading.

Q. Doors over a loading platform, huge doors you are talking about, are you not? A. Yes.

Q. And was the factory activity going on at that time? A. It was, yes.

Q. What about September 15th? What day of the week was that? [881]

A. That was on a Sunday, and we could keep the

(Testimony of Walter M. Berry.)

doors closed, and conditions were generally more favorable to a good comparative test.

Q. What about September 16th, Monday? How were the conditions?

A. The doors were open again, but there it was actually a dull day and the temperature didn't vary too much; and we considered the comparative tests, since they were run fairly close together, were reasonably accurate and satisfactory.

Q. What effect, if any, does the temperature change in the day or the presence of a draft have on taking temperatures, if any?

A. Any change in temperature of the room will cause a slower change in the heater itself, due to the heat capacity of the walls and heating element. So that if you have a sudden drop in the room temperature your heater can't catch up with the change.

Q. You are talking about a time lag between temperature changes of the room and temperature changes of the heater? A. Yes.

Q. And what was the actual input on the September 3rd and 4th test, Mr. Berry? [882]

A. 35,500 BTU.

Q. What was it on September 15th and 16th?

A. 34,900.

Q. What was it on September 15th and 16th?

A. Oh, I made a mistake. Did you ask for September 15th?

Q. Start over again. I don't know whether you were giving me the right answer or not, except on the first question I asked you. So I couldn't cut

(Testimony of Walter M. Berry.)

you if you did make a mistake. You were right on September 3rd and 4th, 35,500. Is that right?

A. Yes.

September 15th——

Q. Well, let's go back a minute. September 3rd and 4th was 35,500 BTU, as you said, wasn't it?

A. Yes.

Q. What was it on May 1st? A. 35,200.

Q. And what was it on September 15th and 16th?

A. On September 15th, 34,800; and on September 16th, 34,900.

Mr. Stanbury: I will offer this data in evidence as Defendant's next in order, and ask leave to take them at the noon recess and have copies made for Mr. Hoegh and Mr. Hale.

What are you doing there? What did you do there? [883]

The Witness: I changed—this was done on May 1st. This BTU was actually made on May 1st, this determination.

Mr. Stanbury: What did you do? Just change 2 to 1 or what?

The Witness: Yes.

Mr. Stanbury: What was on May 2nd? What did you have May 2nd down there for?

The Witness: May 2nd?

Mr. Stanbury: Did you just change May 2nd to May 1st? I didn't see what you did with your pencil. That is all I am asking you, Mr. Berry.

(Testimony of Walter M. Berry.)

The Witness: Let me go back here. This test of test No. 1-A and 2-A, was made on May 1st.

Mr. Stanbury: All right.

The Witness: And these BTU's were made on May 1st.

Mr. Stanbury: What did you have, May 2nd?

The Witness: Yes.

Mr. Stanbury: Was it an error, or what?

The Witness: An error.

Mr. Stanbury: All right.

Mr. Hoegh: Your Honor, could we defer consideration of this until after——

Special Maaster: Would you like to check them over before I rule on the admission of them?

Mr. Hoegh: Yes, please. [884]

Special Master: Let's take our morning recess, and you may look them over, and we will take care of it after the recess.

(Short recess.) [885]

Q. (By Mr. Stanbury): One thing I forgot to ask you, Mr. Berry. On the May 1st, and September 3rd and 4th tests, do the bottom lines of temperature give wall temperatures?

A. No. I think those temperatures are influenced by direct radiation. They are down with the level of the burner and combustion chamber.

Q. Were the thermocouples from which you got the readings on the bottom line in the May 1st, September 3rd and 4th tests, were they in the wall space between the heater and the wall?

(Testimony of Walter M. Berry.)

A. No. They were down below the level of the heater.

Q. Down below where the space between the heater and the wall starts? A. Yes.

Mr. Stanbury: That is all.

Special Master: What is the maximum temperature for those walls by the AGA regulations?

The Witness: 90 degrees above room.

Special Master: If the room was kept at 72, for instance, then the maximum would be 162?

The Witness: That's right.

Special Master: What would be the dangerous stage of a hot spot in a wall? How much leeway is there between the 90 above room temperature and the combustion stage?

The Witness: That is a debatable point. [886]

Special Master: It has never been determined?

The Witness: There has been a tremendous lot of work done on it, and it depends on the time of exposure to a hot zone, on the composition of the material; different kinds of wood char or flame. There has been a tremendous lot of work done on it, but nothing specific can be stated on that point.

Special Master: Have they found any temperature at which, say, the most combustible would ignite?

The Witness: Well, it can be comparatively low. In some cases three or four hundred degrees might cause charring and there may be eventual combustion.

Special Master: At least there is quite a gap

(Testimony of Walter M. Berry.)

between the 90 above room temperature and any possible combustion stage?

The Witness: There is. 90 degrees above room is assumed to be safe under all conditions.

Special Master: Under all conditions?

The Witness: All conditions, yes.

Special Master: Pardon me for the interruption, Mr. Hoegh.

Now, shall we rule on the admission of these? Do you have an objection, or would you like to do your examining first?

Mr. Hoegh: I would like to. Unfortunately, I think we may have gotten them out of order, Mr. Berry. [887]

The Witness: It doesn't make any difference about that.

Mr. Hoegh: Do you suppose we should label them with some exhibit number for each, Mr. Stanbury?

Mr. Stanbury: Anything the court thinks.

Special Master: Well, let's get them back in order, then, and we will mark them for identification so they can be referred to by exhibit number.

Do you have those back together now?

The Witness: Yes.

Special Master: Let me have them so I can mark them.

Mr. Hoegh: Perhaps it would be best to mark each sheet in the event I have comments to make about them.

(Testimony of Walter M. Berry.)

Special Master: The one group is marked Test No. 1. Is that sufficient identification?

Mr. Stanbury: It is for me, your Honor.

Mr. Hoegh: I believe that other sheets have other test numbers.

Special Master: And then the other one has Test No. 1-A up in the upper right-hand corner.

Mr. Stanbury: I am willing to mark them in red, I have a red pen here, on the date, and that will simplify it. For easy reference that will be very good.

Special Master: The one that is marked Test No. 1 will be Defendant's Exhibit V for identification, and the one that is marked Test No. 1-A will be Defendant's Exhibit W for identification. [888]

If you have a red pencil, how about marking each sheet with a red number, and then we can refer to them by exhibit number and sheet number.

Is this another group you have marked?

The Witness: That is a third series.

Special Master: Did you offer this one, also?

Mr. Stanbury: Yes.

Special Master: It shows Test of Model 67 Coleman Wall Heater.

Mr. Stanbury: I offered them all.

Special Master: That will be Defendant's Exhibit X.

(The exhibits referred to were marked as Defendant's Exhibits V, W, and X for identification.)

(Testimony of Walter M. Berry.)

Mr. Stanbury: Shall I mark them on the date for easy reference?

Mr. Hoegh: If there was one for a date, that would be fine, certainly.

Mr. Stanbury: The Court said to mark them with the number in red——

Mr. Hoegh: He was referring to the page references. If you just put a page number on each sheet so that he can refer to it as Exhibit V-1 and V-2.

Mr. Stanbury: Very well.

Special Master: Here is the other one, Mr. Hoegh.

Mr. Stanbury: I will put numbers with circles around them in red, just numbers, and I will start with May 1st.

Special Master: That will be fine.

Mr. Stanbury: 15 pages in all.

Cross Examination

Q. (By Mr. Hoegh): Defendant's Exhibit W begins with page 1 and goes through page 5; Defendant's Exhibit V begins with page 6 through page 11; and Exhibit X, pages 12 through 15.

Mr. Berry, when you ran any of these tests that you have testified to, who was present besides yourself?

A. During all the tests, Mr. Grubb, chief of the laboratories of Coleman, assisted me, in making the set-up, installing the heater, and connecting my potentiometer wires to the various points, various 'couples in the wall. I made all the readings and entered the results.

(Testimony of Walter M. Berry.)

Q. Where were the tests run?

A. The first series was run at a private laboratory at 3234, I think the address is, Olympic Boulevard.

Q. Whose laboratory is that?

A. That is owned by Charles Cook.

Q. And after that where was the place?

A. The next two series were run at the Coleman plant in the industrial district in East Los Angeles.

Q. Was anybody besides Mr. Grubb there at any of these tests? [890]

A. There were various workmen constantly around, except on Sunday morning when we were there alone. Mr. Newton was there at various times. He had no part in the actual running of the tests.

Q. Were any people from Holly or Siegler there? A. No, they were not.

Q. Do you know whether or not they were asked to be there? A. I do not know.

Q. I could tell you that I wasn't there, and you would agree with that statement, would you not, Mr. Berry? A. Yes, I would.

Q. What wall heater model number did you test? A. 67.

Q. What equipment or what components did it have as you tested it? Did it have an economizer?

A. It had an economizer, yes.

Q. Are you familiar generally with the kinds of wall heaters manufactured by Coleman?

A. I think I have only seen this one particular model. I have seen a later model, a more recent

(Testimony of Walter M. Berry.)

model submitted to the laboratory, a very much taller heater. But in this particular series, it is the only heater I have seen. [891]

Q. This one that you referred to as being very much taller, it doesn't have an economizer, is that right? A. That's right.

Q. Does it stick out into the room quite a bit further, too?

A. I would get that impression by looking at the casing, that it does.

Q. What else did this heater have besides an economizer?

A. Well, it is a complete heater ready to set into a wall, and it had a header plate and flue connection, and then the economizer on top of it.

I don't think that there is anything very distinctive about it from other heaters in other respects, except for the economizer.

Q. Did you have a flue on it?

A. We tested it with and without a flue. We tested it with a flue for heat loss, an insulated flue, tested in a similar manner as tested by the laboratory. A four-inch stack with thermocouples six inches below the top. And the temperature measurements on the casing were made without any flue.

Q. Temperature measurements in the wall, is that what you mean? A. That's right.

Q. Do you know whether it was a three-foot economizer [892] or a four-foot economizer?

A. Frankly, I didn't measure it. I couldn't say.

(Testimony of Walter M. Berry.)

That information would have to be supplied by Mr. Newton.

Q. Is it just one that you tested, just the one economizer?

A. Just the one economizer, yes.

Q. Do you know anything about Coleman's own testing laboratory, Mr. Berry?

A. I do not. Only from hearsay.

Q. Mr. Grubb is in charge of it, as far as you know, though, is that correct?

A. So I understand.

Q. Do you know how large a staff he has?

A. Only by hearsay.

Q. Generally in your experience, Mr. Berry, what is the function of a laboratory maintained by a manufacturer?

A. Development and testing of all their products.

Q. When you do work with the AGA laboratory here in town, prior to that time do your clients tell you whether or not they have tested these wall heaters?

A. Most of the larger manufacturers do have certain testing facilities. The smaller ones don't and rely upon somebody like myself, or one of the other consultants, to give their appliances a preliminary check, and if it doesn't seem to meet the laboratory requirements, they have to make a [893] modification.

Q. When you take an appliance to a laboratory, you are fairly sure it is going to pass, aren't you?

(Testimony of Walter M. Berry.)

A. When I turn it over to the AGA, yes, I feel fairly confident that it will meet the requirements.

Q. How many appliances are submitted to the AGA in Los Angeles, or in Cleveland, in a year; do you know, Mr. Berry? A. I don't know.

Q. 5,000, 6,000?

A. I think that figure would be high.

Q. How many of them pass without modification, do you have any idea of that?

A. Comparatively few.

Q. Five or six?

A. I wouldn't make a guess on that, but I know from my experience over a period of years at the laboratory that there are comparatively few that don't require some little modification or adjustment.

Q. How many have you taken into the laboratory that have gone through without modification?

A. Do you mean by that, actually submitted for official tests?

Q. Yes.

A. I would say in the past year probably half a dozen.

Q. How about in prior years—about the same number? [894]

A. About the same number. The requirements are gradually stiffening, and it was a little easier to get by in previous years than it is now.

Q. You do take the precaution of submitting them to the laboratory, don't you, despite your own findings on whether they will pass?

A. Only if I feel that it is a marginal case. For

(Testimony of Walter M. Berry.)

instance, with the equipment that I have available for determining combustion, for example, it is not nearly as accurate as the laboratory equipment, and if I feel that it is a marginal case I very often take a chance on having it pass the laboratory for the reason that if I think it won't pass it would require major changes or modification, which are very often expensive and difficult to do.

Q. Most times don't you find that appliances have to be modified in some manner after they get in the laboratory? The AGA laboratory I am talking about.

A. It depends a good deal on your definition of "modification." There are nearly always some adjustments to be made. It depends upon your definition of "modification." Maybe a very minor change in the baffling of your down draft diverter, or some other small matter. And, of course, there is a constant set of changes when you submit different blowers. Say on a forced air furnace, you submit different blowers, different controls, different pilots. [895] There is constant change of equipment and adjustments necessary.

Q. Would this be a fair statement of what happens when a company submits an appliance to the American Gas Association laboratory: The company presumably gets the appliance fixed up in the best possible manner, doesn't it, that is the first thing that would happen?

A. At least they think they do, yes.

Q. And they have designed it with the American

(Testimony of Walter M. Berry.)

Gas Association requirements in mind, haven't they? A. Yes.

Q. Incidentally, it is fairly expensive to put an appliance into the laboratory, isn't it?

A. It is.

Q. After that they put an appliance into the laboratory and they know the chances are it might go through, but they know probably the better chance will be that they are going to have to change it some after they get it in the laboratory, isn't that true?

A. I think the manufacturer is always optimistic that he has the appliance in good condition or else he wouldn't incur the delay and the cost of repeating a great number of tests. The difficulties and the reason I and several other men are in this consulting work, we do make preliminary tests and try to get the appliance in as good a shape as possible, with the expectation that it will go [896] through without any major re-test.

You might have the appliance through the laboratory, say, 95 per cent, and fail in one little thing that might upset the whole appplecart and require you to repeat practically all the preceding tests, and that is very expensive. That is the only reason that several of us are in the picture at all as consultants, that we are able to render that service and save the manufacturer the extra cost of laboratory fees.

Q. Prior to the time you had been called into

(Testimony of Walter M. Berry.)

this test you had never done consulting work for Coleman, I believe you stated?

A. I never had, no.

Q. So presumably they would have their own testing laboratory and do work similar to that which you do with their own employees; would that be correct?

A. I would think so.

Q. Did you handle any wall heaters to take them through the American Gas Association requirements at all at any time, Mr. Berry?

A. Yes, I have had several clients who have submitted appliances.

Q. Any for the 1956 requirements?

A. Yes.

Q. How about earlier requirements?

A. Yes. [897]

Q. Did any of those go through the laboratory without the necessity of any modifications whatsoever?

A. Frankly, I don't know whether any of them required any modification or major change. I know they eventually got through.

Q. What kind of a seal did you use when you stated you sealed off the passageways from around the lower box into the economizer, Mr. Berry?

A. We had some heavy aluminum foil about two and a half or three inches wide that we pasted along the sides all the way from the bottom up to the header plate. And this illustration here shows some metal tabs that were inserted in the header, underneath the header plate, and they sealed off

(Testimony of Walter M. Berry.)

most of the crack. And then using this metal, aluminum metal tape, which had a stickum on the back of it, why, we sealed off all the cracks and made what I think was an absolutely air-tight joint there.

Q. Let me see if I understand it. You went around the economizer header plate with tape, is that it?

A. No, no. We sealed off the—we sealed off along the side with this heavy aluminum tape——

Q. Along the side of what?

A. The side of the heater and the wall.

Q. The lower box.

A. And the wall, yes. And sealed off all the air [898] in this area here, so that no air coming up the back could get into the front.

Mr. Stanbury: There is in court, Mr. Hoegh, a three-dimensional colored picture with a viewer of the sealing, if it would facilitate your understanding of what he is telling you. There is a viewer here. It has to be plugged in.

It's too bad we don't have one without the sealing. While we will understand, the Court hasn't seen it without the sealing. They ran out of film.

(Whereupon the viewer was given to counsel and the Special Master.)

Q. (By Mr. Hoegh): Did you put a sealing along the bottom?

A. Only down to the bottom of the combustion space to——

Q. On the sides down to the bottom?

(Testimony of Walter M. Berry.)

A. Down to the bottom of the casing, yes. All the way down to the bottom casing.

Q. Anything along the bottom of the rear baffle of the heater to seal that off? Do you understand what I mean, Mr. Berry?

Here at the bottom of the heater is a, what you might think of as a "U"-shaped member, with the flat back portion of the "U" along the wall. Is that correct? A. Yes. [899]

Q. Did you seal that area there?

A. No, we did not.

Q. So that air could come up from around the lower box and come behind the lower box and the wall? And you didn't block off that?

A. It couldn't get in front, no. But——

Q. Well, that area was open, though, wasn't it?

A. Yes, yes, that area was open.

Q. Now, how did you seal off the air that would come up there and get in the economizer?

A. I think that photograph was rather descriptive there. I don't know that I can explain it any better except to say that the whole area along the side of the inner casing was sealed all the way down to the bottom; and this area here was sealed completely.

Q. Which area is that?

A. This area in here.

Q. Would you describe it? The reporter would like to get it down in the record, and so would I, Mr. Berry.

A. The area below the header plate.

(Testimony of Walter M. Berry.)

Q. Was sealed from what?

A. From the circulating air coming up the sides and back.

Q. By a seal that ran across the length of the header, across the heater? [900]

A. It ran all the way—as you saw in the illustration, it ran all the way across the front and down the sides—completely sealed.

Mr. Hoegh: I wasn't looking at that illustration, apparently.

Mr. Stanbury: We will get it out again.

(Whereupon the viewer was again handed to counsel.)

Special Master: That is aluminum foil? Or what was that?

The Witness: Aluminum foil, yes.

Q. (By Mr. Hoegh): Are you familiar with the construction of the header plates on these heaters, Mr. Berry? A. Yes, I am.

Q. Does this particular one have a notch in it to bleed air into the space between the wall and the economizer box?

A. I believe there is a small notch.

Q. Where is it?

A. About the center; in the back just about the center of the header plate.

Q. If you seal off air going into the space which would normally, in the normal function of the heater would lead to the economizer from around the back, would you get more air going through that notch?

(Testimony of Walter M. Berry.)

A. I doubt whether it would make any difference. [901]

Q. How big a notch is it?

A. I think it is only about a quarter of an inch wide by two inches.

Q. Two inches wide by a quarter of an inch deep?

A. Yes.

Q. How much air will a notch like that hold? Or, how much air can you put through a notch like that?

A. It all depends upon the draft that you might have available, the pressure below and above the notch.

Q. You are going to get more flow through that notch if you don't have another available outlet for the air that comes up the back, aren't you? It's just a question of pressures and volumes and velocities we are dealing with, isn't it, Mr. Berry?

A. That's right.

Q. That notch is certainly not a critical flow orifice at any time in this heater, is it?

A. No, it is not.

Q. So the more pressure you get behind it the more flow will go through, is that right?

A. That is true.

Q. Have you ever seen a Coleman wall heater fixed up like this installed in a house?

A. I have not.

Q. Where does the air that normally comes up around [902] the—between the panel and the wall go in the way you fixed up this heater, Mr. Berry?

(Testimony of Walter M. Berry.)

A. Do you mean after we have put in the metal tabs?

Q. Yes.

A. The air would escape out of the front grille.

Q. Do you know that to be true?

A. Where else could it go?

Q. I am asking you, Mr. Berry.

A. Naturally, it would if it were all sealed off and no air went into the register above or just below the economizer there.

Q. Do you know the area I am talking about?

A. The air you are talking about?

Q. The area.

A. Would you say that again? I don't know if——

Q. Yes, I shall try. I am talking about the area between the panels and the wall. Do you know the front panel on the heater as shown here in the front?

A. Yes.

Q. At the sides of that panel there are channels that carry air, aren't there?

A. Yes.

Q. Normally those are interconnected with the areas around the back of the heater, aren't they?

A. Yes. [903]

Q. Now, where does that air go the way you have sealed this thing up, the air carried by those channels?

A. Well, there is very little movement of air in that area all sealed up.

Q. Have you ever checked it?

A. No, no, I have not.

(Testimony of Walter M. Berry.)

Q. When you say it's all sealed up, do you know whether that area is even sealed off from any other area in this heater?

A. It would be sealed off with the method we used there in sealing it.

Q. What seals it off at the top?

A. We used metal aluminum foil there to seal it all off.

Q. These channels would be outside the confines of the lower box, you understand that, don't you, Mr. Berry?

A. Outside the confines of the heater proper?

Q. Yes, that's right.

A. Well, all the air that goes up around on each side, between the element itself, or you might say the heater proper, and the casing, naturally comes out through the register.

Q. Do you know that?

A. Why, certainly.

Mr. Hoegh: Your Honor, I have a few more questions of this witness. [904]

Special Master: Will it take more than five or ten minutes?

Mr. Hoegh: I see from Mr. Hale's notes that it would take longer, your Honor.

Special Master: Very well. We will recess now until 2:00 o'clock.

(Whereupon a recess was taken until 2:00 o'clock p.m. of the same day.) [905]

(Testimony of Walter M. Berry.)

change; probably not so much change in your volume of products going through the heater, however, or the flue temperatures or CO_2 in the flue, as well, as is well borne out by the consistency of these results under considerable varied conditions.

Q. Would you get cooler air going in at the point called the economizer air intake grille as a result of this draft in the room?

A. It is conceivable there might be just a slight change there, yes. But the change would be so insignificant as not to be noticed.

I think that it would be well to point out the fact that the volume of products going through the combustion chamber and up through the stack is so large in relation to the volume going up through the economizer that any effect in variation of temperature of air going into the economizer would be almost insignificant, and for this reason: That in burning a cubic foot of gas you are drawing in 10 cubic feet of air, consequently your products to combustion amount to amount 10 cubic feet for every cubic foot of gas burned. So you have actually, theoretically, 350 cubic feet or more of products going up into your stack, out of your heating element; however, due to the extremely high temperatures at which you discharge [908] those flue products out of the heater, it is necessary to inject a large volume of air to cool the gas down to a point where you pass the AGA laboratory, or meet safe conditions. So, as shown by these tests, your CO_2 is down to about four per cent,

(Testimony of Walter M. Berry.)

which indicates that you are actually drawing in twice the volume of air as to the total volume of products. So you have a volume of over a thousand cubic feet of hot products going up through your stack at a temperature of over 500 degrees.

Q. In how long a period?

A. In one hour over a thousand cubic feet per hour, so consequently any variation in grille temperature or amount of air going into the grille would be so insignificant compared with the total amount of heat going up the flue that you wouldn't expect to find any difference in efficiency. [909]

Q. Mr. Berry, your findings here show, roughly, that these particular heaters you checked had an efficiency of around 66 per cent, is that correct?

A. That's right.

Q. That wouldn't pass AGA, would it?

A. No, it wouldn't.

Q. How do you account for such a low percentage figure for efficiency on these heaters?

Mr. Stanbury: This heater. Excuse me.

Mr. Hoegh: This heater. I'm sorry, Mr. Stanbury.

The Witness: I mentioned this morning that in order to get by the laboratory, and most of them just barely squeeze through at this 70 per cent, that it is necessary to make every possible refinement in adjustment and conditions in order to get the heaters to pass this test.

There was no attempt in this case to make any special adjustment of burner, air shutter, or any-

(Testimony of Walter M. Berry.)

thing. We took the heater just as it was, and since the object seemed to be to make comparative tests, we weren't concerned about the actual efficiency at all.

Q. (By Mr. Hoegh): Well, the actual efficiency for a fact wouldn't be sufficient to pass AGA, would it?

A. This heater tuned up properly presumably would pass, because it has passed. I think a similar model has passed.

Q. What happens? Isn't it that through production [910] tolerances you get a little change in the heater and, therefore, that production model won't pass where a test model would?

A. Very often that is the case.

Q. So to get this heater up, you would have to redesign parts of it, wouldn't you?

A. No, I wouldn't say that.

Q. You would have to change the draft hood, probably?

A. No. I think the draft hood is so definitely described that I don't think any such change would be possible or allowed by the laboratory.

Q. How would you get efficiency up? You would increase stack temperature, wouldn't you?

A. No. You would actually try to reduce stack temperature. You would try to bring up your CO₂, and that would automatically bring your stock temperature down.

Q. Bring up your CO₂ brings your stack temperature down?

A. Always, yes.

(Testimony of Walter M. Berry.)

Q. Supposing you changed the draft hood, you would certainly—changed the draft hood to take more room air through the draft hood, your CO₂ would go down, wouldn't it?

A. It would go down, yes.

Q. And your stack temperature would go down?

A. It would go down. [911]

Q. If you took more room air in, your stack temperature would go up?

A. If you draw more air—do you mean through the diverter into the stack?

Q. That is what I mean.

A. If you draw more air in, actually that is the only way you could get that temperature down, yes.

Q. So to get that temperature up, you would use less room air in going up the flue?

A. That's right.

Q. So your CO₂ would go down and not up?

A. I was thinking about the CO₂ in your—directly out of your heater, the way we would bring our stack temperatures down would be to bring our CO₂ up as high as possible, but that is not true up in the stack there, where you have to have dilution in order to bring that stack temperature down. Consequently, your CO₂ goes down.

Q. How would you get the stack temperature up so that you would increase efficiency in this heater?

A. It really isn't necessary to do very much. There is a balance there. If you take the heat loss,

(Testimony of Walter M. Berry.)

with a low CO_2 , you bring your stack temperatures down, too. You can get the same result by having a higher CO_2 and a higher stack temperature, so that theoretically it shouldn't make any difference what CO_2 you have going up in there. [912]

Q. You would get a higher stack temperature to do it wouldn't you, to bring up your efficiency up?

A. Let me think about this thing here.

Your question is what to do with this heater to get the efficiency up primarily?

Q. Right, yes.

A. I think probably the most effective way would be to get the very best possible condition in your burner, get the best possible flame adjustment. There isn't, really—

Q. You have calculated what the BTU input on this heater was, haven't you, Mr. Berry?

A. Yes, I have.

Q. So that you are burning gas at the rate of 55,000 BTUs per hour, 35,000 BTUs per hour?

A. Yes.

Q. You start with that, and then there are some losses up the stack? A. Yes.

Q. To get that overall efficiency in the heater up you have to raise the stack temperature, don't you? A. No, not necessarily.

Q. What do you do?

A. As I say, probably the most effective thing you might start out with is to make the best possible burner adjustment. That doesn't mean that you are changing your BTU [913] in put; you are

(Testimony of Walter M. Berry.)

just getting the very best possible flame on your burner.

Q. Well, assuming that you have done all that, did you make such an adjustment in this case?

A. No, made no attempt to make any adjustment on it.

Q. Assuming you have done all that, how do you get your efficiency?

A. The logical thing to do would be to increase your stack temperatures just so that it would get by the laboratory, and then take whatever CO₂ you get out of it. Your determining factor there in dilution is your flue temperatures.

Q. And the higher the flue temperature the higher efficiency, isn't that right?

A. Well, up to a certain point, yes.

Q. And if you adjust the flame to get a maximum optimum condition in the actual burning of this gas, that increases flue temperature, doesn't it?

A. No. It might decrease it for the reason that the more heat you absorb down the lower part of your heating element, the more efficient that heating element would be. You have so very little heating surface in these heaters, that that adjustment of your primary air and your burner adjustment is very, very important.

Q. Are you saying that we have got to change the primary heating element? [914]

A. No. I say universally all these wall heaters have so very little heating surface, that that is the reason your flue temperatures are up to 650 and

(Testimony of Walter M. Berry.)

700 degrees, escaping out of your combustion chamber. That is why you have to have dilution to get by the AGA requirements on flue temperature.

Q. If you increase the stack temperature by any means at all, you would get higher efficiency, wouldn't you?

A. Up to a certain point.

Q. And if you increase the stack temperature you would get hotter walls around the flue, wouldn't you? A. Yes, that follows.

Q. So to upgrade this particular wall heater, if you did it by raising stack temperatures, you would raise wall temperatures, wouldn't you?

A. I think that would be true of all heaters.

Q. It would be true of the one you modified by putting this tape on it, too, wouldn't it?

A. It would be true of all heaters.

Q. Now, is foil of this gauge that you used approved for use in these heaters, Mr. Berry?

A. No, I don't think it has ever been used before for this purpose, but it is a very good foil for making an experiment of this kind. This is, I believe, technically called pressure sensitive tape made by the Minnesota Mining Company. It is very heavy. It is as thick as this here (indicating), [915] and it has very good sticking qualities, so it does maintain its contact very, very well.

In fact, we had to pull it off and we had difficulty not tearing it when we pulled it off.

Q. If you supplied a reel of tape with any of your appliances that are approved for use in the

(Testimony of Walter M. Berry.)

field, the AGA wouldn't accept that, would they?

A. Certainly not.

Q. There are certain minimum gauge requirements for any metals used in these heaters, aren't there? A. There are.

Q. And if you had any of those metals in use as you have used these foils, heat would be conducted to the surfaces they touched, wouldn't it?

A. Yes. But I think this has pretty good conductivity itself. Aluminum has good conductivity.

Q. Did you check the temperatures under this aluminum? A. No, I did not.

Q. Would the use of this aluminum the way you have made it in these heaters in the tests you have made avoided the AGA approval on these heaters?

A. Certainly. It was only intended for an experiment, as I understand it.

Q. Why is it that that approval would have been avoided?

A. For the reason that that construction of course [916] would not be acceptable.

Q. To the American Gas Association?

A. Certainly not.

Q. Did you take this wall heater with the foil attached between the box and the wall down to the AGA manufacturers' room?

A. No, I did not.

Q. You didn't test it down there?

A. No.

Q. You tested it, as you testified, in Mr. Cook's place and over at Coleman's?

(Testimony of Walter M. Berry.)

A. That's right.

Q. Normally when you want to get approval of a line of appliances for a client of yours, do you check them first at your home or place of business?

A. No, I do not. I never do any testing on an appliance until it is officially submitted to the AGA laboratory, and then the laboratory has provided facilities for carrying on these preliminary tests.

Q. That is in the manufacturers' room?

A. In the manufacturers' room. They give three days free service and use of facilities, and after that the manufacturer is charged \$10 a day for the use.

Q. You take them into the manufacturers' room and you test them yourself, is that correct? [917]

A. I do.

Q. And then after that you take them into the laboratory and the laboratory checks them?

A. That's right.

Q. The fact that you, yourself, have passed these things before you take them into the AGA doesn't satisfy the City of Los Angeles, does it?

A. Only in very special cases.

Q. Generally it doesn't satisfy any of these codes, does it?

A. No. The City has accepted my tests out in the field on a number of industrial appliances.

Q. Where does the AGA take temperatures on these appliances?

A. The same locations where we made these tests.

(Testimony of Walter M. Berry.)

Q. What other locations?

A. They do run some temperatures on the back wall above the header.

Q. Right above the notch where the air would be coming up the back of the box?

A. That's right.

Q. But you didn't take those temperatures?

A. No, we didn't.

Q. Where else would they take temperatures that you didn't? [918]

A. I don't know. I can't recall any other place.

Q. You are familiar with the requirements, are you not?

A. I am, but I don't think there are any other places.

Q. How about above the economizer outlet grille?

A. They go all the way up the eight-foot height, wall, yes.

Q. Do you know the height of that outlet grille?

A. No, I don't. I think it is three feet above the heater. What that total height is there, I don't recall.

Q. What is the height of a normal ceiling?

A. 8 foot 6.

Q. Do you know how far down from the ceiling that grille is, outlet grille?

A. I do not. We didn't have it in a room so I don't know exactly.

Q. Didn't you even have it in a standard test panel, Mr. Berry?

(Testimony of Walter M. Berry.)

A. We did, yes. [919]

Q. Do you know whether temperatures in that area above the economizer outlet grille are normally very high?

A. That is very difficult to determine that. We tried it in some preliminary tests, but we threw them out for the reason that it is almost impossible to determine the true temperature of that outlet grille because you are getting the effects of radiation in your inside flue.

Q. Would you say temperatures up there would be as high as 300 degrees above room temperature?

A. No.

Q. How high?

A. Frankly, I don't know in this particular case.

Q. Would it have been 200 degrees above room?

A. Yes, I think I would say that it was probably that high. But, as I say, it is almost impossible to determine that.

Q. You didn't measure it for these tests, did you?

A. We attempted in some very preliminary tests to determine that. In fact, we had a grille across there with some thermocouples, and we threw all those tests out because we found out it didn't mean anything.

Q. Too high, is that it?

A. The temperatures were too high because they were getting direct radiation from the surface of the flue.

(Testimony of Walter M. Berry.)

Mr. Stanbury: I wonder if I might ask, is counsel talking about wall temperature or air temperature? [920]

Mr. Heogh: Wall temperature.

Mr. Stanbury: The witness——

Special Master: I think he is talking about the flue.

Mr. Stanbury: He is talking about something else.

The Witness: Outlet grille temperature.

Q. (By Mr. Hoegh): No. Wall temperature above the outlet grille.

A. Wall temperatures above the outlet grille. Above the economizer grille.

Q. Yes.

A. We took them all the way up to the top there.

Q. It doesn't show on your tests, Mr. Berry. I am just wondering why. What did they show?

A. The thermocouples are put up as high as the AGA laboratory would have those thermocouples.

Special Master: What is that box there that has those initials N.M.L. on it, above it?

The Witness: May I ask Mr. Newton a question?

Special Master: We will probably get to him next.

The Witness: I believe that I would like to leave that up to Mr. Newton to explain, that part of the construction. I took the heater and the wall——

(Testimony of Walter M. Berry.)

Q. (By Mr. Hoegh): You followed his instruction on it, is that correct?

A. I took the wall just as it was and set it up [921] according to the instructions of the Coleman Company—Mr. Grubb.

Q. I thought you testified that you set it up in accordance with AGA requirements and tested it according to AGA requirements, both as to temperatures and efficiency.

A. This board, I think, comes very close, if not exactly, according to AGA construction, and I don't—

Q. Well, AGA tests from floor to ceiling, does it not? A. Yes, they do.

Q. And you didn't?

A. I would have to refresh my mind and look at some photographs.

The Witness: Have we some photographs there to show exactly how high those were?

Mr. Stanbury: Yes, we have.

The Witness: To show how high the top thermocouples were?

(Whereupon the viewer was handed to counsel and then to Special Master and then to the witness.)

The Witness: There are no thermocouples above the top register of the economizer.

Q. (By Mr. Hoegh): Well, my question is that AGA would have tested temperatures up there, would it not, Mr. Berry?

(Testimony of Walter M. Berry.)

A. I assume that they originally did when this was approved. [922]

Q. Do you know the purpose of the top half of the economizer outlet grille on the Coleman heater, Mr. Berry, the way that is formed there?

A. Yes. It separates the discharge of the economizer from the upper section of the area in there.

Q. What is the purpose of the upper section?

A. The upper section lets a certain amount of circulation from the room.

Q. In that point? A. Yes.

Q. Do you know the reason for that construction? A. Has some cooling effect.

Q. That takes that upper portion, takes air from the room and dumps it out some place. Do you know where it goes?

A. It goes up in the attic.

Q. Do you know whether that is AGA approved, to dump room air into the attic that way?

A. Well——

Mr. Stanbury: Is the question now or at the time this heater was approved? Do you mean now?

Mr. Hoegh: Well, let's start with the time of the approval covering this heater.

The Witness: At that time the laboratory was not very much concerned about a certain amount of leakage into the attic. They are now. [923]

Q. (By Mr. Hoegh): That wouldn't pass AGA now, is that correct?

A. No. And most of the heaters didn't. Con-

(Testimony of Walter M. Berry.)

sequently, they were all reapproved this last year.

Q. Would AGA approve the use of a notch in a head plate, such as on the heater you tested, under the present requirements, or under the '54 requirements?

Mr. Stanbury: I am thinking to think. Wasn't our last approval in '53?

I am objecting to '54 as being immaterial, and confusing.

Special Master: All of these heaters went out under the first set of regulations, as I recall.

Mr. Stanbury: That is correct, yes. And they stopped making them.

Special Master: Good for five years.

Mr. Stanbury: And they stopped making them before the five years expired. That is correct.

Special Master: Well, the two which were admitted into evidence were those approved in '51 and '53. The latest we had was '53. I think that is the one the heater was approved under.

I think that objection would be good.

Q. (By Mr. Hoegh): Do you know whether those heaters were designed with the '54 requirements in mind, Mr. Berry?

A. I don't know. [924]

Q. Now, the AGA takes temperatures at the back of the economizer, doesn't it, in the wall?

A. Yes, they do.

Q. And you didn't?

A. No, for two specific reasons. First, my experience with wall heaters has been that the hot

(Testimony of Walter M. Berry.)

spots are nearly always in front just above the header plate. If you correct that difficulty you usually have no difficulty elsewhere. Of course, in this particular case it would have been impossible to get any legitimate or reasonable test in trying to measure the temperatures there because of the very fact of cutting off the—sealing off the front there with the tape, and you also cut out the air to the back of the heater; consequently, the back wall temperatures would have been probably high and entirely misleading.

Q. I thought you testified that was your first experience with a heater with an economizer, Mr. Berry. Isn't that true?

A. It is true, yes.

Q. Wouldn't that upset some of the things you gained from experience with other heaters?

A. Well, not necessarily. But I state that was my general experience with wall heaters. But the other reason is probably more pertinent in this particular case, that in the process of sealing off that air, we closed off the [925] ventilated air around the sides and back of the economizer. So any results there would have been entirely misleading and wouldn't have meant anything.

Q. You modified the heater so much that it couldn't pass AGA around the back, is that correct?

A. We didn't have in mind trying to modify it at all. We were making comparative tests, irrespective of any AGA requirements; although we

(Testimony of Walter M. Berry.)

tried to run most of the tests as close as possible to the AGA requirements.

Q. Your experience certainly hasn't included any temperatures up around outlet grilles prior to this case, economizer outlet grilles prior to this case?

A. No. But I have had a great deal to do with measuring temperature and I know the effects of radiation.

Q. Would wall temperatures up there be 200 degrees above room?

A. I don't know what they would be. But apparently they weren't under normal test since it was passed by the laboratory. That is all I can say.

Q. And you don't know the effects of these modifications on the heater as to those temperatures then, do you? A. No, I do not.

Q. Did you run any of these tests—well, first, do you know a Mr. Fairchild?

A. Yes, I know him very well. [926]

Q. Did you run any of these tests in connection with this Mr. Fairchild?

A. No, I did not.

Q. Do you know whether or not he ran any such tests similar to yours on these heaters?

A. I do not know. I might mention that the setup of this heater and all the equipment is still set up, and I feel so confident of the results on the efficiency test that they can be checked any time and I feel quite sure that results will be similar to what we have presented here.

(Testimony of Walter M. Berry.)

Q. Mr. Berry, do you know whether the American Gas Association will let you interconnect the air space, or form a conduit between the air coming out the main discharge grille of the heater—that's around in the lower panel there—and the panel side rails, as we call them?

Mr. Stanbury: Objection. That is immaterial. It apparently refers——

Special Master: I don't think I understand this question, Mr. Hoegh.

Will you read the question?

Mr. Hoegh: Perhaps I can rephrase it.

Mr. Stanbury: My objection is that it apparently is in the present tense. That is my objection.

Special Master: I don't think I followed the question.

Mr. Hoegh: Perhaps we had better start over.

Q. (By Mr. Hoegh): Wasn't it your testimony this morning, Mr. Berry, that any air coming up around inside the panel between the panel and the wall would be discharged into the room through the main outlet grille of the heater?

A. Well, I don't know that I expressed it quite that way. That discharge, I think, would be through the side louvers on the side of the panel there.

Q. You weren't talking about those this morning, were you?

A. Maybe I didn't quite understand your question. There is some leakage there, but there's a projection on that front panel that slips over the

(Testimony of Walter M. Berry.)

edge of the top part of the heating element there. I mean, the inside casing that probably makes that joint fairly tight.

Q. You didn't recall that this morning, did you?

A. Yes. I may have misunderstood your question, or not answered it quite in detail, specific detail.

Q. Your testimony was that that air was discharged out into the room through the main outlet grille, as I recall it this morning, Mr. Berry.

A. Well, I was in error. I answered too hastily then, if I did, because I helped put that front casing on there to the heating element there, and I should have recalled that that was a fairly snug fit there.

Q. So that the air coming up in those panel side [928] rails would not be discharged into the room. Is that your testimony?

A. It would be discharged in the room, but probably be discharged through the louvers on each corner, or on the upper side, side of the upper section of the front panel.

Q. Normally, that was two panel side rail channels which are connected with the area around the sides of the lower box, is that right?

A. Yes.

Q. But you sealed that off to prevent any interflow of air between those areas, is that correct?

A. Yes, we did.

Q. When you take a heater into the AGA laboratory, Mr. Berry, any variations over the 90-

(Testimony of Walter M. Berry.)

degree limit of rise in wall temperatures are rather strictly adhered to, aren't they?

A. Rather strictly now, yes. There is a little tolerance; occasionally, I don't think they would hold you up for a few degrees in a few spots. But, strictly reading the specifications, why, there is no tolerance in there.

Q. Have you found in your work before the AGA that generally it is required to have separate air passages between heating elements and the surrounding wall spaces?

A. It isn't required, but that is the only way that most manufacturers find it possible to get by on the wall temperatures, to have that circulating space between the wall [929] and the element by means of a flange or some projection attached to the side of the casing.

Q. The way you have modified these heaters in an attempt to seal off certain areas, you have a rather large surface connection there, don't you, between the heater and the wall? A. Yes.

Q. That certainly wouldn't be approved by AGA, would it?

Mr. Stanbury: You mean now or then? If there is any difference.

Mr. Hoegh: Then. I assume there would be.

The Witness: It's conceivable that the conduction of heat along a solid metal member going to the wall would conduct enough heat there so that the temperature might be too high.

Q. (By Mr. Hoegh): Do you know of any way

(Testimony of Walter M. Berry.)

that a company could make a heater so that it would have this construction, with this foil that you have used to modify these heaters?

A. Well, I am not a sheet metal worker. I don't know just how I would fabricate it, but I can conceive there would be ways of doing it. Whether it be a very practical way or not, I don't know.

Q. You have variations in stud width to contend with. That would be one of the problems, would it not? A. Yes.

Q. You would have variation in the spacing between [930] studs to contend with, wouldn't you?

A. That is true.

Special Master: On these temperature charts here, you took the temperature on both the front and back of the stud?

The Witness: The thermocouples go in the studs from the outside. The ends are turned over, flush with the studs, yes. So there are two rows of thermocouples the way down.

Special Master: That is, you got a reading on both sides?

The Witness: Yes. On the inner side of each studding going down, yes, on the side of the heater.

Special Master: That is what you call the back and front? Is that the way you would express it, as far as the heater fitting in there is concerned?

(Discussion between Special Master and witness outside the hearing of the reporter.) [931]
Special Master: Is there a question pending?

(Testimony of Walter M. Berry.)

Mr. Hoegh: No, there is not, your Honor, unless you asked it.

Special Master: No.

Q. (By Mr. Hoegh): Mr. Berry, going back to that area above the economizer outlet grille, have you ever examined any Coleman installation instructions to determine how far down from the ceiling that grille is? A. I have not.

Special Master: Can't you agree on that?

Mr. Tilton: We are under the impression that it is in the record. Mr. Newton says that the record contains a copy of the Coleman installation instructions, but I don't have the exhibit number in mind at the moment. We can find it.

Special Master: Could we have it approximately? Is it a foot, or six inches, or two feet?

About a foot, 15 inches, something of that kind?

Mr. Newton: Yes.

Mr. Hoegh: I think that would be approximately correct.

Special Master: You both have seen these. I have never seen one of the real ones. All I have seen are photographs. But it would vary a little according to the height of the ceiling?

Mr. Stanbury: That is what I would think.

Special Master: You can't tell from a photograph—— [932]

Mr. Newton: It is 80 inches from the floor.

Mr. Stanbury: To the top?

Mr. Tilton: To the bottom.

(Testimony of Walter M. Berry.)

Special Master: That is, the air outlet grille, 80 inches to the bottom of that air outlet grille?

Mr. Tilton: Yes.

I found the exhibit, your Honor. It is No. 28 in the record.

Special Master: In the original record?

Mr. Tilton: Yes.

Q. (By Mr. Hoegh): In your work as a consultant, Mr. Berry, or in your experience as an engineer, can you conceive of any reason for the structure of the top of that outlet grille, economizer outlet grille, except to take care of a very dangerous condition at that point?

A. Well, construction of somewhat similar nature is used quite frequently to direct the air or products in a certain direction. I would say that if the products escaping from that economizer were extremely hot, by spilling them somewhat below the top there, that there would be less heat piled up near the top, yes.

Q. The products aren't spilled at all, are they?

A. I mean the heat, the warm air coming out of there.

Q. How about the top half of the economizer [933] outlet grille, would that be used to alleviate an extremely high wall temperature?

A. Any circulation of air you might have up there naturally would reduce the temperature of the wall.

Q. Wouldn't you presume from looking at that

(Testimony of Walter M. Berry.)

structure, that that was what that was for, the top of that economizer outlet grille?

Mr. Stanbury: Pardon me for interrupting here.

When we refer to the top of the economizer outlet grille, are we talking about the top of that part that is an outlet, or the top of the whole grille?

Mr. Hoegh: The top of the whole grille I am referring to.

Mr. Stanbury: I am objecting to that.

Special Master: You mean above the outlet?

Mr. Hoegh: Yes.

Mr. Stanbury: I object to that, because it assumes it is an outlet grille by referring to it as the top of the outlet grille.

Special Master: There is no grille there, is there?

Mr. Hoegh: The portion that I am referring to—as I have understood our nomenclature, the entire grille was an outlet grille.

Mr. Stanbury: No, sir.

Mr. Hoegh: And the outlet is shown, and the inlet is [934] just directly above that.

Mr. Stanbury: No. The outlet grille is where it is marked Air Outlet, and the top part is an inlet.

Q. (By Mr. Hoegh): Have you understood what I have meant when I have talked about the top of an economizer outlet grille, Mr. Berry? Have we been talking about this area up here above the plate that extends through the middle of the economizer and out through the economizer outlet grille?

(Testimony of Walter M. Berry.)

A. Well, I assume that you are talking about the very extreme top of that grille there.

Special Master: That is actually divided?

The Witness: That is divided, yes.

Mr. Stanbury: You can see it on the photograph, if you wish, your Honor. Exhibit 8-A to -E shows the division line.

Q. (By Mr. Hoegh): In your experience, Mr. Berry, can you conceive of any reason for that except to alleviate a very high temperature around that grille, or in the wall above that grille?

A. Unquestionably there is a relief there, yes. Just how much circulation you get above that partition there up through the wall there depends upon the openness of the structure above there. Even if that wasn't open, experience has shown that a certain amount of circulation in that area might have some cooling effect. But if you have some relief up in the attic so that the room air can get into that area [935] above that partition of the wall, naturally it will cool that down.

Q. Wouldn't you normally, then, have taken the temperatures in that area above the hole of the economizer outlet grille, checked those?

A. I suppose if we were preparing this for submission to the laboratory, we would have had to do that, but since these were strictly comparative tests and we had no question in our mind but this had been approved as originally constructed, why, we had no particular occasion to investigate every portion of that grille or area.

(Testimony of Walter M. Berry.)

Q. Did any of these temperatures which you did take show temperatures which would not have passed the American Gas Association requirements?

A. Yes, sir, there were a number of places in this top panel. And there may have been a few in the wall temperatures. I don't think there were. But certainly there were a few spots up there in that panel in front of the economizer that were a little over the AGA requirements.

Mr. Hoegh: I have nothing further, your Honor.

Mr. Stanbury: I have a couple of questions, very quickly.

Redirect Examination

Q. (By Mr. Stanbury): Concerning your testimony this afternoon as to what [936] you did to this heater, or what you could have done to the heater to increase the efficiency, did you in any of these tests notice any difference in the way the heater performed when you let the wall space air around the lower box into the economizer from when you kept it out altogether?

A. No, I did not.

Q. When you had that back wall space air sealed out of the economizer, was some of it continuing to pass up the wall, back wall space, to the attic?

A. Yes, a certain amount went up through there.

Q. Who is this person Fairchild to whom reference was made that you said you know?

(Testimony of Walter M. Berry.)

A. He is another consultant with a great deal of experience in gas appliances.

Mr. Stanbury: I have no further questions.

Recross Examination

Q. (By Mr. Hoegh): Mr. Berry, have you found in your experience with wall heaters that you can make any changes in the air flows of those heaters without affecting the operation of the heater throughout?

A. Well, there is a case, again, as to how much change. Naturally, the air flow over a heater is very, very important, and the better contact you have with the air and [937] the combustion chamber, or the heating element, the better it is, because you have such a very small amount of heating surface there. It is really ridiculous that you can get by with that small amount of heating surface with a 35,000 BTU heater. So that the air flow is important. Just how much change you make, to make any material change, naturally it is going to change your results.

Q. As I understand your testimony, it is particularly important because of the small size of these heaters, the small heat exchange surfaces that you have?

A. That's right.

Q. Would you say that modifications that you make to increase the efficiency on one kind of heater would apply to a different kind of heater where there were different air flow patterns?

A. There is a considerable similarity now. So

(Testimony of Walter M. Berry.)

many have copied each other that many of the heating elements are almost identical so that the same changes would probably apply. But there are different types and modifications that would have to be different for different heat exchangers.

Q. With each set of appliances you have an initial set of problems, don't you?

A. That is right, every one is to some extent different.

Q. Would those same considerations apply to any other [938] of Coleman's wall heaters, the Dual Line, 35 Dual, 45 Dual?

A. I wouldn't be prepared to say anything on that. I have just probably barely seen the 35 Coleman. I have no definite recollection, even, of what it looks like.

Mr. Hoegh: Nothing further.

Mr. Stanbury: Nothing further, Mr. Berry.

Special Master: You may step down. We will take our recess before we go on.

(Recess taken.) [939]

* * * * *

ALWIN B. NEWTON

called as a witness by the defendant, being first sworn, was examined and testified as follows:

Special Master: Be seated. Give me your name and address, please.

The Witness: Alwin B. Newton, 3511 Elmwood Drive, Wichita, Kansas. [940]

Direct Examination

Q. (By Mr. Stanbury): Mr. Newton, what is your occupation?

A. I am vice-president of the Coleman Company in charge of design and research.

Q. How long have you been in that position?

A. Somewhat over four years.

Q. What is your profession?

A. I am a mechanical engineer.

Q. What is your education?

A. I graduated from Syracuse University in mechanical engineering, and then from Massachusetts Institute of Technology afterwards with a master's degree in mechanical engineering.

Q. And will you tell us of your professional experience?

A. Yes. I worked for the General Electric Company in Lynn, Massachusetts, for approximately a year in their turbine research department. Then for York Corporation, York, Pennsylvania, for somewhat over four years in their development department.

I left there as an assistant head of their devel-

(Testimony of Alwin B. Newton.)

opment department. And then for about eight years I was with Minneapolis-Honeywell as manager of their refrigeration division in Minneapolis, Minnesota; after which I was chief engineer of Chrysler Corporation Airtemp Division in Dayton [941] for some four and a half years.

Then I went to Acme Industries in Jackson, Michigan, for one year as director of sales; after which, by previous contemplation, I became vice-president in charge of engineering. I was with them a total of somewhat over four years. And from there I came to Coleman.

Q. Since you have been at Coleman what has your experience and function been?

A. I first came as chief design engineer, knowing of the potential retirement of the then vice-president in charge of design and research, whose place I took.

I am a member of the Board of Directors and of the Executive Committee and, of course, of the various steering committees that direct the activities of the company. [942]

* * * * *

Q. (By Mr. Stanbury): Now, will you explain, in detail, what you show on this overlay?

A. Yes. This overlay shows one of the methods by which the heater could have been redesigned to eliminate the pink air from the economizer completely. What we have done in this case is to illustrate the economizer—let me say first, from here down there is no change in the lower box, so we

(Testimony of Alwin B. Newton.)

can eliminate that from our discussion. All the changes occur above that.

And what we have done is to change the inlet so that we have, by use of a solid header plate across here, with no ventilation whatever, and by making that adapted to communicate [977] directly with the air economizer inlet and providing a bottom plate so that the pink air is completely excluded from this area above the header plate and the bottom of the air inlet, we have no communication whatever between the pink and the room air which is shown as orange. To do that we have split the upper part of the casing into two pieces, which is a simple thing to do, so that the upper part, a point just two or three inches below the top, up through the area that includes the room air inlet grille is a separate piece and is installed at the same time the economizer is. Preferably it could be installed later, but it would probably be installed at the same time the economizer is installed.

And here I have illustrated an adjustable joint, because there are differences in the space from the front face of the wall back to the back side in here where the back of the header plate has to communicate with the rear inner wall. And that adjustment is simply taken care of by moving this in and out here (indicating).

Now, those are the changes we would make in the heater.

Q. All right. Now, how would that design compare with the heater used on the tests made for

(Testimony of Alwin B. Newton.)

September 3rd and September 15th insofar as the wall temperatures and the efficiency are concerned?

A. Well, we know that this type of thing makes no measurable difference in efficiency; that is, as we get more [978] air from the room in here, the changes, if any, are in the direction of a slightly higher efficiency. But they are so minor that for all practical purposes you get the same efficiency that you would have had with the same heater before.

As far as the temperatures, our tests that we took on September 15th, and other dates, show that the more we can exclude the air from below, such as the pink air which is a heated air, from the economizer inlet, the more we use the low temperature from the room itself through the economizer, the lower are going to be all of these wall temperatures. And our data shows that, as we took out the little bit of air that leaked in from the pink area, the wall temperatures went down in this upper area. Actually, in this design they go down much more because we are also excluding the brown air from the economizer. And that's a heated air, also.

Q. What would be your opinion, sir, as to whether a heater designed as that one is would perform so as to comply with the AGA requirements as they were in 1953?

A. It would have certainly complied, and would certainly have passed any AGA test that the original heater passed.

(Testimony of Alwin B. Newton.)

Q. In 1953 were you aware of any AGA requirement, or requirement at all, against permitting the pink air, the back wall air to flow in the wall space all the way to the attic? A. No.

Q. Was that question raised in connection with the Coleman heater? [979]

A. Not to the best of my knowledge.

Q. What retooling would be involved in switching from the infringing heater to a heater designed such as you have just indicated with your overlay there?

A. Well, we've made some estimates of what our retooling costs and so forth all through the organization would have been, and the total retooling, which includes, of course—we call them the “new literature” and so forth or sales retooling, which includes that kind of thing—would be about \$7500.

Q. How many dies do you have to change?

A. There is one basic large die that has to be changed, and that is the die that makes this whole outer casing. And we have to have a new die to form this piece, this piece being the new piece with the room air return grilles in it in front of the economizer. And that new die there would probably be made from what we cut off of the old die, at least the male part of it, and female parts of it would.

Q. How long, in your opinion, would be required to do that redesigning, retooling and get the

(Testimony of Alwin B. Newton.)

AGA approval and get the thing on the market as redesigned?

A. Well, relating it to the things we were doing at the time and the type of testing we would have to do, [980] it would be done in less than three months.

Q. Do you know whether AGA does, or did at that time, make any allowance whatsoever to expedite matters which were in some state of emergency?

A. They did then, and they do still.

Q. That is, put them through somewhat faster than the normal routine?

A. Any manufacturer who has a real emergency need for quick service gets it.

Q. Now, would that heater, as redesigned, put any hot metal in contact with the wall or stud spaces?

A. No. We haven't changed anything down below here (indicating). We have exactly the same contact of just the one header plate, which we had before; and that's no problem.

Q. I mean, does it put any hot metal in contact with the wall or stud spaces? A. No.

Q. Would that redesign be adjustable to variations in stud space dimension?

A. Yes, it will.

Q. How?

A. Because of the adjustable joint which is shown here, where the inlet hood, as it might be called—what was formerly the top of the casing—

(Testimony of Alwin B. Newton.)

and the rest of the duct that takes the air from the room into the economizer, [981] is shown with a slit joint into the inlet of the economizer so it can be moved in and out to take care of wall variations.

Q. Is it adjustable to variations in wall thickness? A. Yes, it is.

Q. How?

A. Mainly the variation in wall thickness, or in the material of the front wall——

Q. I thought that was where the wall thickness problems exist. If I am wrong——

A. There are two places——

Q. All right.

A. ——if I may say so, where the wall thickness problem does exist. One is the thickness of a stud, which is three and five-eighths inches, a standard stud; but in some areas there is a practice of cutting them down to save wood. And then there is also a variation in the thickness of the front wall itself. And since we are concerned with the dimension that is made out of the stud dimension plus the wall thickness dimension, we have to provide this variation that I just described; and it provides for both of those things.

Q. Starting in May of 1953, if you redesigned this heater as you have indicated, do you believe that you could have had the redesigned device on the market by September 1st of that year?

A. I would certainly expect to, yes. [982]

Q. Now, can you tell us whether what you have

(Testimony of Alwin B. Newton.)

described as a redesign of the economizer of this heater, whether that was also adaptable, was adaptable to both the four foot and three foot economizers, or only to one?

A. It could have been made with either economizer. The difference in length is at the top.

Q. Now, when you designed this chute—when did you design the chute?

A. July of—June and July of 1956 is when it was designed.

Q. At that time did Coleman have its plans for the kind of heater which is now put out by it?

A. Yes, surely.

Q. Were you attempting to redesign the heater when you designed the chute?

A. No, I was not.

Q. What were you attempting to do?

A. Well, actually, I was—what I was attempting to do was to take care of all heaters as they then existed in our stocks and in our branch stocks and our distributors' stocks, for that matter, to provide a device which I thought would eliminate the infringement. I was trying, really, to carry out what I thought the wishes of the court were, and do it ahead of the time we actually had to.

Q. You were attempting to apply something which you [983] thought would do the job to the heater design already in use?

A. Yes, that is correct.

Mr. Stanbury: I will offer the overlay that has

(Testimony of Alwin B. Newton.)

just been used by the witness as Defendant's Exhibit BB.

Special Master: It will be received. [984]

* * * * *

Q. (By Mr. Stanbury): What kind of a wall heater is Coleman now making?

A. We are making a single stud space heater in sizes which run from 25,000 BTU in the smaller size now up to 62,500, I believe it is, in the largest size.

We have one of the largest big heaters that is on the market.

Q. Are they single stud space?

A. Yes, they are all single stud space.

Q. Do they have economizers?

A. No, they do not.

Q. I assume it has AGA approval?

A. Yes, sir.

Q. How does its function compare with the infringing heater with the economizer?

A. Its function is similar as far as heating the room and whatnot. It does a better job of heating than any of the older heaters did.

We have provided for more air circulation in the heater, and therefore get more circulation within the room than we ever got with the previous models with the economizer.

Q. When did Coleman begin to put that model on the market? [1004]

A. 1957 right after the first of the year. [1005]

* * * * *

(Testimony of Alwin B. Newton.)

Cross Examination * * * * *

Q. (By Mr. Hoegh): Mr. Newton, have you ever actually built a heater such as you have shown in Exhibit BB, with the lower part, as well?

A. No, not exactly like that.

Q. Obviously then, too, you don't have AGA approval on that kind of a heater?

A. No, I don't believe I said we did. My comment this morning was that the tests that we have run indicate that the more we go in this direction the lower our upper wall temperatures and the more simpler it becomes to get AGA approval.

* * * * *

[Endorsed]: Filed February 10, 1958.

In the United States District Court, Southern
District of California, Central Division

No. 213-57-WM

THE SIEGLER CORPORATION, a Corpora-
tion, Plaintiff,

vs.

THE COLEMAN COMPANY, a Corporation,
Defendant.

TRANSCRIPT OF PROCEEDINGS

Los Angeles, California

Monday, May 12, 1958

10:45 A.M.

Honorable William C. Mathes, Judge Presiding.
Appearances: For the Plaintiff: Christie, Parker

& Hale; By: C. Russell Hale, Esq.; Richard B. Hoegh, Esq.; and Ashley Stewart Orr, Esq., 595 East Colorado Street, Pasadena 1, California. For the Defendant: Parker, Stanbury, Reese & McGee; Dawson, Tilton, Fallon & Lungmus; By: Raymond Stanbury, Esq. and Timothy Tilton, Esq., 315 West 9th Street, Los Angeles 15, California. [1]*

The Clerk: Case No. 213-57-WM, The Siegler Corporation vs. The Coleman Corporation.

The Court: Are you going to say something more than you said in the voluminous memoranda, Mr. Hoegh?

Mr. Hoegh: Your Honor, I won't say that it will be more. I would like to emphasize a couple of points.

The Court: All the talk is about Claim 2. Isn't there a Claim 1 in the patent?

Mr. Hoegh: There is, your Honor; but through the admissions of the defendant that claim is not in issue in this case.

The Court: Well, the first thing we should settle then is what is before the court on this particular motion. Is it stipulated that everything that is in the file as of this date is before the court on this motion?

Mr. Hoegh: I assume so, yes, your Honor.

The Court: Is that agreed, Mr. Stanbury?

Mr. Tilton: I assume you are referring to the depositions that have been taken and other material.

Mr. Hoegh: Yes.

* Page numbers appearing at top of page of Reporter's Transcript of Record.

Mr. Tilton: I see no objection to that.

The Court: Well, I haven't read any of the depositions. I never look at the interrogatories or requests for admissions [2] prior to the time that counsel are prepared to discuss them or until counsel agree. I treat the interrogatories and the requests for admissions the same as I would depositions. I never go into them in advance, but if they are before me—that is the reason I wasn't apprised of the disposition as to Claim 1. I kept wondering what happened to Claim 1. So that is disposed of in the requests for admissions, is that it?

Mr. Hoegh: Yes.

The Court: It isn't involved here, is that it?

Mr. Hoegh: No. It's not involved to this extent, at least, that none of the devices manufactured by the plaintiff or predecessor are charged to infringe that claim.

We have placed no particular stress in this motion on any of the depositions. Those are matters which we think are outside the scope of the motion, since they relate primarily to the issue of infringement.

The Court: Are you saying they aren't used in support or opposition to the motion? As I understand the stipulation just made, everything that is in the file, including, depositions, stipulations, interrogatories, if there are any, and requests for admissions and responses to requests for admissions, all of that is before the court either in support of or in opposition to the motion.

Is that the stipulation? [3]

Mr. Stanbury: That is the stipulation, your Honor.

Mr. Hoegh: Yes, your Honor.

The Court: Very well. Regardless of how pertinent it may be. I don't know how pertinent it may be. But one of the difficulties of these motions is sometimes defining what the court may consider on the motion. Oftentimes I get them under submission without knowing just precisely what is to be considered on the motion.

Mr. Hoegh: I had assumed that Rule 54 would permit the court to examine anything in the record in search for an issue of fact.

The Court: Well, I have always had doubt about that unless the motion is actually predicated on those and specified. I think it is better practice in making the motion to specify precisely as to the affidavit of so and so verified a certain date, the deposition of so and so.

Mr. Hoegh: I believe our Notice of Motion does do that, your Honor.

The Court: It may well do it.

Very well. You may proceed.

Mr. Hoegh: I know you have seen these parties and these lawyers in here on other matters from time to time, but I would like to review a little history.

The Court: Well, I must say that the title of the plaintiff, I didn't know until the other day that the [4] plaintiff was the same as the one in the other case. I must say that deceived me. I never did look at the file in this case until the other day, really,

and I didn't know that I had the Holly Company and the Coleman Company again before me. I thought Siegler was another company.

Mr. Hoegh: It is, your Honor. It is the successor to the business formerly conducted by Holly in Pasadena.

The Court: I notice in this reply memorandum you quote some colloquy of court and counsel in that other case. Is that in the record here?

Mr. Hoegh: I have made it part of the record, I believe, in the Notice of Motion, your Honor.

The Court: What? By incorporation by reference?

Mr. Hoegh: Yes. I had assumed there would be no dispute but that admissions made by the parties in the other action by the Coleman Company would constitute admissions in this case.

The Court: Well, if they are before the court in this case.

Mr. Hoegh: Yes, your Honor.

The Court: How are they before the court, by incorporation?

Mr. Hoegh: Only by incorporation by our reference to them in the notice, your Honor. Those are the only matters which we had brought out of the other record and [5] attempted to use in this proceeding.

The Court: Do you think that the statement of counsel, in effect, as to the validity or invalidity of the patent should be given weight?

Mr. Hoegh: Yes, your Honor. I base that on the

understanding I have that anything counsel says in court binds the client.

The Court: You start here with the presumption of validity, and as I understand it, you rely upon that Browell patent not having been cited.

Mr. Hoegh: That is part of it, yes.

The Court: In other words, you rely on the fact that the presumption of validity does not apply in respect to that patent, the Browell patent.

Mr. Hoegh: Yes, your Honor.

The Court: Otherwise, the presumption of validity would have to stand, wouldn't it?

Mr. Hoegh: Well, your Honor, I know that you devoted a great deal of study to that matter in the Delco case decided here recently, and we have attempted to follow that case in this matter by setting forth facts which in our opinion destroy the presumption of validity even as to the cited art.

The Court: In order to destroy the presumption the court would have to say, would it not, that the evidence [6] would be such that no finder of fact could reasonably find to the contrary?

Mr. Hoegh: Well, that is perhaps one way of saying there's no issue as to the facts which have been set forth.

The Court: That would be the only way you could say there is no issue as a presumption.

Mr. Hoegh: Yes.

The Court: Ordinarily you can't weigh the evidence on a motion for summary judgment.

Mr. Hoegh: That is true, your Honor. And I think perhaps when you say that no finder of fact

could find to the contrary, you in effect weigh the evidence; you say there is no issue.

The Court: Well, you weigh it but it weighs so far on one side that you are able to say that no reasonable fact finder could find to the contrary of the fact claimed.

Mr. Hoegh: Yes, your Honor.

The Court: Whether you can do that in the face of the presumption, where you say a disputable presumption is so far outweighed—I suppose the evidence could be that clear. I don't know.

Mr. Hoegh: I think it could, your Honor. The Court of Appeals in the Paris case (234 F. 2d 65) declared a patent invalid over the prior art since it was obvious on its face that no invention was represented. [7]

The Court: The Paris case?

Mr. Hoegh: Yes.

The Court: Our Court of Appeals? Was that that purse?

Mr. Hoegh: Our zipper bag of some kind, yes.

The Court: I cited that in the Delco case. But the court there didn't discuss the presumption at all and as I recall——

Mr. Hoegh: It was still there.

The Court: ——the case, it appears in the opinion but not in the reasoning of the court. It appears in the opinion that the pertinent prior art was not cited in the Patent Office proceedings in that case, and that could have been a ground, but not a stated ground.

Mr. Hoegh: No.

The Court: Well, I am taking your time. What did you wish to emphasize?

Mr. Hoegh: Well, I like to get the views of the court. I just wanted to give a little bit of history, your Honor.

The patent with which we are now concerned, the Giwosky patent, was applied for in October 1953. That was almost a year after the Coleman Company had been on the market with the infringing devices, and was some time after the Holly Company had obtained its patent and been on the market with the device covered by the Hollingsworth patent.

The application that was originally filed, from [8] the file wrapper history, shows that it was directed to a wall heater having three stages of heat exchange, the first being through the primary wall heater, or lower box, and the second two being along the flue, the cool points that Mr. Giwosky stated to be those that presented a problem of overheating—"local overheating" I think he calls it.

Thereafter, in April of 1954, just about five or six months after Coleman had applied for its patent, Holly came on the market, predecessor of plaintiff, with a device that is now charged to infringe. Thereafter, the Coleman Company, through the processes of amendment in the Patent Office, or the process of the Patent Office presenting several amendments, refers to being in October 1954, the Coleman Company did not at that time attempt to claim a device such as that which Holly brought on the market in April of 1954; nor did the Coleman Company attempt to have the application taken up

out of turn in the Patent Office on the grounds that an infringing device was on the market. And that procedure is provided for in the Patent Office when a person who has a patent application before the office thinks that an infringing device is on the market. To me that indicates at least as early as 1954 the Coleman Company did not consider that this particular application covered a device having only two stages of heat interchange; which the request for admissions and the interrogatories do point out that the Holly unit have only [9] the two stages of interchange, while the original Coleman application was directed to a heater having three stages of interchange of heat.

The application of Giwosky was amended in 1955, late 1955, and the remarks to that amendment state,

“Newly added claims carefully define a structural arrangement conceived of by applicant, and in so doing these claims recite a wall heater and economizer assembly wherein three distinct air flow patterns are present.”

Those three distinct air flow patterns are those of the circulation around the primary heat exchanger and additional two along the flue in the Giwosky conception.

So that by November of 1955, well over a year after Holly had been on the market with a device now charged to infringe, there was no thought that the Coleman application would cover a device such as that which is now charged to infringe, having only two stages of heat interchange; one in the pri-

mary box, and the second above that in the economizer.

I think the next significant date is April 1956 when the Court of Appeals affirmed this court's judgment in the other case between these two parties. In July of 1956, just two or three months after the Court of Appeals affirmed this court's holding Coleman to be an infringer of the Hollingsworth patent, the claim which became Claim 2 of the [10] patent we are now concerned with was admitted, after final rejection in the Patent Office, and——

The Court: After final rejection of what in the Patent Office?

Mr. Hoegh: Of the application originally. There were some proceedings after final rejection in the Patent Office.

The Court: Is the file wrapper here?

Mr. Hoegh: Your Honor, we had only one and it is in the original file. It is not in the court file.

The Court: I recall it being mentioned, but I didn't see it. I can get it from the original file.

The patents, of course, are all here, are they?

Mr. Hoegh: Yes, your Honor.

The Court: I notice they are attached to your memorandum. Are they before the court in the form of an affidavit or admission of some kind?

Mr. Hoegh: No, they are not in that form, your Honor.

The Court: I don't see how I can consider prior art patents that are just merely attached as exhibits to a memorandum.

Mr. Hoegh: We have the file history before

your Honor, and the citations to those patents are in the file history. [11]

The Court: Of course, the file wrapper is the administrative record.

Mr. Hoegh: Yes, it is.

The Court: Now, is the patent in suit before the court in some way? Is a copy of it before the court?

Mr. Hoegh: A copy of it is in the proceedings.

The Court: How?

Mr. Hoegh: I don't think that it is in the file wrapper.

The Court: How is it before the court here?

Mr. Hoegh: Only as being lodged with the court, your Honor.

The Court: Well, that doesn't—I think there is an affidavit. Here is the Giwosky affidavit, and attached is Giwosky patent 2,767,702. Is that the patent in suit?

Mr. Hoegh: Yes, it is, your Honor. And he does state that that is his patent in the affidavit.

The Court: Does he authenticate that?

And there is the Hollingsworth patent attached. And the Browell patent is attached.

Are all of those authenticated by the affidavit?

Mr. Hoegh: No, they are not, your Honor; just the Giwosky patent. The Hollingsworth patent, of course, has been gone into rather thoroughly previously and was in the courtroom, and I would assume that this court could take judicial [12] notice of matters which are in its file. The Browell patent and the Hollingsworth patent are in those files and copies were supplied with the memorandum.

The Court: Well, for the purpose of this motion will it be stipulated that the Giwosky patent, and the Hollingsworth, et al. patent, 2,602,441; and the Browell patent, 268,860; that the copies filed by the plaintiff on March 31, 1958, under caption "Affidavits, Prior Art Patents and Certified Copy of File Wrapper in Support of Plaintiff's Motion for Summary Judgment," are true copies of those patents?

Mr. Stanbury: So stipulated, your Honor.

The Court: Very well. Now, in your memorandum you have attached——

Mr. Hoegh: Copies of additional references of record other than Hollingsworth.

The Court: I haven't looked at them, but there is C-a-y-o-t, 2,702,539; Snyder patent, 2,093,492; and Derrough, 1,608,777; Bacon and McGarrigal, 786,713; which are attached to plaintiff's "Reply to Defendant's Memorandum in Opposition to Plaintiff's Motion for Summary Judgment," filed May 8, 1958.

Is it stipulated that those are true copies of the patents?

Mr. Stanbury: So stipulated, your Honor.

The Court: Very well. [13]

Mr. Hoegh: Your Honor, we have taken this history of this patent. It was issued in October, October 23, 1956. Late in December, December 28, 1956, the final injunction of this court, or the interlocutory injunction of this court in the earlier case was served upon the defendants. December 28th was a Friday. On Monday, December 31st, a letter was sent to the Holly Manufacturing Company by

Coleman, the Coleman Company's attorneys, charging it with infringement of the Giwosky patent.

In our opinion the Giwosky patent, we think, was asserted merely for its nuisance value. That is not before this court but we do urge seriously that there are grounds for invalidating it on a motion for summary judgment. Two of those are set forth in our motion which I think can be taken up together. The first is that Giwosky was not the inventor of the device claimed in Claim 2 of the Giwosky patent, the claim that is before this court. The remaining ones are that Claim 2 presents new matter which did not perform part of the Giwosky application as originally filed; that the matter which became Claim 2 required a supplemental oath because it was so far removed from what had been originally filed by Mr. Giwosky in his application.

The Court: What required the supplemental oath, the rules of the Patent Office?

Mr. Hoegh: Claim 2, the rules of the Patent Office. [14]

The Court: Presumably, the Patent Office waived the rule, did it not, by not requiring the supplemental oath?

Mr. Hoegh: Well, I suppose that is——

The Court: If we indulge the presumption in the regularity of official proceedings we can't assume that the Examiner overlooked it and forgot to ask for it, can we?

Mr. Hoegh: Nevertheless, your Honor, the court is empowered to review the validity of the patent; and in doing so there certainly would be a duty

upon this court to examine whether or not everything had been accomplished that should have been by the applicant.

The Court: Well, the oath is a matter of form, isn't it? It could be waived, I suppose.

Mr. Hoegh: No, it could not, the way I understand it.

The Court: The statute calls for an oath, does it?

Mr. Hoegh: Yes, your Honor. And the reason for the Patent Office rule is to allow a supplemental oath to be filed to give the inventor a chance to cure——

The Court: Then it would seem your reliance would be upon the statute and not on the Patent Office proceedings.

Mr. Hoegh: Yes, your Honor.

The Court: This is, in effect, a supplement to the application.

Mr. Hoegh: Yes. [15]

The Court: And not verified as a part of the statute.

I interrupted you.

Mr. Hoegh: The remaining grounds which could be lumped in this discussion would be that the patent, or the matters now claimed to infringe, were put in public use more than two years before the subject matter of the claims which are now claimed to infringe was presented to the Patent Office.

The Court: Is your argument there that if the Holly device is an infringing device, that it is the device described in the patent in suit, which was on the market for a few years?

Mr. Hoegh: Yes, it is, your Honor.

The Court: Have you finished stating the grounds?

Mr. Hoegh: Yes, as to these. The remaining ground that we have urged is the one that the device is anticipated by prior art.

The Court: Now, I notice you rely not only on the Browell patent, but you rely upon tacking the Hollingsworth patent onto the Browell patent.

Mr. Hoegh: Yes, your Honor.

The Court: Can that be done? I am referring now to strict anticipation. I am not referring to this loose use of the term "anticipation" in the sense of meaning that prior art so anticipated in fact the invention that we must [16] say that the patent in suit does not represent an inventive advance over the prior art. I am not referring to that loose use of "anticipation." I am referring to strict anticipation as used in patent law.

Now, as I understand it, a patent must anticipate, a prior patent must anticipate the patent in suit in order for there to be strict anticipation for a prior invention; that you can't look to invention of Patent A and take one element of a combination, and Patent B—I am referring to prior art patents now—and take another element of the combination, and prior art Patent C and take another element and say that those three elements are combined in the patent in suit and each of them appears in the prior art patent and, therefore, there is anticipation. If *there* were true, there could never be a valid combination patent, could there?

Mr. Hoegh: There could if the combination were of those that were not obvious to people skilled in these matters.

The Court: Well, now you are referring to whether or not it's——

Mr. Hoegh: A less strict anticipation.

The Court: ——a patentable advance over the prior art. But in order to be anticipated in the strict sense of the term as I understand it—but there is so much loose talk in the decisions that I may be in error—there must be a prior patent or a prior invention which singly anticipates [17] the invention of the patent in suit in order for there to be strict anticipation, what some of the cases call strict anticipation to distinguish, I suppose, from loose anticipation. Is that your understanding?

Mr. Hoegh: Yes, your Honor.

The Court: Then you couldn't tie Browell onto Hollingsworth for any other purpose than to say that they are both parts of the prior art and taken together show a state of art, such an advanced state of the art that the patent in suit is not an inventive advance over it. Isn't that what you mean?

Mr. Hoegh: Yes. I think you can also say, your Honor, that Hollingsworth, the Hollingsworth patent taken all by itself is a strict anticipation of the Giwosky device.

The Court: Would you say that Browell is?

Mr. Hoegh: No. As to certain details of the economizer I would say so, your Honor.

The Court: The defendant says — as to certain details.

Mr. Hoegh: Yes.

The Court: Well, that wouldn't be material, would it? Well, it might be material in determining whether or not either Hollingsworth or the patent in suit is an inventive advance over Browell.

The defendant says, in effect, that you are blowing [18] hot and cold on Browell; that in the Holly Manufacturing case, the prior suit in this court, you urged that Browell was not part of the pertinent art, as I recall.

Mr. Hoegh: I think perhaps we are both a little guilty of that. But I think we can say this, your Honor, that the Hollingsworth device showed the way to Giwosky, and this is an established fact—of how to design a device with a secondary heat exchanger, a wall heater with a secondary heat exchanger. In solving the very basic problems of wall heaters which we went into at great length in the earlier trial, the early fireplaces were of no help at all to Hollingsworth in setting up and designing a wall heater having functions and the elements that his device did. However, once Hollingsworth was on the market, or had been disclosed in an issued patent, then there would be no patentable advance over the prior art of Hollingsworth when you consider Browell.

The Browell patent relates to a flue construction, and the pertinence of it certainly seems to me to be demonstrated by the testimony of Mr. Kice and the

remarks of Mr. Lyon which we have alluded to in our memorandums.

To pursue a little further the question of anticipation by Mr. Hollingsworth of the Giwosky device, the Hollingsworth device shows the very feature upon which Coleman was able to convince the Patent Office that Coleman should be granted a patent on the Giwosky device, the Giwosky invention. [19] That feature was the use of room air blowing across the top of the lower box into the economizer, which in the later stages of the Giwosky patent became the reason for which Coleman was urging allowance of its patent. The use of room air to cool this so-called barrier plate or lower box top and use that room air then to further cool the flue, exactly the same type—well, not exactly the same, but patentably the same kind of arrangement was used in the earliest Hollingsworth device. He took room air from a little more circuitous route. He took it up through the columns of the trim and across the top of the lower box into the economizer.

The Coleman Company in its arguments to the Patent Office said that Hollingsworth showed only a dead air space in that particular area in the forward portion of the lower box, while in actual fact Hollingsworth did show a way for air to blow up around the column of the trim, which would be room air which would be circulated or flowing up through those columns across the top of the lower box and into the economizer just the same as Giwosky did later by a slightly different means; at least disclosed in the patent by a slightly different

means. That dead air space was presented as a distinguishing feature between Giwosky and Hollingsworth after the Examiner pointed out that there was no invention in making the barrier of Hollingsworth complete and taking that room air in at higher levels. [20]

The Coleman Company went on to make a very strong pitch about the importance of that room air flowing across the top of the lower box and thereby solving a problem which could not be solved by the Hollingsworth device. In view of that, which I don't consider to be refuted in any way by any of the documents filed by the defendant, it seems to me, the plaintiff, that we can disregard the presumption of validity which might normally exist as to the reference to Hollingsworth and look right straight at both of those devices. And in my opinion the Hollingsworth device is a strict anticipation of the Giwosky device.

The Court: Hollingsworth was cited in the Giwosky patent.

Mr. Hoegh: Yes, sir.

The Court: If the Giwosky patent is presumptively valid over Hollingsworth, over the Hollingsworth patent, wouldn't it be presumptively valid over Browell?

Mr. Hoegh: No, it would not be presumptively valid over Browell, since Browell was not cited to the Patent Office. And I do not think that it would be presumptively valid over Hollingsworth because the Coleman Company misled the Patent Office as to how Hollingsworth functioned in order to make

the statement that this one feature upon which Coleman was able to obtain a patent was existent in Giwosky and not in Hollingsworth. And, in actual fact, those representations [21] to the Patent Office were not true. There is no doubt that the Hollingsworth device took air through the column trims and across the top of the lower box into the economizer.

The Court: I notice that your Notice of Motion does not state that it is based upon the records and files in the other case. At least, as I read it I don't see it here.

Mr. Hoegh: The only reference to it, your Honor, in the Notice is the admissions of the defendant set forth in the memorandum of points and authorities served with it.

The Court: The admissions include portions of the record in the other case which you wish to rely upon?

Mr. Hoegh: Those that we have quoted, yes, your Honor, the statements of Mr. Kice and Mr. Lyon.

The Court: That is Case No. 15,886, is it, Holly against Coleman?

Mr. Hoegh: Yes, your Honor.

The Court: Do you wish to stipulate, gentlemen, that the records and files in that case may be before the court in this case on the motion?

Mr. Tilton: If I may speak on that, your Honor. We have no objection to that. But we certainly don't want to stipulate that a misstatement of fact by Mr. Lyon can be considered an admission against interest.

Mr. Lyon's statement in the record was that Browell [22] was the file wrapper reference against the Giwosky patent, and that is not true.

The Court: I am not going to decide this case upon any statement that counsel made in the heat of another trial. It would take a solemn concession of counsel, in my view, to bind the party in a situation as serious as the worth of this property. I am just thinking of the finding, so that there won't be any question as to what is before the court and what I may consider. And that is made more difficult by the fact that I tried the other case.

If it is agreed, I will take judicial notice of the papers and records in the other case, case No. 15,886.

Mr. Stanbury: We will stipulate that the court may do so.

The Court: Is that agreeable to the plaintiff?

Mr. Hoegh: Yes, your Honor.

The Court: Very well.

Mr. Hoegh: That record is getting quite voluminous, and will be quite a record to incorporate or search for an issue of fact. The only pertinent parts that we have presented are set forth in the memorandum.

The Court: Perhaps I am extending it too much. Perhaps I should say the record before the Court of Appeals.

Mr. Stanbury: Well, that's another matter, your Honor. [23]

The Court: You would want the entire record.

Mr. Stanbury: Oh, yes.

The Court: Very well.

It is agreed that it be the entire record as it exists as of this day?

Mr. Hoegh: Yes, your Honor.

The Court: Anything further, Mr. Hoegh?

Mr. Hoegh: Your Honor, the question of intervening rights seems to me to be one which is easily determined upon this motion, and in my opinion there is no question but that Claim 2 presented a broadening amendment to the application as originally filed since it eliminated one of the elements which was a restriction upon the application as it was originally filed. It eliminated the third stage of heat exchange, or what we might call the second stage, along the flue. The original application was directed to the three stages. Mr. Giwosky, in filing for his patent, declared that there was a problem of overheating at the economizer outlet on the top edge of the economizer outlet, and that he was unable to get a device which did not have the third stage in it to perform so that it would pass AGA regulations. He merely lifted off the top stage and was unable to make such a device perform properly, in his opinion. He stated that there was a problem of local overheating in the region of where this third stage circulation took place, so that that local overheating [24] was alleviated by what he taught in his application as originally filed.

So we come then to Claim 2 which eliminates this particular feature, the third stage of heat exchange; but the problem is still stated in Mr. Giwosky's application and is still stated to exist in the patent

that finally issued. Mr. Giwosky made an oath that he thought he was the first inventor of this device when he first filed the application in 1953. He made no subsequent oath that he had found a way to alleviate this local overheating by some other means than that which he originally taught in his application. He is only entitled to a patent which has utility. The patent laws require, or just merely state that patents shall be granted for new and useful improvements and new and useful devices. He could not obtain a patent on a device which had no utility.

We are not arguing that such a device might not have utility, but at least Mr. Giwosky thought that it had no utility.

Then we come along to the device which is now set forth in Claim 2 and now charged to infringe this patent, and we find that devices charged to infringe have been on the market for well over two years before this particular claim appeared in the patent. There's no doubt about that. That's a fact which is plainly established by the affidavit of Mr. Hamner. So we have a broadening amendment. We have a [25] device. And reinforcing that statement is the fact that Mr. Giwosky stated in his affidavit that he found the third stage to be essential to the operation of the device shown and disclosed in his patent.

We have the further amendment to the objects of the patent, or what might be called the statement of invention which makes a change in the objects to include only one stage of heat exchange along

the flue, and that change was made at the same time that this broadening amendment was filed in July of 1956.

All of those factors point up that Claim 2 is a broader claim than anything previously filed, and when you take that fact and set it alongside of the unchallenged fact that the devices now charged to infringe were on the market as early as 1954, I think that the cases clearly establish that such a claim is not valid since the rights have intervened in the meantime for this two-year period.

Those are factors which clearly are ascertainable from the file wrapper and from the fact that this particular device now charged to infringe appeared long before the claim which it is charged to infringe appeared in the application.

I think, your Honor, that it is certainly a clear rule of patent law that a disclosure must teach a person skilled in the art how to practice or construct the device defined in the claims. It would be asking Mr. Giwosky to be [26] indeed prophetic to ask him to teach persons skilled in the art how to do something which he found he could not do himself. It would be an impossible burden. I don't think that anyone can examine the file wrapper, or even the patent, and find a way in which this particular device defined in Claim 2 could be made to operate, in view of the problems set forth by Mr. Giwosky as to local overheating in the region of the economizer outlet.

He has invited persons skilled in the art to do more work in this field. He says, "While in the fore-

going specifications I have set forth a specific structure in considerable detail for the purpose of illustrating the invention, it will be understood that such details of structure may be varied widely by those skilled in the art without departing from the spirit of my invention."

Undoubtedly Mr. Newton has done more work in this field, and Holly Manufacturing Company, if they do in fact infringe—and that is certainly not a fact at all—was able to construct a device having only two changes of the heat interchange; and perhaps Mr. Newton has, too, as set forth in his affidavit. However, we are still faced with the fact that Giwosky did not teach anyone how to do this, for he himself was unable to do it.

Your Honor, I would like to reserve a few moments for reply. [27]

The Court: Very well.

Mr. Stanbury: Your Honor, may I move the admission for the purpose of this case of Mr. Timothy L. Tilton of the Illinois Bar, who is admitted to practice in the Supreme Court and all the courts of Illinois, as well as in all of the Federal Courts in Illinois; and for whose good character and integrity, based upon personal acquaintance, I may vouch.

The Court: The motion is granted.

Mr. Stanbury: I am prepared to argue this matter, but in anticipation of questions that might come up, Mr. Tilton is so much better qualified to argue the matter than I am that I have asked him to do so, your Honor.

The Court: Very well.

Mr. Tilton: If the court please, we take the general contention that most of the questions raised by the plaintiff are premature and improper on a motion for summary judgment; but at the same time we have no desire to hide behind a claim of triable issue. We are willing to have a full discussion of the issues in this case at any stage. So, in consequence of that, I would like to take up each one of the points that have been raised here, unless your Honor feels that there is no reason for going further at this time with any particular issue.

Now, the first point which I believe your Honor has indicated really as the threshold consideration here [28] relates to the presumption of validity, and while I would not undertake to say what your Honor meant in the Delco chemical case I certainly feel that you did make it clear in that opinion that that was a situation in which the Patent Office hadn't gotten within a country mile of the present prior art. There was square and direct participation of a whole group of prior art patents that had been completely overlooked by the Patent Office.

Now, Siegler's theory here is that the Patent Office missed Browell, and if they had had it they never would have allowed this patent. Our position is that the Patent Office considered references which were much more pertinent than Browell, which are more pertinent on their face, and they had no reason to cite Browell because it was cumulative.

The Court: I suppose plaintiff will concede that Hollingsworth is more pertinent than Browell.

Mr. Hoegh: Yes, your Honor.

Mr. Stanbury: I should think so, your Honor.

Mr. Tilton: If I may hand up a group of patents. They are all in evidence in this matter. They are the ones attached to the affidavit, but I thought it might be more convenient if your Honor first of all will look at the Browell patent, which is the one on top, and you will notice that down toward the bottom of the flue there are some little [29] black specks that look like perforations.

Now, the specification of Browell doesn't mention what those are. They seem to have a reference letter small p on them, but the specification doesn't tell you what they are, what purpose they serve. However, I think it is probably true that they are small openings, that some air did come in there and could have come out of the pipes marked I.

But, now, as compared with that, let's see what references the Patent Office did consider. If your Honor will look at the Derrough patent, which is the next one in the group, that was cited in the first action of the Patent Office. It shows a flue with cold air coming in and going out in two places. It is a jacketed flue in which you have two cold air streams ventilating the flue. The patent specification goes into detail about this. It isn't left to conjecture.

Not only the Derrough patent was cited, but also the Bacon and McGarrigal patent, which is the next one in the group. And as your Honor will note there again, we have a jacketed flue in combination

with a fireplace, and we have two cold air streams ventilating that flue.

Now, at the very most the Browell patent would only teach the practice of using a plurality of cold air streams to ventilate a jacketed flue and clearly could only [30] be cumulative of either one of those we have referenced.

Now, as to whether it is a better reference, I leave it to your Honor's judgment as to whether the Examiner would cite something that didn't even mention the particular feature in question but left it to conjecture by looking at the drawing.

As I understand the law, your Honor, it is this: That the presumption of validity may not be circumvented simply by showing some patent which was not officially cited, unless it's clear that the Patent Office completely missed the most pertinent art. And there are two recent cases in the Seventh Circuit that held this. And one of them is the *Artmoore Co. v. Dayless*, found at 208 F. 2d page 1, the point in question being at page 4. And also *Helms Products v. Lake Shore Manufacturing Company*, 227 F. 2d 677, and the point being at page 681.

If I might just read one or two short sentences from the *Artmoore* case. This was written by Chief Judge Major, who was undoubtedly our leading patent judge in the Seventh Circuit. He has since retired.

But he stated,

"* * * defendants' argument based on these prior art patents, not cited in the Patent Office, is not

convincing. It has been held, and we think with logic, that it is as reasonable to conclude that [31] a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked * * *

So, I don't believe we have a situation here where, as in the Delco case, it can be said to be plain that the best prior art patents were missed.

Now, as to whether Browell is such a powerful reference here, since we have incorporated everything by reference I would like to refer to the appeal brief which was filed by Holly in which they stated,

"A study of the Browell patent moreover shows that what it discloses is basically different from what defendant makes and sells. All that Browell discloses is the jacketed pipe connected to a fireplace * * *"

and then they go on and finally conclude,

"* * * in short, the Browell fireplace and jacketed flue bear no more than a superficial resemblance to the defendants' wall heater."

The Court: You think that that cancels out what Mr. Lyon says about the patent in suit?

Mr. Tilton: I think it is at least as good if we are going to consider that sort of thing. And, incidentally, the court of appeals agreed with that statement and so held in their opinion. [32]

The Court: What do you say on this point that Claim 2 was added long after the alleged infringing device appeared on the market?

Mr. Tilton: Our position, your Honor, is that

that is a complete misinterpretation of the file wrapper. It is true that at the outset Claim 1 of the patent called for the feature of using a plurality of air streams to ventilate the flue. This claim was rejected as directly anticipated on Bacon and on the Derrough patent in the first action and was withdrawn. The subject matter that was carried all the way through and on which claims were eventually allowed is that found in Claim 3 of the original application, and there is nothing in Claim 3 that says that you must use two stages of heat exchange. Rather, it claims a particular means for overcoming hot spots in a flue of this type of unit which can be applied either once or twice.

The Court: Did Claim 3 in the original application become Claim 2 allowed?

Mr. Tilton: Yes. If I may refer to that, your Honor. The final wording of Claim 2 in the patent is somewhat different in that it is longer. Claim 3 is a broader statement of this inventive principle, but nevertheless it is perfectly clear that it was the same invention that followed all the way through here.

The Court: Well, did Claim 3 become Claim 2 as [33] allowed?

Mr. Tilton: Claim 3 was cancelled for the purpose of rewriting in the first amendment and another claim presented on that subject matter and followed all the way through until that subject matter was eventually allowed. And our position is that at all times there was complete continuity of this subject matter.

If your Honor would care to go into this just a little further at this time, if you will look at the copy of the Giwosky patent which I handed up; I think that it is right below the Hollingsworth patent. If you do that, I think I can explain what we have. Actually, there is not two inventions here but only one. If you will notice, the area in dispute is the lower one, of course, and you find there this plate 18 which extends across the top of the heater and directs the hot air out into the room.

Now, directly above that is the lower end of the front wall, and that is one of the most vulnerable points for overheating. And what is done there to overcome that is to bring the cool room air in and pass it over that plate, thereby reducing its temperature and reducing the amount of heat radiated to that wall.

Now, we find that another hot spot occurs up toward the top of the unit, and there again Giwosky does exactly the same thing. He provided a barrier plate, No. 26, which [34] brings the hot air out underneath and brings the cool air in over the top of it. And then to say, as our opponents here apparently do say, that what Giwosky thought he invented was a three-stage heat exchange unit is just impossible on any examination of this patent. I mean, what he was doing here was trying to find a means of overcoming hot spots and, thereby, creating an improvement over what Hollingsworth had done. And it is true, he had two hot spots and he used the invention twice. But the sub-

ject matter that we claim is involved in this suit would apply whether it was used once, twice, three or four times.

So, we can't see that there is any basis for the contention that you have to use it twice. Claim 3 only calls for it once. And we had a claim before the Patent Office at all times which called for it only once.

Of course, I recognize that these matters involve a rather detailed construction of the claims, and that our position is that that can be more readily done at the trial, but——

The Court: If this is an invention over Hollingsworth's device, how does the Hollingsworth device infringe?

Mr. Tilton: Yes, your Honor. I would be very happy to go into that.

The Court: I don't believe that is before me though, on this motion. The motion is based upon validity. [35]

Mr. Tilton: I think it is in this way: That the defendant takes a position which—or, rather, the Siegler Company, the declaratory plaintiff, takes the position that they are entitled to intervening rights because the device which they manufactured from 1954 on comes under our claims. Now, if that is true it must have infringed. So, it's a threshold issue on the matter of intervening rights. You must hold it infringed before you can create intervening rights. And here they are in denying the infringement, while at the same time asking

your Honor on a motion for summary judgment to hold that they have intervening rights.

The Court: Normally, if the prior device infringes, why, it anticipates, doesn't it?

Mr. Tilton: That is quite right, your Honor.

If I might hand this up to your Honor. This is a photograph from the deposition of Mr. Biggers in this case, and that represents a front view of the heater which Holly originally manufactured from 1950 to 1954.

Now, as compared with that we have these photographs which were attached to Mr. Newton's affidavit—and I will hand them up again for convenience—which show the device as modified in 1954. And your Honor will notice that there is an opening at the top about 12 inches wide—12 inches long and one and a half inches wide—which communicates directly with the economizer. You can stick both hands in [36] there and practically reach inside of the economizer. Prior to that they had a solid metal plate across that opening.

This isn't a leakage question. We are not complaining about a little air leaking into the heater. This is a situation in which they modified their construction, and our position is that they had to do it in order to pass the more stringent A.G.A. requirements in 1954.

Now, our patent was applied for well before they came on the market. We applied for it in 1953. And our heater was on the market in '52.

The Court: Well, if you say that Holly infringes,

then aren't you saying that the Hollingsworth patent anticipates the Giwosky patent in suit?

Mr. Tilton: If your Honor will look at the copy of the Hollingsworth patent that I handed up, you will find that in the area where they now have an opening they had nothing but a solid metal plate. That is the area which is marked "critical area" on that copy. s

The Court: Yes. I have it before me.

Mr. Tilton: What the Examiner did in the Patent Office—and incidentally, this case was very thoroughly examined. We discussed it not only with the primary Examiner but also the chief Examiner of the division, and the rejection was that it would not require invention in view of Hollingsworth to open that plate that is shown solid there and to bring [37] in air into the economizer in view of the other references, such as Derrough and Bacon which show the ventilating of flues.

And so the exact issue of validity over the prior art as presented in this case was presented to the Patent Office. There is no difference.

Now, we had this question that was raised by Mr. Hoegh in which he said that we misrepresented something to the Patent Office. Well, now, I don't know how that is before your Honor at this time. They have filed no affidavit which says that we misrepresented anything, or why. But the point was simply that we pointed out to the Patent Office that that area marked "critical area" was essentially a dead air space, and it is. You can see it from the patent. It is simply an area which

is bracketed metal plates and enjoins the wall. And there is no provision for bringing air directly into that space from the room, as we have in the construction which they went to in 1954.

So, we feel this is a case that has real substance. It's not one that can be disposed of on a preliminary motion such as this.

The Court: Is it your position that the alleged infringing devices are not manufactured in accordance with the teachings of the Hollingsworth patent?

Mr. Tilton: That is correct, your Honor. In the [38] Hollingsworth patent 100 per cent of the air, as you recall, was supplied to the economizer from the back wall space. They now have this large opening in front which communicates directly with the economizer, and it is our position that they never could have gotten that wall area right above that cool enough to pass A.G.A. if they hadn't opened it up.

Now, why did they make the change? The only answer Mr. Hollingsworth could give in the deposition in this case was that they wanted to save the price of this piece of metal which went all the way across. But he admits that he knew of the Coleman device before he made this change, before he thought of making it; and he knew of the Coleman principle of operation. So, at the very least, he must have known that he could take that off without doing any detriment to the unit.

The Court: Doesn't the plaintiff say here that this patent in suit is purely a paper patent, that

no device has ever been made according to its teachings?

Mr. Tilton: Yes. I am glad you mentioned that, your Honor. If you will look at the copy of the Giwosky patent that I handed up, I just cannot understand how this point can keep being raised when it is so absolutely contrary to all of the evidence.

You can see from the Giwosky patent itself that it utterly falls. [39]

The Court: I don't suppose it's of any consideration. If it is disputed I couldn't consider it on this motion, anyhow.

Mr. Tilton: I think that is quite true, but if I might just take a moment, your Honor, you recall this leakage passage from the back space that went under and came around—if you will look at the copy of the Giwosky patent you will see that the bottom of the economizer, the space, the barrier plates, and the little passage through there which communicates with the back wall space; and that is the leakage passage on which we were held to infringe, shown right in the patent. So, how in the world can anyone contend that we didn't make a commercial device like the one shown in the patent? It's an absurdity on the face of it.

The Court: Well, I wouldn't decide this motion upon anything that is in dispute. As far as the facts were concerned, I assume—not that it would make any difference—determining validity. It might be of importance on the issue of infringement.

Is there anything further?

Mr. Tilton: Of course, from a legal standpoint it is really unsound, anyhow. It's like arguing that nothing could have infringed the Hollingsworth patent that didn't get 100 per cent of the air from the back wall space. That isn't the issue on the question of infringement. That is, [40] there may be other forms that fall in the broader claim.

I think the issue here, perhaps ironically or not, is just the converse; that we have the question here as to whether enough air goes in this opening that they have provided to affect the operation of the heater, to achieve the result of reducing these wall temperatures and helping them in satisfying the A.G.A. requirements; and that we feel our evidence will show that at the trial.

The Court: This is becoming a very crowded art, isn't it? It wasn't heretofore.

Anything further?

Mr. Tilton: Well, I don't know how far to go with this. There is one point that Mr. Hoegh didn't stress in his oral argument but which is one of the principal points in their brief, and I would like to spend just a moment on it.

In Claim 2 it is stated that the cool room air coming in is in heat exchange relation with this barrier plate, and they claim that that term "heat exchange relation" is new matter and it's improper, wasn't part of the invention, and so on. And yet the original application very clearly stated that this room air was directed on the plate, that it impinged on the plate, and any cool air stream im-

pinging on a heated plate is necessarily in heat exchange relation with it.

Now, Mr. Giwosky signed an affidavit for the plaintiff [41] here, but when asked about this point he very readily agreed, and in his second affidavit, which we have filed, he said, "As stated in my patent application as originally filed this room air impinged on the closure plate—" and that being a quote from the original specification "—and would, thereby, necessarily be in heat exchange relation with the plate."

So, we have simply a quibble over terms. I don't see any reason to spend more time on that.

As your Honor knows, the procedure for obtaining a patent is one of negotiation between the patent attorney and the Patent Office. An inventor develops a particular mechanical structure, but he is in no position to say what his invention is in relation to the prior art as far as a claim definition. That is worked out by a process of negotiation. And to pinpoint the precise point of novelty in relation to the art involves a very formal detail-type of definition. So you frequently find—in fact, I would say you almost always find an inventor didn't originally conceive his invention in the exact identical terms in the final claims. Those are worked out in relation to the art.

There are many cases—we cite some of them on page 4 of our memorandum—which hold that in order to fully protect the real invention great latitude is given in making these amendments.

There is one case quoted in the brief, but there

is [42] another recent one in the Seventh Circuit that brings this out very well. And that is *Glade v. Wahlgreen*. It is cited but not quoted. In that case this question was raised of new matter and the Court of Appeals there stated,

“It is also urged by defendants that the claims in the Martin patent were not the same as claims originally filed and that certain amendments were made of the specifications while the application was pending, hence they assert that the final claim should have been supported by a supplemental oath. A supplemental oath is required only when an applicant claims some phase of his invention quite different than what was originally claimed. The original claims of the Martin patent are directed to the same general subject matter as those in the patent, and we think this contention is without merit.”

Now, it is our position here that we have a clearer case, really, than this *Glade v. Wahlgreen*; that we didn't simply claim the same general subject matter, but we put a searchlight on this feature that we wanted to patent and we followed it all the way through. We had to give up on the broad idea of ventilating the flue with two cool air streams because that was directly met. But there was a very thorough examination of this patent on that one particular feature.

Now, the Siegler Company in their presentation have [43] relied on the *Muncie Gear* decision of which I expect your Honor has heard before. It is the one that is discussed a lot but it actually has

a very limited application. In the Muncie Gear case the patentee had disclosed something in his patent drawing which he didn't regard as an invention at all. He later, many years later claimed an entirely different invention from anything that he originally indicated. And in that case it is equivalent to filing a new application, and the public use bar cut it off, as well as the use by other companies. So that case has a very limited application. And that fact is well brought out.

We cite the Coats Loaders case on page 4 of our memorandum. And in the Coats Loaders case it brings out that Muncie Gear doesn't even apply where you claim something consisting of three elements and you later drop out one element; because obviously the two elements were part of what you were originally claiming. And that is a recent decision in the Sixth Circuit, a 1956 case. So I don't feel that Muncie Gear could possibly have any application here.

They cite four other new cases which I would like to just comment on briefly. The Western Electric case is a Supreme Court decision and dealt with a divisional application. By definition a divisional application relates to a different invention. So that if when you file a divisional application you do have a situation in which you are shifting [44] to an entirely different invention.

And the Dwight and Lloyd case also involved shifting to an entirely different subject matter. The Westinghouse case and the Crown Cork case

both involved divisional applications and followed the same rule.

The Court: Those are the cases cited on page 12 of the defendant's reply brief?

Mr. Tilton: Yes, your Honor, page 12 of their memorandum.

The other case that they particularly rely on in their original brief—and I didn't have time to run this down when we filed our reply—is the case of *Chicago & Northwestern Railway Co. v. Sales*. Now, they say that case means that any change in your claims with reference to another company is at your prejudice and that you can enlarge your claims or change them to cover something an infringer is doing.

Now, the *Northwestern Railway* case was distinguished, and the actual rule as stated in *Hobbs v. Beach*, 180 U.S. 383, which case holds that there is no departure where the original specifications suggest—and the word "suggest" is the one used in the opinion—the final claims. And that is true even where there was a complete element omitted from the claims as originally filed.

So it's the rule of the *Northwestern* case, the [45] *Muncie Gear* case, all of those cases apply where you start off on one track and shift to something entirely different. It isn't just the usual procedure of working out the formulation of your claims in the negotiations.

In closing I would like to mention one other decision, and interestingly enough the case most precisely in point came out of our opponent's brief,

and I didn't notice it until I came out here. And it is the *Wagenhorst v. Hydraulic Steel Co.* case, 27 F. 2d 27, a Second Circuit decision by Judge Dennison, who perhaps next to Judge Learned Hand was one of our finest patent judges.

The Court: 27 F. 2d?

Mr. Tilton: It is at 27 F. 2d 27 and the point is at page 31. And it is cited, incidentally, in another connection in the Siegler brief. But if I might just read from that, because it is so directly pertinent.

In that case, by the way, the facts were that the patentee never appreciated that having lugs attached to this rim was an important part of his invention, although he disclosed it. A competitor came out with it and he filed a claim on it, and this competitor is now being sued, and this is what the court says:

"If this specific form involved invention, he knew that he had made it and reduced it to practice long before, and that he and not the [46] later comer was entitled to the patent. Perhaps, if he had not seen the competing construction, he would not have made the specific claim; perhaps, in the regular prosecution of his application, he would; but, so long as the applicant does not depart from or unduly enlarge the invention actually shown by his specifications and drawings, he may at any time amend his claim, so as to secure his real invention; and it is not controlling that he did not realize his claims were inadequate until he saw the competing device * * *"

And, so, it actually is immaterial whether Cole-

man was stimulated into action to get a better type of claim by seeing the Holly device. The facts are, if it is material, that that was not true.

Mr. Dawson, my partner, was prosecuting the case at that time and he tells me that he had no knowledge whatsoever which led him to try to write a claim to cover the Holly device. He was simply prosecuting a case in relation to the prior art. If that was material—which I don't think it is—he can certainly testify, and he would so testify. But I think the law is as stated in the Wagenhorst case, and so it is not a material issue.

There is one other decision I have a note of here, your Honor, which is pertinent to one phase of this. That [47] case is *Gibson v. Smoot*, 28 F. 2d 123-129. And this case brings out the rule, the common sense rule, actually, that a patentee does not need to conceive of his invention in the same words as finally used in the claims which are drawn in relation to the prior art. That rule is so self-evident that it is rare that you find it in an opinion. But it did come up in that case and there is a square holding on the point.

I think that is all I have, your Honor, unless there are some other areas. We have taken depositions. We have had interrogatories. If we were going to try this case I think we could go on the rest of the day but I don't think it is necessary.

The Court: Very well.

Do you have any reply?

Mr. Hoegh: Well, your Honor, the critical hour is at hand. If I could just have two minutes.

The Court: What do you say to Mr. Tilton's point that this contention of yours that the interposition of Claim 2 after plaintiff's devices appeared on the market, the contention of which is not available to you as long as you are denying infringement?

Mr. Hoegh: Your Honor, I don't believe that that's true. It is enough if the charge of infringement is made. The judge pointed out in the Westinghouse case, 22 F. 2d 823—it was, I believe, that one that the court had this very [48] same situation before it. And we will take it either way, of course. If we don't infringe we are all right, and——

The Court: Well, infringement isn't involved on this motion.

Mr. Hoegh: No it is not. Just the charge of infringement, as I read that case, was sufficient to invalidate the claim that was filed two years after the devices alleged to infringe appeared on the market.

The Court: That's the Westinghouse case in the Second Circuit, 22 F. 2d 277?

Mr. Hoegh: Yes, your Honor. That one or the Dwight v. Lloyd case cited just following it on page 12 of our memorandum.

The Court: What do you say to the point that these were divisional applications?

Mr. Hoegh: Your Honor, I would consider a divisional application to be an amendment. It would have to be an amendment. In my understanding of the patent law you have to present

matters which were originally disclosed before the division could be filed.

And to just elaborate briefly on that disclosure. Again, I'd like to point out that Mr. Giwosky disclosed a problem, an overheating problem at the top of the economizer outlet, and he disclosed one way of solving that problem, and that was to use a third stage air circulation past that [49] particular hot spot. He found such a third stage to be essential to his device in Claim 3, upon which Mr. Tilton relies in saying that the subject matter of Claim 2 was in this case throughout; and even that one defines a third stage of heat exchange. I don't ask you to take my word for it or Mr. Tilton's word for it. It's in the file wrapper as one of the original claims; and it clearly defines an enclosure plate, as it is sometimes called in this application, below which air is discharged and above which air is taken in.

Further, since Mr. Giwosky found that three stages of heat exchange were essential to the operation of his device, as he states in his affidavit; and he also states in his affidavit that the original application was directed to three stages of heat exchange.

The omission of a claim or an element of a claim which was essential to the operation of his device, in my opinion, takes that device outside the scope of what he originally applied for.

On our point that the intervening rights of the plaintiff have invalidated the claim, I would like to read from Webster Electric Company vs. Split-

dorf, 792, which indicates that the test of whether or not new matter is shown is not the same where a claim of intervening rights is made as where a claim of new matter is made, in violation of the statutory prohibition against inserting new matter. The [50] court there states,

“A comparison of these claims as set forth in the patent with the claims in the original application, to say the least, leaves in doubt the question whether they were not so materially enlarged as to preclude their allowance on the original application. But this aside, the evidence establishes to our satisfaction that Cain, the inventor, did not originally intend to assert these amended claims because he considered their subject matter one merely of design and not of invention. And the inference is fully warranted that the intention to do so was not entertained prior to 1918, which was several years after the original application was on file. During all this time their subject matter was disclosed and in general use, and Cain and his assignees, so far as Claims 7 and 8 are concerned, simply stood by and awaited developments.”

It is the position of the plaintiff that that exact same pattern was followed by the defendant in this case. The matter upon which the Coleman Company placed particular stress in getting this patent allowed, the use of room air to flow across the top of the lower box in heat exchange relation to that box top, is one which Mr. Giwosky considered to be merely a detailed design; and I [51] don't think there is anything in either of his affidavits that

would in any way vitiate that statement. And, therefore, the very matter upon which Coleman got this claim allowed was something which he did not consider to be part of his invention.

More than that, he considered the element which was omitted in Claim 2 to be essential to the proper operation of the device or any device which he proposed in his original application, and one which he naturally felt or thought would have utility.

For those reasons we think this claim is invalid.

The Court: The motion will stand submitted, gentlemen?

Mr. Tilton: Unless your Honor would like to go into this question about the invention covered by Claim 3 of the original application. I think I can show very quickly that that is directed to the invention now covered by Claim 2. But I think it is one of the triable issues here.

The Court: Is it disclosed by reading the claim?

Mr. Tilton: I think it is, your Honor. With your background in this field I think it is clear that it recites the barrier plate and recites the hot air come out underneath and cold air going on top, and there is nothing in there at all about two heat exchange stages. That is Claim 1, which we cancelled. [52]

I should be very happy to have it stand submitted, your Honor, as it reads in our brief.

Mr. Hoegh: I think the claim clearly recites, your Honor, that the barrier plate referred to is in the flue and not between what might be called the economizer and the lower box.

The Court: Very well, gentlemen. The motion for summary judgment will stand submitted. [53]

[Endorsed]: Filed August 19, 1958.

[Endorsed]: No. 16154. United States Court of Appeals for the Ninth Circuit. The Coleman Company, Inc., a Corporation, Appellant, vs. The Siegler Corporation, a Corporation, Appellee. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed: August 20, 1958.

Supplemental Filed January 9, 1959.

/s/ PAUL P. O'BRIEN,
Clerk of the United States Court of Appeals for
the Ninth Circuit.

United States Court of Appeals
For The Ninth Circuit

No. 16154

THE COLEMAN COMPANY, INC., a corporation,
Appellant,
vs.

THE SIEGLER CORPORATION, Appellee.

APPELLANT'S CONCISE STATEMENT OF
POINTS ON APPEAL (RULE 17)

Appellant, The Coleman Company, Inc., in accordance with Rule 17(6) of the United States Court of Appeals for the Ninth Circuit makes the following statement of points upon which it intends to rely:

1. The Court erred in granting summary judgment in favor of plaintiff on the ground that Claim 2 of Giwosky Patent No. 2,767,702 is invalid as being anticipated by Browell Patent No. 268,860 and Hollingsworth Patent No. 2,602,441, or as failing to meet the standard of invention because lacking in patentable novelty over said Browell and Hollingsworth patents.

2. The Court erred in holding that the issues of anticipation and invention with respect to Claim 2 of said Giwosky patent in relation to said Browell and Hollingsworth patents involve no triable questions of fact.

3. The Court erred in refusing to accord the Giwosky patent its legal presumption of validity over the prior art merely because the Browell patent was not cited and formally made of record by the Patent Office in the file wrapper of the Giwosky patent.

PARKER, STANBURY, REESE &
McGEE,
DAWSON, TILTON, FALLON &
LUNG MUS,

/s/ By RAYMOND G. STANBURY,
Attorneys for Appellant, The
Coleman Company.

Affidavit of Service by Mail Attached.

[Endorsed]: Filed September 24, 1958. Paul
P. O'Brien, Clerk.

[Title of Court of Appeals and Cause.]

APPELLANT'S DESIGNATION OF
RECORD (RULE 17)

Appellant, The Coleman Company, Inc., a corporation, in accordance with Rule 17(6) of this Court, designates the following as the record which is material to the consideration of the appeal herein:

1. Complaint.
2. Answer and Counterclaim.
3. Answer to Defendant's Counterclaim.
4. Interrogatories to Defendant.
5. Plaintiff's Request for Admissions.

6. Notice pursuant to 35 U.S.C. Sec. 282.

7. Defendant's Reply to Plaintiff's Request for Admissions under Rule 36.

8. Interrogatories to Plaintiff.

9. Plaintiff's Answers to Defendant's Interrogatories.

10. Pretrial Statement.

11. Affidavits, Prior Art Patents, and certified copy of File Wrapper in Support of Plaintiff's Motion for Summary Judgment.

12. Notice of Plaintiff's Motion for Summary Judgment.

13. Memorandum in support of Motion for Summary Judgment.

14. Memorandum in opposition to Motion for Summary Judgment.

15. Affidavits submitted by Defendant in opposition to Plaintiff's Motion for Summary Judgment.

16. Statement of Genuine Issues.

17. Reply to Defendant's Memorandum in Opposition to Plaintiff's Motion for Summary Judgment, (including attached Exhibits A to D).

18. Proposed Findings of Fact and Conclusions of Law.

19. Order on Plaintiff's Motion for Summary Judgment.

20. Clerk's Notice of entry of Summary Judgment.

21. Findings of Fact, Conclusions of Law and Summary Judgment.

22. Notice of Appeal.

23. This Designation.

24. The entire transcript of proceedings of May 12, 1958 before the Trial Court, being the proceedings upon plaintiff's Motion for Summary Judgment.

PARKER, STANBURY, REESE &
McGEE,
DAWSON, TILTON, FALLON &
LUNG MUS,
/s/ By RAYMOND G. STANBURY,
Attorneys for Appellant.

Affidavit of Service by Mail Attached.

[Endorsed]: Filed September 24, 1958. Paul P. O'Brien, Clerk.

[Title of Court of Appeals and Cause.]

APPELLEE'S DESIGNATION OF
RECORD (RULE 17)

Appellee, The Siegler Corporation, in accordance with Rule 17(6) of this Court, designates the following portions of the record for printing in addition to those designated by Appellant as being material to the consideration of the appeal herein.

1. Defendant's Answers to Plaintiff's Interrogatories, dated February 3, 1958.
2. Defendant's Reply to Plaintiff's Request for Admissions under Rule 36 dated February 3, 1958, if the same differs from Item No. 7 in Appellant's Designation.
3. That portion of Volume 6 of the transcript of

proceedings had on trial dated Monday, January 24, 1955, in Civil Action No. 15,886-WM Civil beginning on line 23, page 686, with the words "The Court:" to and including the statement "Mr. Lyon: That is right." line 25, page 687 thereof.

4. That portion of the transcript of Record prepared on Appeal from Interlocutory Judgment No. 14711, Volume I, beginning with the heading "Jack Kice:" on page 283 to and including line 8, page 284, ending with the statement "* * * my general jurisdiction."

Page 312, the last 14 lines, beginning with the words "Now, we have only been * * *" to and including line 2, page 316 ending with the words "* * * that dates back to 1919."

Page 354, beginning with line 4, with the wording "The Court: When you use that term * * *" to and including line 14, page 359, ending with the statement "The Court: Up into the heat exchanger?"

5. That portion of the transcript of Record prepared on Appeal from Interlocutory Judgment No. 14711, Volume II, on page 512, beginning with the heading "Plaintiff's Exhibit Number 11" to and including the drawing designated Plaintiff's Exhibit 1 on page 516.

The entire contents of page 542, being Plaintiff's Exhibit Number 43.

6. The decision of the United States Court of Appeals for the Ninth Circuit rendered April 10,

1956, Case No. 14711, and reported in 233 F. 2d 71.

7. The following portions of the transcript of proceedings before the Special Master, Civil Action No. 15,886-WM Civil:

Volume 1, dated September 10, 1957, page 17, beginning with the heading "Cross Examination," line 11, to and including line 21 of page 22.

Volume 6, dated September 18, 1957, beginning with the heading "Direct Examination," page 556, line 1, to and including line 23, page 568, concluding with the words "* * * of the directors."

Volume 7, dated September 19, 1957, page 722, line 1, beginning with the words "Mr. Hoegh:" to and including line 20, ending with "* * * 1938."

Volume 8, dated September 20, 1957, page 782, line 16, beginning with "Q. By Mr. Hoegh: Mr. Johnson, * * *" to and including line 4, page 783, including the statement, "I told him that we would not."

Page 843, line 11, beginning "Q. By Mr. Hoegh: Mr. Johnson, * * *" to and including line 17, ending with the words "* * * meet A.G.A. tests."

Volume 9, dated September 24, 1957, page 859, from the heading "Walter M. Berry" on line 18 to and including page 939.

Page 940, line 17, beginning with the words "Alwin B. Newton" to and including line 14, page 942, ending with the words "* * * activities of the company."

Volume 10, dated September 25, 1957, page 977, line 14, beginning with the wording "Q. By Mr. Stanbury: Now, will you * * *" to and including line 6, page 984, including the words "* * * it will be received."

Page 1004 from line 4, beginning with "Q: What kind of * * *" to and including line 1, page 1005, ending with the words "* * * of the year."

Page 1069, line 6, beginning "Q: Mr. Newton, * * *" to and including line 15, concluding with the words "* * * get A.G.A. approval."

8. Appellant's concise statement of Points on Appeal (Rule 17) (served on September 23, 1958).

(Items 3-5 and 7 above relate to portions of the record in the related case entitled *The Coleman Company, Inc. vs. Holly Manufacturing Company* Appeal No. 16141. It is requested that these portions of that record be printed even though the parties have stipulated that the Court may consider the entire record and transcript of proceedings in that case without the necessity of reproducing it.)

CHRISTIE, PARKER & HALE,

/s/ By C. RUSSELL HALE,

Attorneys for Appellee,

The Siegler Corporation.

Affidavit of Service by Mail Attached.

[Endorsed]: Filed September 30, 1958. Paul P. O'Brien, Clerk.

[Title of Court of Appeals and Cause.]

STIPULATION INCORPORATING
RECORD BY REFERENCE

It Is Stipulated by the parties hereto, through their respective counsel, that subject to the approval of the Court the entire record and transcript of proceedings in *The Coleman Company, Inc.*, a corporation, vs. *Holly Manufacturing Company*, a corporation, No. 16141, may be deemed part of the record on appeal in this action, without duplication thereof.

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/s/ By ASHLEY STEWART ORR,

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The Siegler Corporation.

So Ordered:

/s/ ALBERT LEE STEPHENS,

Chief Judge, U. S. Court of Appeals
for the Ninth Circuit.

[Endorsed]: Filed October 2, 1958. Paul P.
O'Brien, Clerk.